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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte AMANDA E. CHESSELL and
ANDREW J. STANFORD-CLARK¹

Appeal 2015-006151
Application 12/266,737
Technology Center 2100

Before MICHAEL J. STRAUSS, DANIEL N. FISHMAN, and
JAMES W. DEJMEK, *Administrative Patent Judges*.

STRAUSS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1, 4–8, 18, and 20–28. Claims 2, 3, 9–17, and 19 have been cancelled. App. Br. 15, 17–18. We have jurisdiction over the remaining pending claims 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.

STATEMENT OF THE CASE

Introduction

Appellants' invention is directed to modifying a message upon determining the message contains a scope sensitive field. Abstract.

Claim 1 is representative of the subject matter on appeal and is reproduced below with the disputed limitations emphasized in *italics*:

1. A method for modifying a message to account for scope sensitive fields of the message, the method comprising:

receiving the message from a first entity directed to a second entity over a computer communications network, *the message comprising data fields with at least one data field able to be populated with content of different levels of detail including a first level of detail appropriate to the first entity;*

determining, by a computer, whether the at least one data field of the message includes a scope sensitive field by accessing a data schema associated with the message, the data schema indicating which of the data fields of the message are scope sensitive;

responsive to determining that the at least one data field of the message contains the scope sensitive field, transforming the scope sensitive field by populating the scope sensitive field with content of a second level of detail appropriate to the second entity; and,

transmitting the message including the transformed scope sensitive field to the second entity.

The Examiner's References and Rejections

Claims 1, 4–8, 18, and 20–28 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Final Act. 3–8.

Claims 1, 4–8, 18, and 20–28 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that the applicant regards as the invention. Final Act. 8–10.

Claims 1, 4–6, 8, 18, 20–22, and 24–26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Abjanic et al. (US 2003/0069975 A1; Apr. 10, 2003) (“Abjanic”) and Phippen et al. (US 2001/0049743 A1; Dec. 6, 2001) (“Phippen”). Final Act. 10–20.

Claims 7 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Abjanic, Phippen, and Williams (US 5,251,314; Oct. 5, 1993). Final Act. 20–23.

Claims 27 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Abjanic, Phippen, and Birk et al. (US 2005/0278790 A1; Dec. 15, 2005) (“Birk”). Final Act. 23–25.

ANALYSIS²

Rejections under 35 U.S.C. § 112, first paragraph

Claims 1, 4, 18, 20

Claim 1 recites, *inter alia*, “data fields with at least one data field able to be populated with content of different levels of detail” and “the data schema indicating which of the data fields of the message are scope sensitive.” The Examiner finds these features are not supported by the

² In this Opinion, we refer to Appellants’ Appeal Brief (“App. Br.,” filed January 21, 2015); Appellants’ Reply Brief (“Reply Br.,” filed May 29, 2015); the Final Office Action (“Final Act.,” mailed August 28, 2014); and the Examiner’s Answer (“Ans.,” mailed April 7, 2015).

original disclosure and, therefore, claims 1, 4–8, 18, and 20–28 fail to comply with the written description requirement. Final Act. 3–4. In particular, the Examiner interprets these two recitations as collectively encompassing data fields that are *not* able to be populated with content of different levels of detail when the number of “at least one data field” is not equal to the number of “data fields.” *See* Ans. 3–4; *see also* Final Act. 4. In other words, the Examiner’s findings assume if there is only “at least one” data field able to be populated as claimed, there must be some other fields that are *not* able to be so populated and the Examiner finds no support for such fields. The Examiner concludes, “one skilled in the art would not reasonably conclude based on Figure 4a that the inventor had possession of data fields which are *not* able to be populated with content of different levels of detail.” Ans. 3 (emphasis added). Appellants contend support for the two limitations at issue is found in Figure 4a and paragraphs 10, 37, and 38 of the Specification. App. Br. 6; Reply Br. 2–3).

We are persuaded by Appellants’ contention. Figure 4a of Appellants’ Specification is reproduced below.

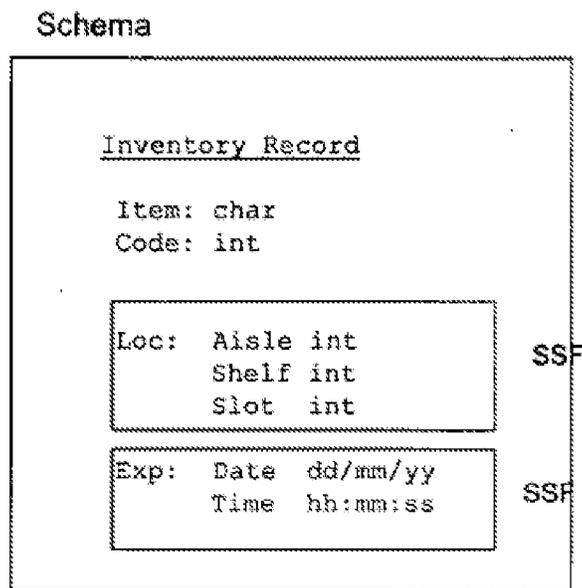


Figure 4a

Appellants' Figure 4a above depicts a schema of an inventory record, the record comprising four fields two of which are scope sensitive fields ("SSF").

