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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MATTHEW DENESUK, DANIEL FREDERICK GRUHL,
SRIDHAR RAJAGOPALAN, and ANDREW S. TOMKINS

Appeal 2015-002298
Application 13/526,424
Technology Center 2100

Before ROBERT E. NAPPI, CARL L. SILVERMAN, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

HOWARD, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants¹ appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 31–35, 38–42, and 56–60, which constitute all of the claims pending in this application. Claims 1–30, 36, 37, and 43–55 have been cancelled. App. Br. 10, 11, 14. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Appellants identify International Business Machines Corporation as the real party in interest. App. Br. 2.

THE INVENTION

The claimed invention is directed to a knowledge-based data mining system. Abstract, Spec. p. 1.

Claim 31, reproduced below, is illustrative of the claimed subject matter:

31. A method for collecting and associating unstructured data, comprising:

receiving a plurality of documents, the documents comprising entities of interest that consist of one or more of a person, a date, a company, an institution, an event or a location;

analyzing, by a processor, the plurality of documents to identify the entities of interest, wherein a direct linkage does not exist between at least a first and a second identified entity of interest;

determining from the plurality of documents a bridging entity consisting of one of a person, a date, a company, an institution, an event or a location, wherein:

a first direct linkage exists between the first identified entity of interest and the bridging entity; and

a second direct linkage exists between the second identified entity of interest and the bridging entity;

periodically determining if another bridging entity exists, wherein a plurality of data miners use rules to process the entities and append respective keys to the entities representing characteristics of the entities as derived from rules embodied in the data miners, whereby characteristics of the entities are defined by expert authors of the data miners are identified for use in responding to data requests from customers.

REFERENCE

The prior art relied upon by the Examiner as evidence in rejecting the claims on appeal is:

Tamayo

US 2005/0102292 A1 May 12, 2005

REJECTION

Claims 31–35, 38–42, and 56–60 stand rejected under (pre-AIA) 35 U.S.C. § 102(e) as being anticipated by Tamayo. Final Act. 2–5.

ANALYSIS

We have reviewed the Examiner’s rejection in light of Appellants’ arguments that the Examiner erred. In reaching this decision, we have considered all evidence presented and all arguments made by Appellants. We are not persuaded by Appellants’ arguments that the Examiner erred in rejecting claims 31–35, 38–42, and 56–60.

Appellants argue Tamayo does not disclose “determining from the plurality of documents a bridging entity consisting of one of a person, a date, a company, an institution, an event or a location,” as recited in claim 31. App. Br. 6–8. According to Appellants, buying a banana cannot be a bridging event “because it is not a person, a date, a company, an institution, an event or a location, as required by the claims.” App. Br. 7; *see also* Reply Br. 2. Instead, Appellants argue a banana is a product. *Id.* Appellants further argue that the Examiner’s claim construction is not consistent with the specification. App. Br. 7–8 (quoting Spec. ¶¶ 57–60).

The Examiner find Tamayo discloses the determining limitation recited in claim 31. Final Act. 3 (citing Tamayo ¶ 170); Ans. 3. Specifically, the Examiner finds Tamayo teaches buying a banana is a bridging event that links Joe and Jim. *Id.* The Examiner further finds buying a banana is an event as recited in claim 31. *Id.*

During prosecution, claims must be given their broadest reasonable interpretation while reading claim language in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). However, we will not read limitations from the specification into the claims. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993). Any special meaning assigned to a term “must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.” *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998); *see also Helmsderfer v. Bobrick Washroom Equip., Inc.*, 527 F.3d 1379, 1381 (Fed. Cir. 2008) (“A patentee may act as its own lexicographer and assign to a term a unique definition that is different from its ordinary and customary meaning; however, a patentee must clearly express that intent in the written description.”). Absent an express intent to impart a novel meaning to a claim term, the words take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art. *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 (Fed. Cir. 2003).

Regardless of the general contentions and imputed intended meanings articulated by Appellants in the Appeal Brief, “[i]t is the *claims* that measure the invention.” *See SRI Int’l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (en banc) (citations omitted).

Though understanding the claim language may be aided by the explanations contained in the written description, it is important not to import into a claim limitations that are not a part of the claim. For example, a particular embodiment appearing in the

written description may not be read into a claim when the claim language is broader than the embodiment.

SuperGuide Corp. v. DirecTV Enters, Inc., 358 F.3d 870, 875 (Fed. Cir. 2004) (citing *Electro Med. Sys. S.A. v. Cooper Life Sci., Inc.*, 34 F.3d 1048, 1054 (Fed. Cir. 1994)). “[A]lthough the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments. . . . [C]laims may embrace ‘different subject matter than is illustrated in the specific embodiments in the specification.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc) (citations omitted).

Appellants have not persuaded us the Examiner erred in finding buying a banana to be an event as recited in claim 31. We have reviewed the sections of the Specification cited by Appellants and do not find a special definition of the term event. Accordingly, we use the ordinary meaning of the term, which is broad enough to encompass buying a banana. Because Appellants’ arguments are not commensurate with the scope of the claims, they are unpersuasive. *See In re Self*, 671 F.2d 1344, 1348 (CCPA 1982).

