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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/112,530	03/28/2002	Margaret G. MacPhail	AUS920010202US1	3697

65362 7590 08/01/2016
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EXAMINER

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ART UNIT	PAPER NUMBER
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2492

NOTIFICATION DATE	DELIVERY MODE
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08/01/2016

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARGARET G. MacPHAIL, DAVID B. KUMHYR, and
SEBASTIAN D. HASSINGER

Appeal 2015-002175
Application 10/112,530
Technology Center 2400

Before ST. JOHN COURTENAY III, JAMES W. DEJMEK, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–8, 10–20, 22–32, and 34–37. Claims 9, 21, and 33 are cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Invention

The invention on appeal “is directed to an automated service within a marketplace for electronic commerce.” (Spec. 2).

Representative Claim

1. A method for processing data for electronic business transactions, the method comprising:

[L1] *receiving* a document for an electronic business transaction **at an intermediate cloaking service** from a first entity in an electronic marketplace;

[L2] *retrieving* a **registered** set of cloaking preferences for the first entity;

modifying the document in accordance with the registered set of cloaking preferences to remove or hide information in the document that identifies the first entity; and

[L3] *forwarding* the modified document to a second entity in an electronic marketplace.

(Emphases and bracketed matter added regarding the contested limitations, labeled as L1, L2, and L3).

Rejections

A. Claims 1–5, 7, 8, 10–17, 19, 20, 22–29, 31, 32, and 34–36 are rejected under 35 U.S.C. § 102(e) as being anticipated by Redlich et al. (US 2002/0091975 A1; filed Dec. 6, 2001; published July 11, 2002) (“Redlich”).

B. Claims 6, 18, 30, and 37 are rejected under 35 U.S.C. § 103(a) over the combined teachings and suggestions of Redlich and Yehia et al. (US 2002/0091614 A1; filed Jan. 9, 2001; published July 11, 2002) (“Yehia”).

Grouping of Claims

Based on Appellants’ arguments, we decide the appeal of all claims rejected under anticipation rejection A on the basis of representative claim 1.

Based on Appellants' arguments, we decide the appeal of all claims rejected under §103 rejection B on the basis of representative dependent claim 6. *See* 37 C.F.R. § 41.37(c)(1)(iv).

ANALYSIS

We have considered all of Appellants' arguments and any evidence presented. We disagree with Appellants' arguments, and we adopt as our own: (1) the findings and reasons set forth by the Examiner in the Action from which this appeal is taken, and (2) the reasons and rebuttals set forth in the Answer in response to Appellants' arguments. (Ans. 13–26). However, we highlight and address specific findings and arguments for emphasis in our analysis below. We consider Appellants' arguments *seriatim* as they are presented in the principal Brief.

Anticipation Rejection A of Representative Claim 1

Limitation L1: Did the Examiner err in finding Redlich discloses [L1] ***receiving*** a document for an electronic business transaction ***at an intermediate cloaking service*** from a first entity in an electronic marketplace,” within the meaning of claim 1? ¹ (Emphasis added).

The Examiner finds Redlich discloses the claimed “intermediate cloaking service” as element 452 (an “intermediate” Application Service Provider (ASP) server), as depicted in Figure 6. (Final Act. 4).

¹ We give the contested claim limitations the broadest reasonable interpretation consistent with the Specification. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). *See Spec.* 29, ll. 24–27: “The description of the present invention has been presented for purposes of illustration *but is not intended* to be exhaustive or limited to the disclosed embodiments.”

Appellants contend, “[n]othing from Redlich teaches or suggests the claim requirements of an ‘intermediate cloaking service’ or ‘intermediate identity cloaking service’ which receives, modifies, and forwards a ‘document for an electronic business transaction’ that is received from a first entity in an electronic marketplace,” because “Redlich’s data security system describes an internal process for securely storing information . . . by the user, there is no use of an ‘intermediate cloaking service.’” (App. Br. 6).

The Examiner disagrees, and finds: “the ASP server of Redlich (see Fig. 6 item 452 *ASP server*) [shows] the ‘[intermediate cloaking] service’ in question.” (Ans. 14). The Examiner explains his claim construction: “‘Cloaking’ is reasonably interpreted as ‘hiding/removing from sight . . . [and] ‘[i]ntermediate’ is being interpreted as ‘between a source and destination.’” (*Id.* at 15).

