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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARY JESSE, PHILIP ANDREW CORDIER, JAMES DON EHRMIN, STEVEN MICHAEL KNOX, DOUGLAS MANIS, DON A. MESSENGER, and MATTHEW WILLIAM WAHLIN

Appeal 2014-009096
Application 13/102,968
Technology Center 2400

Before CAROLYN D. THOMAS, JOSEPH P. LENTIVECH, and KARA L. SZPONDOWSKI, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants seek our review under 35 U.S.C. § 134(a) of the Examiner's Final Rejection of claims 1–5, all the pending claims in the present application (App. Br. 2). Claims 6–11 are canceled (*id.*). We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

The present invention relates generally to "automated systems for organizing and facilitating information exchange between members of an organization." *See* Abstract.

Claim 1 is illustrative:

> 1. An automated communications system comprising:
>
> an input-processing subsystem that processes the messages received from receiving components that each receives messages from a communications medium by forwarding each message directed to a group, subgroup, or user to a routing-and-message-forwarding component which determines whether or not the message is authorized to be forwarded and, when the message is authorized to be forwarded, returns a corresponding message for each member of a group, member of a subgroup, or user to which the message is directed, and
>
> queues the one or more corresponding messages to one or more internal queues; and
>
> a post-processing subsystem that
>
> dequeues messages from the one or more internal message queues,
>
> processes each message dequeued from the one or more internal message queues to generate one or more processed messages, including modifying either or both of the destination and source addresses included in the message according to stored rules when the stored rules are applicable to the message, and
>
> forwards the one or more processed messages to sending components that each sends processed messages to a communications medium.

Appellants appeal the following rejections:

R1. Claims 1–5 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter (Final Act. 5);

R2. Claims 1–5 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite (*id.* at 6–7);

R3. Claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipated by Tsai (US 2004/0196858 A1, Oct. 7, 2004) (*id.* at 7–8);

R4. Claim 2, 3, and 5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsai and Fonseca (US 2005/0076089 A1, Apr. 7, 2005) (*id.* at 9–12); and

R5. Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsai, Fonesca, and McClendon (US 2005/0078619 A1, Apr. 14, 2005) (*id.* at 12–13).

ANALYSIS

Rejection under § 101
Claims 1–5

Issue 1: Did the Examiner err in finding that the claims are directed to *software per se*?

Appellants contend:

> Paragraph [0070] of the current application clearly and explicitly states, completely contrary to the Examiner's assertion, that the automated communications system that represent embodiments of the present invention include hardware platforms. Furthermore, Figures 8A-B, 15B, 16, and 17 of the current application clearly and unambiguously show physical hardware components . . . .

(App. Br. 7). Appellants further contend that "the Examiner has again failed to cite any authority for the absurd assertion" (*id.* at 9).

The Examiner finds "[i]n paragraph 70 of the [Appellants'] publication, [Appellants] have noted that the communication systems may be implemented in many different ways, including programming languages and data structures. Such examples are of software[,] . . . the claims can

then be reasonably interpreted as being implemented by software in certain embodiments" (Ans. 3). We agree with the Examiner.

For example, as indicated by the Examiner "[s]oftware by itself does not fall into any one of these statutory categories" under 35 U.S.C. § 101 (Ans. 2). A claim that recites no more than software, logic, or a data structure (i.e., an abstraction) does not fall within any statutory category. *In re Warmerdam,* 33 F.3d 1354, 1361 (Fed. Cir. 1994). Significantly, "[a]bstract software code is an idea without physical embodiment . . . ." *Microsoft Corp. v. AT&T Corp.,* 550 U.S. 437, 449 (2007). We highlight that the unpatentability of abstract ideas was reaffirmed by the U.S. Supreme Court in *Bilski v. Kappos,* 130 S. Ct. 3218, 3222 (2010).

