UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Ex parte GREGORY LEITHEISER

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Appeal 2015-002530
Application 12/403,398
Technology Center 2100

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Before JOSEPH L. DIXON, ST. JOHN COURTENAY III, and
KRISTEN DROESCH, *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 1–4, 6–10, and 13–19. Claims 5, 11, and 12 are
canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We Affirm.

Invention

The disclosed and claimed invention on appeal "relates generally to
communications networks, and, more particularly, to web applications
available over communications networks." (Spec. ¶ 1).

Representative Claim 1

1. A method of providing user information to web applications, the method comprising:

serving a web page including an embedded widget to a client associated with a user from a web application server, wherein the widget is operable when executed to retrieve user information from a user information web server wherein the user information comprises personal identifying information;

[L] *responsive to receiving the user information from the user information web server, providing the user information to the web application to authenticate the user to the web application.*

(Emphasis and bracketed lettering added to highlight contested limitation L.)

Rejection

Claims 1–4, 6–10, and 13–19 are rejected under 35 U.S.C. § 102(e) as anticipated by Chen et al. (US 2009/0287559A1; pub. Nov. 19, 2009).

Grouping of Claims

Based on Appellant's arguments, we decide the appeal of claims 1, 4, 6–10, and 13–19 on the basis of representative independent claim 1. We address dependent claims 2 and 3, *infra*. *See* 37 C.F.R. § 41.37(c)(1)(iv).

ANALYSIS

We have considered all of Appellant's arguments and any evidence presented. We disagree with Appellant's 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 Appellant's arguments. (Ans. 2–6). However, we highlight and address specific findings and arguments for emphasis in our analysis below.

Rejection of Independent Claim 1 under 35 U.S.C. § 102(e)

<u>Issue</u>: Under 35 U.S.C. § 102(e), did the Examiner err in finding
Chen expressly or inherently discloses contested limitation L:

> [L] *responsive to receiving the user information from the user
> information web server, providing the user information to the
> web application to authenticate the user to the web application*[,]

within the meaning of claim 1? [1] (Emphasis added).

At the outset, we broadly but reasonably construe the claim language
"*providing the user information to the web application* **to authenticate the
user to the web application**" as a statement of intended purpose. [2] Because
claim 1 does not positively recite the "user information" is *actually used* by
"the web application" to authenticate the user, we conclude the contested
language is directed to an *intended future step or act of authentication* that is

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[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 e.g.,* Spec. (¶ 41) ("Many variations and
modifications can be made to the preferred embodiments without
substantially departing from the principles of the present invention. *All
such variations and modifications are intended to be included herein within
the scope of the present invention, as set forth in the following claims.*").
(Emphasis added).

[2] "An intended use or purpose usually will not limit the scope of the claim
because such statements usually do no more than define a context in which
the invention operates." *Boehringer Ingelheim Vetmedica, Inc. v. Schering-
Plough Corp.*, 320 F.3d 1339, 1345 (Fed. Cir. 2003). Although "[s]uch
statements often . . . appear in the claim's preamble," *In re Stencel*, 828 F.2d
751, 754 (Fed. Cir. 1987), a statement of intended use or purpose can appear
elsewhere in a claim. *Id.*

not required to be performed, within the scope of claim 1. [3]

Regarding the claim construction of the contested portion of limitation L ("to authenticate the user to the web application"), Appellant relies on two extrinsic dictionary definitions,[4] and contends, inter alia: "[b]oth [dictionary] entries emphasize the *verification of a user's identity*. Chen cannot anticipate providing information to authenticate a user because *authentication entails the verification of the user's identity* and Chen expressly embraces the *conceptually opposing concept* of maintaining a user's individual privacy." [5] (App. Br. 6, emphasis added).

However, the Examiner disagrees (Ans. 3–4):

> . . . Appellant's interpretation of the word "authentication" above and use in claim 1 requires only that the provided user information is sufficient to authenticate the user to the web application. As such, Appellant's interpretation of "authenticate" is aligned with the Examiner's interpretation presented in the Response to Arguments in the Final Rejection of April 12, 2012 (¶23-24), wherein the Examiner [found] that Chen's provision of personally identifying information to the widget is required for the widget to provide advertising specific to the user, i.e. the user's identity is determined, i.e. verified, from their profile and

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[3] 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).

[4] *See* 37 C.F.R. § 41.30 regarding dictionaries, "which may be cited before the Board."

[5] Our reviewing court guides: "[a] reference is no less anticipatory if, after disclosing the invention, the reference then disparages it . . . . [T]he question whether a reference 'teaches away' from the invention is inapplicable to an anticipation analysis." *Celeritas Techs., Ltd. v. Rockwell Int'l Corp.*, 150 F.3d 1354, 1361 (Fed. Cir. 1998).

that information is used to serve the user with relevant advertising.