Appellants also argue the Examiner did not provide sufficient information in its rejection of the periodically determining and wherein limitations recited in claim 31. Appellants argue the Examiner cites one hundred and twenty-four paragraphs and does not provide a full and fair opportunity to address the Examiner’s rejection.

In the Final Action, the Examiner finds Tamayo discloses the periodically determining and wherein limitations recited in claim 31. Final Act. 3–4 (citing Tamayo ¶¶ 73–197). In the Answer, the Examiner relies on only three paragraphs from the original range—paragraphs 82, 84, and 86—

to support the finding that Tamayo teaches the periodically determining and wherein limitations recited in claim 31. Ans. 3–4.

In response to the limited citations set forth in the Answer, Appellants argue the Answer should be considered a new ground of rejection. Reply Br. 4. Appellants further contend that the cited sections do not disclose the disputed claim limitation. *Id.*

We are not persuaded by Appellants’ arguments. As our reviewing Court has held, “all that is required of the office to meet its prima facie burden of production is to set forth the statutory basis of the rejection and the reference or references relied upon in a sufficiently articulate and informative manner as to meet the notice requirement of [35 U.S.C.] § 132.” *In re Jung*, 637 F.3d 1356, 1363 (Fed. Cir. 2011). We have reviewed the Examiner’s Answer (Ans. 3–4) and conclude that the notice requirement is satisfied in this case by “the examiner’s discussion of the theory of invalidity . . . , the prior art basis for the rejection . . . , and the identification of where each limitation of the rejected claims is shown in the prior art reference by [paragraph] number.” *Jung*, 637 F.3d at 1363. The citation of three paragraphs does not impose an undue burden on the Appellants so that they do not have a full and fair opportunity to respond.

Additionally, Appellants contention that the Examiner erred by not designating a new ground of rejection does not persuaded us the Examiner erred. Appellants did not file a petition to request that the Answer should be designated a new ground of rejection and that prosecution should be reopened. *See* 37 C.F.R. § 41.40(a); *see also* MPEP 1207.03(b) (A petition should be filed “if an appellant feels an answer includes a new ground of rejection that has not been designated as such and wishes to reopen

prosecution.”). Instead, by filing a Reply Brief, Appellants elected to maintain the appeal. *Id.*

Finally, besides the new ground of rejection argument discussed above, Appellants’ argument consists essentially of quoting the claim language twice and a naked assertion that the corresponding limitation is not present in the prior art:

In the Examiner's Answer, the Examiner **for the first time**, has pointed to paragraphs [0082], [0084] and [0086] with specificity to assert that they teach the claimed step of periodically determining if another bridging entity exists, wherein a plurality of data miners use rules to process the entities and append respective keys to the entities representing characteristics of the entities as derived from rules embodied in the data miners, whereby characteristics of the entities are defined by expert authors of the data miners are identified for use in responding to data requests from customers. First, Applicants respectfully submit that this should constitute a new ground of rejection since this is the first time that the Examiner has identified with the required particularity the portion of Tamyo that he contends teaches this claim limitation. *In addition, Applicants respectfully submit that the cited portions of Tamyo fail to teach or disclose periodically determining if another bridging entity exists, wherein a plurality of data miners use rules to process the entities and append respective keys to the entities representing characteristics of the entities as derived from rules embodied in the data miners, whereby characteristics of the entities are defined by expert authors of the data miners are identified for use in responding to data requests from customers.*

Reply Br. 4 (bold underline in original, bold italics added). That is insufficient to raise an argument that that Examiner erred. *See In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (Rule 41.37 requires “more substantive arguments in an appeal brief than a mere recitation of the claim

elements and a naked assertion that the corresponding elements were not found in the prior art.”); *see also* 37 C.F.R. § 41.37(c)(1)(iv) (“A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.”). Because Appellants have not identified any specific errors in the Examiner’s findings, “the Board will not, as a general matter, unilaterally review those uncontested aspects of the rejection.” *Frye*, 94 USPQ2d at 1075.

Accordingly, we sustain the Examiner’s rejection of claim 31, along with the rejection of claims 38 and 56, which are argued on the same grounds, and dependent claims 32–35, 39–42, and 57–60, which are not argued separately.²

² In the event of further prosecution, including any review for allowance, we invite the Examiner’s attention to the question of whether the claims are patent-eligible under 35 U.S.C. § 101. *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355-56 (2014). Regarding at least method claim 31, but for the recitation of a processor, a question arises as to whether a person would be capable of performing the contested steps or acts as mental steps, or with the aid of pen and paper. *See CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1375 (Fed. Cir. 2011) (“That purely mental processes can be unpatentable, even when performed by a computer, was precisely the holding of the Supreme Court in *Gottschalk v. Benson*”). Moreover, “a method that can be performed by human thought alone is merely an abstract idea and is not patent-eligible under § 101.” *CyberSource*, 654 F.3d at 1373. We have decided the issues before us. We leave further consideration of this § 101 issue to the Examiner.

We further invite the Examiner to consider whether the whereby clause of the independent claims—specifically “characteristics of the entities *are defined by expert authors of the data miners are identified for use in responding to data request from customers*”—and the data miner limitation of claim 35—“*a data miner comprising a processor that executes*

DECISION

For the above reasons, we affirm the Examiner's decision rejecting claims 31–35, 38–42, and 56–60.

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

instructions from *a data miner*”—are indefinite under section 112, second paragraph.