At the outset, we find Appellants’ contentions are not commensurate with the scope of the claim. (*See* App. Br. 6). For example, claim 1 does not require the argued “‘intermediate cloaking service’ . . . which *receives, modifies, and forwards* a ‘document for an electronic business transaction.’” (App. Br. 6, *emphases added*).² Under a broad but reasonable interpretation, claim 1 merely requires the step or act of “receiving” to occur “*at an intermediate cloaking service*” (*emphasis added*), and not *by* an intermediate cloaking service. Contrary to Appellants’ contentions (*id.*), claim 1 is silent regarding *who or what* performs the recited steps or acts of *receiving, retrieving, modifying, and forwarding*.

² Independent claims 8, 13, 20, 25, and 32 each place various requirements on the recited “intermediate cloaking service,” none of which require all steps (or functions) to be performed by the “intermediate cloaking service.”

We conclude the Examiner’s interpretation of the claim terms “intermediate” and “cloaking” is reasonable. (Ans. 15). Because we find the receiving step is performed *at* Redlich’s ASP server 452 (Fig. 6) (or equivalent ASP server 152 (Fig. 2)), we are not persuaded the Examiner erred in finding Redlich discloses contested limitation L1. (See Redlich ¶ 148, referencing ASP 452 depicted in Fig. 6, *see also* Redlich ¶ 101, referencing ASP 152 depicted in Fig. 2).

Limitation L2: Did the Examiner err in finding Redlich discloses “retrieving a *registered set of cloaking preferences* for the first entity,” within the meaning of claim 1? (Emphasis added).

The Examiner finds Redlich discloses a filter that “separates extracted data (security sensitive items) from the remainder data” where the security sensitive items comprise a set of “cloaking preferences,” as claimed. (Final Act. 4, *citing* Redlich ¶ 85). The Examiner additionally finds Redlich’s description (¶ 101) of establishing a filter that is then “stored at a secured location on [ASP] server **152**” anticipates the claimed *registration* of the set of cloaking preferences. (*Id.*, *citing* Redlich ¶ 101).

Appellants urge: “there is not a single reference . . . in Redlich to a ‘set of cloaking preferences,’ much less . . . any . . . ‘registered set of identity cloaking preferences.’” (App. Br. 6).

However, an *ipsissimis verbis* test is not required. *In re Bond*, 910 F.2d 831, 832–33 (Fed. Cir. 1990) (citation omitted). “An anticipatory reference . . . need not duplicate word for word what is in the claims.” *Standard Havens Prods. v. Gencor Indus., Inc.*, 953 F.2d 1360, 1369 (Fed. Cir. 1991).

This reasoning is applicable here. The Examiner concludes the broadest reasonable interpretation of cloaking is “hiding/removing from sight.” (Ans. 15). The Examiner finds Redlich’s “filtering” to remove “names” in a document falls within the scope of the claimed “cloaking service” and intermediate (“identity”) cloaking service.³ (*Id.*). The Examiner restates his finding that “storing of the ‘filter’ on the server discloses *registration* with the server.” (*Id.* at 17, *citing* Redlich ¶ 101: “The filter may be stored . . . at a secured location on server 152.”).

Appellants reply by providing a series of *definitions* for the claim term “registered” to refute the Examiner’s finding that *storing the filter* would anticipate the claimed “registered set of cloaking preferences.” (Reply Br. 2).⁴

We do not find Appellants’ arguments persuasive. Appellants’ Specification is silent regarding any definition for the claimed “cloaking service” that would preclude the Examiner’s broad but reasonable interpretation.⁵ *See* n.1, *supra*. Applying the Examiner’s broad but reasonable interpretation of “cloaking” (Ans. 15), we find the *filter* of Redlich anticipates the claimed “cloaking service” because it removes *sensitive data* from the document (“*the system filters the plaintext and*

³ *See e.g.*, independent claims 8, 20, and 32, which alternatively recite an “intermediate *identity* cloaking service.” (Emphasis added).

⁴ *See* 37 C.F.R. §41.30 regarding citations to dictionaries.

⁵ Because “applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee.” *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) (citation omitted).

separates extracted data (security sensitive items) from the remainder data”). (See Redlich ¶ 84, emphasis added). Regarding the “security sensitive items” (*id.*), the Examiner refers to Redlich ¶ 84 and finds Redlich describes “***names of contracting parties are extracted and stored separate from [the] contract.***” (Final Act. 4, emphasis added).

We find the “security sensitive items” (e.g., names of contracting parties) in Redlich are “cloaking preferences” within the meaning of contested claim 1, limitation L2. See Redlich, ¶ 84: “The uncommon words (extracted-security sensitive words) . . . would be placed in an extracted text or extracted data file 106.” The “security sensitive words” (“cloaking preferences”) are described in further detail in Redlich’s paragraph 85, as cited by the Examiner. (Final Act. 4).