Specifically, Chen discloses gathering a *user's identifying information and storing this data as the user's user profile* (¶ 62: a user's usage data is stored at a server as a user profile and *the user profile is sufficient enough to determine a first user from a second user, ex. a user who's usage is related to electronics is not a user who collects sports memorabilia*). *This user's identifying information, i.e. the user's profile*, is then requested by a widget at the user's client in order for the widget to serve correct relevant information to the specific user (¶ 64: widget server retrieves the user's profile [and] uses it to provide relevant data to the widget, i.e. the user is determined by the widget through the user's specific information).

Therefore, Chen clearly anticipates authenticating a user to a widget by providing user information to the widget by providing user identifying information to the web application in order for the web application to use said data to provide correct data to the user. . . .

(Paragraph breaks added, emphasis added).

This appeal turns upon claim construction. We note claim 1 is silent regarding the argued *"verification of the user's identity."* (App. Br. 6, emphasis added). Turning to the Specification for *context*, we find non-limiting descriptions of *exemplary embodiments* of the widget that performs the claimed authentication. For example, see paragraph 30 of the Specification (with emphasis added):

> The user information widget 16 is also configured to perform various verification and authentication functions. *For example*, the user information widget 16 is configured to request user permission to retrieve user information from the repository 14 in response to a request by a web application 42 for user information. The user information widget 16 also is configured to request *user verification of retrieved information prior to*

> *providing the retrieved information* to the requesting web
> application 42. **For example**, if the widget 16 retrieves a credit
> card number from the repository 14, the widget 16 requests the
> user to verify the accuracy of the credit card number before
> providing the credit card number. *In addition, the user*
> *information widget 16 is configured to authenticate a user prior*
> *to retrieving user information from the repository 14. The user*
> *information widget 16 authenticates a user by requesting*
> *credentials (e.g., user identification and/or password) from the*
> *user and verifying that the received credentials are valid for the*
> *user.*

Although Appellant's Specification discloses *exemplary embodiments*
of the claimed invention, *absent a definition or express disclaimer*, the scope
of the claims is not limited to those particular embodiments. [6] We decline
Appellant's invitation to read limitations from the Specification into claim 1.

Although we have fully considered the extrinsic *dictionary definitions*
proffered by Appellant, which require verification of a user's identity for
authentication (App. Br. 6), we particularly note dependent claim 3 further
limits the scope of independent claim 1 (via claim 2 which depends directly

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[6] *See Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1346–47 (Fed. Cir.
2015) ("This court has repeatedly 'cautioned against limiting the claimed
invention to preferred embodiments or specific examples in the
specification.'") (quoting *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d
1313, 1328 (Fed. Cir. 2002)). *See also SuperGuide Corp. v. DirecTV Enter.,*
Inc., 358 F.3d 870, 875 (Fed. Cir. 2004) (a particular embodiment appearing
in the written description may not be read into a claim when the claim
language is broader than the embodiment.); *Liebel-Flarsheim Co. v. Medrad,*
Inc., 358 F.3d 898, 906 (Fed. Cir. 2004) (discussing cases wherein the court
expressly rejected the contention that even if a patent describes only a single
embodiment, the claims of the patent are not construed as being limited to
that embodiment).

from claim 1):

> 3. The method of claim 2, wherein authenticating the user to the widget comprises receiving a user identification and password from the user and *verifying that the user identification* and password received are *valid for the user.*

(Claim 3, emphasis added).

Our reviewing court guides: "[w]hen different words or phrases are used in separate claims, a difference in meaning is presumed." *Nystrom v. TREX Co., Inc.*, 424 F.3d 1136, 1143 (Fed. Cir. 2005). Under the doctrine of claim differentiation, "the presence of a dependent claim that adds a particular limitation gives rise to a presumption that the limitation in question is not present in the independent claim." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005). This "presumption is especially strong when the limitation in dispute is the only meaningful difference between an independent and dependent claim, and one party is urging that the limitation in the dependent claim should be read into the independent claim." *SunRace Roots Enterprise Co., Ltd. v. SRAM Corp.*, 336 F.3d 1298, 1303 (Fed. Cir. 2003).

This reasoning is applicable here. Because the language of dependent claim 3 (*verifying that the user identification . . . [is] valid for the user*) further limits the contested limitation of "providing the user information to the web application to *authenticate the user* to the web application" (claim 1), there is a strong presumption under the doctrine of claim differentiation that the *authentication* recited in claim 1 is *not* limited to *verifying that the user identification is valid for the user,* as required by the language of dependent claim 3.

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Thus, we find Appellant is impermissibly reading the narrowing limitations recited in dependent claim 3 into broader independent claim 1. (App. Br. 6). *See Nystrom*, 424 F.3d at 1143 ("[w]hen different words or phrases are used in separate claims, a difference in meaning is presumed."). Therefore, on this record, we are not persuaded the Examiner's interpretation of claim 1 is overly broad, unreasonable, or inconsistent with the Specification. *See* n.3, *supra*.