Here, Appellants' Specification states:

> For example, automated communications systems that represent embodiments of the present invention may be implemented in many different ways by varying any of many different implementation parameters, including programming languages, control structures, modular organization, data structures, operating-system platforms, and hardware platforms.

(33:9–14). In other words, Appellants' automated communications system may be implemented in many *different ways* by varying of many different implementation parameters, including programming languages and data structures. Although Appellants contend that "paragraph [0070] clearly and explicitly states that a hardware platform is one of the components of the automated communications systems that can be varied . . . . This, of course, means that the hardware platform is a component of the currently claimed automated communications system" (App. Br. 6–7), we find no such explicit declaration. Instead, Appellants' Specification merely states that the system can be implemented in *many different ways* by varying any of many

different implementation parameters (*see* Spec. 33:9–14). Stated differently, there are *different* implementation parameters, i.e., ways of implementing the system, that can be varied, including programming languages and data structures. Appellants' Specification fails to indicate that a hardware platform is included in each and every implementation, as proffered by Appellants.

Accordingly, we sustain the Examiner's § 101 rejection of claims 1–5 for being directed to *software per se*.

Rejection under § 112, second paragraph
Claim 1–5

Issue 2: Did the Examiner err in finding that the claims are indefinite?

Appellants contend "[c]learly, [the routing-and-message-forwarding component] returns the corresponding message to the input-processing subsystem which then 'queues the one or more corresponding messages to one or more internal queues'" (App. Br. 10).

The Examiner finds "[w]hen a message is returned, it implies that an original message was sent" (Ans. 4) . . . and "[a]s the claim language uses the language 'returns' accompanied with a subject that never sent a message initially, the language is unclear and applicant's arguments are not persuasive" (*id.*). We agree with the Examiner.

As indicated by the language in claim 1, the routing-and-message forwarding component "returns a corresponding message for each member . . . to which the message is directed" (*see* claim 1). We find that such language implies, as noted by the Examiner, that a message is *returned* to each member of a group, subgroup, or user. Furthermore, we agree with the

Examiner that this step raises the question: How can the routing component return the message to a member/user when the message was never received from the member/user? We find that Appellants' explanation, i.e., it returns the corresponding message to the input-processing subsystem, is inconsistent with the plain language of the claims.

Furthermore, regarding claims 2–4, Appellants concede that "[t]he Examiner is correct [because] [t]he word 'not' was inadvertently omitted from the final clause in each of claims 2-4" (App. Br. 11). Although Appellants indicated that an amendment was included with the current Appeal Brief to address this error (*id.*), we note that the Examiner found that such an amendment was improper according to the *Manual of Patent Examining Procedure* (MPEP) § 1206, and therefore did not enter the amendments (*see* Ans. 5).

Accordingly, we sustain the Examiner's rejection of claims 1–5 under § 112, second paragraph, for being indefinite.

Rejection under § 102(b)
Claim 1

Issue 3: Did the Examiner err in finding that Tsai discloses forwarding the one or more processed messages to sending components that each sends processed messages to a communications medium, as set forth in claim 1?

Appellants contend that "the post-processing subsystem effects a fan-out in which a single message dequeued from the one or more internal message queues generates one or more processed messages and the one or more processed messages are forwarded to multiple sending components"

(App. Br. 21). Appellants further contend that "[b]y contrast, Tsai discloses a network bridge that simply transmits a message from a cell phone connected to a first wireless carrier to a cell phone connected to a second wireless carrier" (*id.*) and that "[t]here is no fan-out or branching in any of the message passes discussed in Tsai" (*id.* at 23).

The Examiner finds, and we agree, that "[A]ppellant[s'] claims are not limited to taking a single message and fanning it out toward multiple users" (Ans. 5) and "there could be two initial messages directed toward two different users, and these messages can be forwarded to the two different users" (*id.* at 6). For example, claim 1 merely recites, *forwards the one or more processed messages to sending components* (*see* claim 1). We find that such claim language does not necessarily require that a single processed message be fanned-out to multiple sending components. Claim 1 can also be read as multiple processed messages sent to multiple sending components. i.e., two processed messages sent to two different sending components, as proffered by the Examiner.