Moreover, we find Appellants’ proffered definitions of “register” to be overly narrow. See n.5 *supra*. When citing to WEBSTER’S NINTH NEW COLLEGIATE DICTIONARY, Appellants ignore the broader definition “*to record automatically.*”⁶ We conclude this broader definition is applicable to contested limitation L2 of claim 1, and reads on Redlich (¶ 84) where the security-sensitive words (i.e., cloaking preferences) are “placed in an extracted text or extracted data file 106,” (i.e., are recorded or *registered*). Therefore, on this record, and by a preponderance of the evidence, we are not persuaded the Examiner erred in finding Redlich’s descriptions of storing the filter (on the ASP server), and storing the associated security filter words (“cloaking preferences”), anticipate contested limitation L2. (Redlich ¶¶ 84–85, 101).

⁶ WEBSTER’S NINTH NEW COLLEGIATE DICTIONARY 992 (19th ed. 1991).

Limitation L3: Did the Examiner err in finding Redlich discloses “forwarding the modified document to a second entity in an electronic marketplace,” within the meaning of claim 1?

The Examiner finds Redlich’s descriptions of transmitting the document outside an organization, exchanging information between parties, and distributing the secured document, anticipate *forwarding the modified document*, as recited in contested limitation L3. (Final Act. 4, *citing* Redlich ¶¶ 36, 41, and 174).

Appellants contend that instead of disclosing the claimed *forwarding of the modified document*, Redlich “is used to securely store a filtered document 100 as extracted text 106 and common text or remainder data 104” and “describe[s] only the transmission and sharing of plaintext portion[s] of the document.” (App. Br. 7).

We are not persuaded by Appellants’ arguments. We broadly but reasonably interpret the claim term “forward” in this context, as being understood to mean “to send or ship onward from an intermediate post or station in transit.”⁷ We find Redlich discloses “the secured [(i.e., modified)] document or data object may be . . . *distributed*” to other users. (Redlich ¶ 174, *emphasis added*). (Final. Act. 4). Given this evidence (*id.*), we are not persuaded the Examiner erred in finding Redlich anticipates contested limitation L3.

For the aforementioned reasons, on this record and based upon a preponderance of the evidence, we sustain the Examiner’s rejection A of representative independent claim 1, and grouped claims 2–5, 7, 8, 10–17, 19,

⁷ WEBSTER’S NINTH NEW COLLEGIATE DICTIONARY (19th ed. 1991) (page 486).

20, 22–29, 31, 32, and 34–36, also rejected under rejection A, which fall with claim 1. (*See* Grouping of Claims, *supra*).

Rejection B of claims 6, 18, 30, and 37 under 35 U.S.C. § 103(a)

Issue: Did the Examiner err in finding the combination of Redlich and Yehia would have taught or suggested “wherein the document is formatted in accordance with an ebXML (electronic business extensible Markup Language) specification,” within the meaning of dependent claim 6? ⁸

Combinability under 35 U.S.C. § 103(a)

As a threshold matter, we decide the question of whether the Examiner erred by improperly combining the cited references under 35 U.S.C. § 103(a). Regarding this issue, Appellants raise three principal arguments:

Appellants initially allege the “deficiency in [the Examiner’s] proffered ‘motivation’ is that the stated goals could be met without using ebXML-formatted documents.” (App. Br. 12).

However, the contested limitation merely requires “wherein the document is formatted in accordance with an ebXML (electronic business extensible Markup Language) specification.” (Claim 6). Redlich teaches the document is formatted in accordance with an XML specification. (Redlich ¶ 30). Additionally, as found by the Examiner, Yehia teaches the use of ebXML formatted documents. (Final Act. 12, *citing* Yehia ¶ 138).

Given this evidence, we conclude that replacing the XML document of Redlich with the ebXML document of Yehia would have been an obvious

⁸ Claims 18, 30, and 37 are similar or commensurate in scope with claim 6.

substitution to an artisan possessing an ordinary level of skill in the art, because we find such replacement would have *merely yielded predictable results*. The Supreme Court guides the “combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007).⁹

This reasoning is applicable here. Because we find the “ebXML specification” recited in claim 6 was a well-known markup language specification used for electronic business (as evidenced by Yehia at ¶ 138), we find ebXML could have been readily substituted for the generic XML specification used by Redlich (¶ 30). Appellants have not presented sufficient arguments or evidence to persuade us that such substitution would have required a major change in the functionality of either reference. We find incorporating the ebXML specification of Yehia (¶138) would have merely improved upon the use of XML by Redlich (¶ 30).

Appellants additionally urge: “the Examiner’s proposed combination of Redlich’s distributed storage system with Yehia would clearly render Yehia’s scheme unsatisfactory for its intended purpose” and the references “would never b[e] combined without doing *irreparable violence* to Yehia’s disclosure” (App. Br. 13, *emphasis added*).