For these reasons, and on this record, we find a preponderance of the evidence supports the Examiner's finding of anticipation regarding the contested language of independent claim 1. Because Appellant has not persuaded us the Examiner erred, we sustain the rejection of representative claim 1, and the rejection of the associated grouped claims, which fall with claim 1. *See* Grouping of Claims, *supra*.

Rejection of Dependent Claim 2

Appellant advances no separate, *substantive* arguments for dependent claim 2. Instead, Appellant recites the language of the claim, points to the evidence relied on by the Examiner, and merely asserts: "[n]owhere does Chen expressly or inherently disclose authenticating a user to its widget." (App. Br. 7). [7] Arguments not made are considered waived. [8]

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[7] *See In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) ("[W]e hold that the Board reasonably interpreted Rule 41.37 to require 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.").

[8] *See* 37 C.F.R. § 41.37(c)(1)(iv)("Under each heading identifying the ground of rejection being contested, any claim(s) argued separately or as a

Therefore, we sustain the rejection the dependent claim 2.

Rejection of Dependent Claim 3

Claim 3 recites:

> The method of claim 2, wherein authenticating the user to the widget comprises receiving a user identification and password from the user and verifying that the user identification and password received are valid for the user.

Appellant points to Chen (¶ 105) and urges: "Nowhere does Chen expressly or inherently disclose receiving a user identification and password from the user and verifying that the user identification and password are valid." (App. Br. 7).

The Examiner disagrees, and finds:

> Chen clearly discloses authenticating the user to the customizable widget by using a user account to sign into the widget server using a password (¶[¶]105-106: the user signs into an account to retrieve the customizable widgets, ¶62 the toolbar collects the user data and profiles to provide to the server which are later used by the widgets to verify the user and retrieve the correct relevant information, Fig. 9 user can protect his customized widgets from the toolbar by password protecting them). As such, Chen discloses the use of a username, i.e. user account, and password to authenticate the user to the widget by providing the widget with the user's profile information after the user is authenticated to the toolbar.

(Ans. 5, emphasis added).

Because Chen (¶ 105) expressly describes "no customizable button is

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subgroup shall be argued under a separate subheading that identifies the claim(s) by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.").

displayed until the user signs into an account," we find a preponderance of the evidence supports the Examiner's rejection of claim 3.

Reply Brief

To the extent Appellant advances 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).

Conclusion

For at least the aforementioned reasons, on this record, we are not persuaded the Examiner erred. We find a preponderance of the evidence supports the Examiner's finding of anticipation for all contested claims on appeal. [9]

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[9] Regarding independent claim 15, Appellant appears to have replaced the term "*means* for " with the "nonce" word "user information <u>widget</u>" thereby connoting a *single* generic "black box" for performing *all* of the intended functions recited in independent claim 15. We conclude "widget" may be interpreted as a *nonce word* substituting for the term "means." *See Williamson*, 792 F.3d at 1349 (Fed. Cir. 2015) (en banc) ("we should abandon characterizing as 'strong' the presumption that a limitation lacking the word 'means' is not subject to § 112, para. 6."). *Cf. with id.* at 1350 ("'[m]odule' is a well-known nonce word that can operate as a substitute for 'means' in the context of § 112, para. 6").

In the event of further prosecution, and to the extent that "widget" is a nonce word that fails to have a *sufficiently definite meaning* as the name for a *particular structure* capable of performing the recited functions, we leave it to the Examiner to consider whether claim 15 should be rejected under pre-AIA 35 U.S.C. § 112, second paragraph, as being indefinite (if the "widget" is construed as a "means" under pre-AIA § 112, sixth paragraph,

DECISION [10]

We affirm the Examiner's rejection of claims 1–4, 6–10, and 13–19 under 35 U.S.C. § 102(e). 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

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and if no corresponding structure is found in the Specification), and/or under pre-AIA 35 U.S.C. § 112, first paragraph, as a *single means* which is *non-enabling for the scope of the claim. See* MPEP § 2164.08(a). *See also In re Hyatt*, 708 F.2d 712, 714–15 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held non-enabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). 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.

[10]   In the event of further prosecution, we leave it to the Examiner to consider an additional rejection under 35 U.S.C. § 101 regarding claim 15. The "user information <u>widget</u>" recited in claim 15 appears to be directed to software per se, i.e., a purely software "widget." Disembodied software in itself, with no structural tie to an article of manufacture, machine, process, or composition of matter, is not patentable subject matter. "Abstract software code is an idea without physical embodiment." *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437, 449 (2007). Software *per se,* or a computer program *per se,* does not fall within a statutory class (not a process, machine, manufacture, or composition of matter). "The four categories [of § 101] together describe the exclusive reach of patentable subject matter. If a claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful." *In re Nuijten*, 500 F.3d 1346, 1356–57 (Fed. Cir. 2007). *See also* MPEP § 2106(I)(iv) (listing examples of claims that are not directed to one of the statutory categories: "a computer program *per se*") (citing *Gottschalk v. Benson*, 409 U.S. 63, 72 (1972)). 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* MPEP § 1213.02.