Consistent with the Examiner's interpretation, Tsai discloses in Figure 1 four devices, i.e., M1–M4, in a network in which messages are routed. The Examiner reasons, and we agree, that "[e]ven if these messages are forwarded on a one-to-one basis and not fanned out, Tsai reads on the broadest reasonable interpretation of the claims" (Ans. 7) because Tsai discloses forwarding a plurality of messages to a plurality of components. As written, Appellants' claim 1 does not require a fan-out of a single message to multiple recipients. "Construing claims broadly during prosecution is not unfair to the applicant . . . because the applicant has the opportunity to amend the claims to obtain more precise claim coverage." *In*

re Amer. Acad. of Sci. Tech Ctr., 367 F.3d 1359, 1364 (Fed. Cir. 2004). Here, we find that claim 1 as written, does not require any type of fan-out of messages in the post-processing subsystem. We further find that claim 1 does not necessarily require "group messaging" or "group addressing" as proffered by Appellants (*see* App. Br. 24–26), as claim 1 recites "directed to a group, subgroup, or user" (*see* claim 1). In other words, the message could be directed to a single user.

As for Appellants' contention that "the currently claimed automated communications system does not include wireless carrier networks, such as those described in Figures 2, 3, and 4 of Tsai" (App. Br. 27), the Examiner finds, and we agree, that the claimed system "are not restricted toward a single system with no outside networks involved" (Ans. 7). In other words, claim 1's automated communication system is not restricted from using external wireless carrier networks. Therefore, as noted by the Examiner, "the combination of such systems [in Tsai's Figure 1] can be interpreted as the claimed automated communication system" (*see* Ans. 7).

Accordingly, we sustain the Examiner's rejection of claim 1.

Rejection under § 103(a)
Claims 2–5

Issue 4: Did the Examiner err in finding that Fonesca teaches or suggests parsing the destination address into an ordered sequence of nodes, as set forth in claim 2?

Appellants contend "[i]n paragraph [0117] of Fonesca, Fonesca discusses parsing a message and assigning variables with values based on the content of the message, but does not teach, disclose, mention, or suggest parsing a destination address into an ordered sequence of nodes" (App. Br.

31). Appellants further contend that Fonesca is not "in any way related to the parsing of a destination address into an ordered sequence of nodes and considering the nodes with respect to authorization of a source address to send messages to the nodes" (*id.* at 30–31). We agree with Appellants.

In response to Appellants, the Examiner finds that Fonesca "inherently implies parsing a destination address, as the messages are filtered and processed accord[ing] to the recipient [and] [s]uch an action would not be possible without parsing out the destination addresses of the recipients" (Ans. 9). Regarding the Examiner's inherency conclusion, we note that "[i]nherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson,* 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted). Here, we find that the Examiner has merely shown that "parsing the destination address" *may result* in Fonesca. However, when relying upon a theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the Examiner's determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ2d 1461, 1463–64 (BPAI 1990). Here, the Examiner fails to provide facts and/or technical reasoning to support the conclusion that "parsing the destination address" necessarily flows from Fonesca's teachings, as one skilled in the art would recognize that there are various means for obtaining the destination address.

In view of the above discussion, we are of the opinion that the proposed combination of references set forth by the Examiner does not support the obviousness rejection. We, accordingly, do not sustain the

rejections of dependent claim 2, and dependent claims 3–5 for similar reasons.

DECISION

We affirm the Examiner's § 101 rejection of claims 1–5.

We affirm the Examiner's § 112, second paragraph, rejection of claims 1–5.

We affirm the Examiner's § 102(b) rejection of claim 1.

We reverse the Examiner's § 103(a) rejections of claims 2–5.

Since at least one rejection encompassing all claims on appeal is affirmed, the decision of the Examiner is affirmed.

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