We find Appellants have mischaracterized the requirements for combining prior art. Our reviewing court has held that when the combination would render the prior art *being modified* “inoperable for its

⁹ The skilled artisan would “be able to fit the teachings of multiple patents together like pieces of a puzzle” since the skilled artisan is “a person of ordinary creativity, not an automaton.” *KSR*, 550 U.S. at 420–21.

intended purpose” then the references cannot be combined.¹⁰ This test is unconcerned with any “*irreparable violence*” against the modifying reference. Further, Appellants have provided no evidence of such “*irreparable violence*,” but merely asserted that it would occur.¹¹ Therefore, we do not find Appellants’ argument persuasive.

Finally, Appellants contend there is no *prima facie* showing of a *reasonable likelihood of success* from the combination of cited references because “[t]he rejection analysis set forth in the Office Action is entirely silent on the question of whether there is a reasonable expectation of success.” (App. Br. 14).

However, “[o]bviousness does not require absolute predictability of success . . . *all that is required is a reasonable expectation of success.*” *In re Kubin*, 561 F.3d 1351, 1360 (Fed. Cir. 2009) (citing *In re O’Farrell*, 853 F.2d 894, 903–04 (Fed. Cir. 1988) (internal bracketing omitted)).

Here, Appellants present no contrary evidence to show the likelihood of success would have been unattainable or unreasonable. *See* MPEP §2143.02(II). Moreover, Appellants present no evidence that combining the teachings and suggestions of the cited references would have been “uniquely challenging or difficult for one of ordinary skill in the art.” *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (*citing* KSR, 550 U.S. at 418).

¹⁰ *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984).

¹¹ The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602 (CCPA 1965); *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997).

On this record, we find the Examiner’s proffered combination of familiar prior art acts and/or elements according to their established functions would have conveyed a reasonable expectation of success to a person of ordinary skill having common sense at the time of the invention. Therefore, we find an artisan would have had sufficient motivation to improve or complement the XML teachings of Redlich, with the more specialized business ebXML specification described by Yehia (¶ 138), accompanied by a *reasonable* expectation of achieving what is claimed. (Claim 6).

For the aforementioned reasons, we do not find persuasive Appellants’ arguments that the references have been improperly combined by the Examiner.

Contested Limitation under § 103 (Representative Claim 6).

As found by the Examiner and discussed above, Yehia (¶ 138) teaches use of the ebXML specification. (Final Act. 12). To the extent Appellants contend the addition of Yehia fails to cure the previously argued purported deficiencies of Redlich (App. Br. 8–12), we find Appellants’ contention is grounded on an erroneous premise — that Redlich fails to disclose (or suggest under §103 rejection B) contested limitations L1, L2, and L3.¹² Therefore, we find this argument regarding anticipation rejection A of claim 1 (over Redlich) unpersuasive for the reasons discussed above.

On this record, we find a preponderance of the evidence supports the Examiner’s underlying factual findings and legal conclusion of obviousness

¹² “[A]nticipation is the epitome of obviousness.” *Jones v. Hardy*, 727 F.2d 1524, 1529 (Fed. Cir. 1984) (citation omitted).

regarding claim 6. Because Appellants have not persuaded us the Examiner erred, we sustain § 103 rejection B of representative claim 6. Grouped claims 18, 30, and 37 (not argued separately) fall with claim 6.

Reply Brief

To the extent Appellants advance new arguments in the Reply Brief not in response to a shift in the Examiner's position in the Answer, we note arguments raised in a Reply Brief that were not raised in the Appeal Brief or are not responsive to arguments raised in the Examiner's Answer will not be considered except for good cause. *See* 37 C.F.R. § 41.41(b)(2).

DECISION ¹³

We affirm the Examiner's rejections of claims 1–8, 10–20, 22–32, and 34–37.

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 41.50(f).

AFFIRMED

¹³ In the event of further prosecution, we leave it to the Examiner to consider whether at least independent claims 1, 8, 13, 20, 25, and 32 should be rejected under 35 U.S.C. § 101, to the extent these claims are directed to an idea of itself, e.g., performance of business transactions. Abstract ideas have been identified by the courts by way of example, including fundamental economic practices, certain methods of organizing human activities, an idea “of itself,” and mathematical relationships/formulas. *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2355–56 (2014). Although, the Board is authorized to reject claims under 37 C.F.R. § 41.50(b), no inference should be drawn when the Board elects not to do so. *See Manual of Patent Examining Procedure* (MPEP) § 1213.02 (9th Ed., Rev. 7, Nov. 2015).