Paragraph 37 of Appellants' Specification, in describing Figure 4a, provides an example of an inventory record comprising "two fields which are denoted as scope sensitive fields (SSF) . . . the location (loc) and Expiry (Exp) fields." Thus, even under the Examiner's interpretation of claim 1 as requiring fields able to be populated as recited as well as fields not able to be so populated, we find paragraph 37 of the Specification supports the limitations at issue. We conclude the Examiner's reasoning regarding the written description support for claim 1 is in error.

For the reasons discussed *supra*, and on the record before us, we reverse the Examiner's § 112 rejection of independent claim 1. For similar reasons, we do not sustain the Examiner's § 112 rejection of independent claim 18, which recites similar limitations, and dependent claims 4 and 20, which were rejected based on their dependency from rejected claims 1 and

18.

Claims 5–8 and 21–24

The Examiner finds “determining whether the at least one data field of the message includes a tracking number,” as recited in claim 5, is not supported by the original disclosure. Final Act. 4. Appellants contend support for the disputed limitation is found in paragraph 58 of the Specification. App. Br. 6.

We are not persuaded by Appellants’ contention. Appellants’ Specification recites that “[i]n the disclosed embodiment, a tracking number is *assigned* to the message itself. In an alternative embodiment, a different identifier is *assigned* to each SSF.” Spec. ¶ 58 (emphasis added). The Examiner argues *assigning* a tracking number to the at least one data field of the message is not *including* a tracking number to the at least one data field of the message, and concludes paragraph 58 of the Specification does not support the disputed “including” limitation of claim 5 under the written description require of under 35 U.S.C. § 112, first paragraph. Because Appellants have not provided sufficient evidence and/or a persuasive line of technical reasoning explaining why *assigning* a tracking number supports *including* a tracking number, we agree with the Examiner.

Appellants further contend, for the first time in the Reply Brief, that the disputed limitation is also found in paragraph 51 of the Specification. Reply Br. 5. We decline to consider these arguments, because Appellants do not provide a basis that this argument is responsive to the Examiner’s Answer or show good cause for its untimely presentation. *See* 37 C.F.R. § 41.41(b)(2) (2013) (“Any argument raised in the reply brief which was not

raised in the appeal brief, or is not responsive to an argument raised in the examiner's answer . . . will not be considered by the Board for purposes of the present appeal, unless good cause is shown.”). Furthermore, even if timely presented, we similarly find paragraph 51 fails to provide the requisite written description support of the disputed “including” limitation for the reason discussed *supra* with respect to paragraph 58 of the Specification.

For the reasons discussed *supra*, we sustain the Examiner's rejection of claim 5 under 35 U.S.C. § 112, first paragraph. For similar reasons, we sustain the Examiner's § 112 rejection of claim 21 and dependent claims 6–8 and 22–24, which were not argued separately.

Claims 25 and 26

Claim 25 recites, in pertinent part, “*responsive to* determining that the at least one data field of the message contains the scope sensitive field transforming the scope sensitive field by populating the scope sensitive field with content of the second level of detail appropriate to the second entity” (hereinafter the “first determining step”) “comprises: determining a message type of the message” (hereinafter the “second determining step”). The Examiner finds these limitations are not supported by the original disclosure. Final Act. 6. In response, Appellants contend support for the first and second determining steps is found in paragraph 39 of the Specification. App. Br. 7.

We are not persuaded of Examiner error. Specifically, the Examiner finds support for the first determining step is found in Figure 5, steps 140 and 150. Final Act. 6. The Examiner further finds support for the second

determining step is found in Figure 5, step 110. *Id.* The Examiner finds step 110 occurs before steps 140 and 150 and, therefore, the second determining step is not *responsive to* the first determining step. *Id.* Appellants do not provide sufficient evidence or argument to persuasively rebut these findings.

Appellants further contend, for the first time in the Reply Brief, that the first and second determining steps are also found in paragraphs 36 and 42 of the Specification. Reply Br. 5–6. Appellants argue:

[The] Examiner further appears to suggest . . . that it is the order of the claimed limitations that [the] Examiner finds no support [sic]. But the limitations of the claims 25 and 26 do not necessary [sic] require a specific order, except for the claimed limitation directed to locating a transformation that is appropriate for the (determined) message type.

Id. at 6 n.4. This contention is untimely and waived. *See* 37 C.F.R. § 41.41(b)(2) (2013) Furthermore, even if timely presented, the argument is unpersuasive. For the second determining limitation to be *responsive to* the first disputed limitation, as claimed, it follows that the second determining step occur *after* the first determining step. This interpretation requiring the particular sequence of steps is supported by Figure 5 reproduced below:

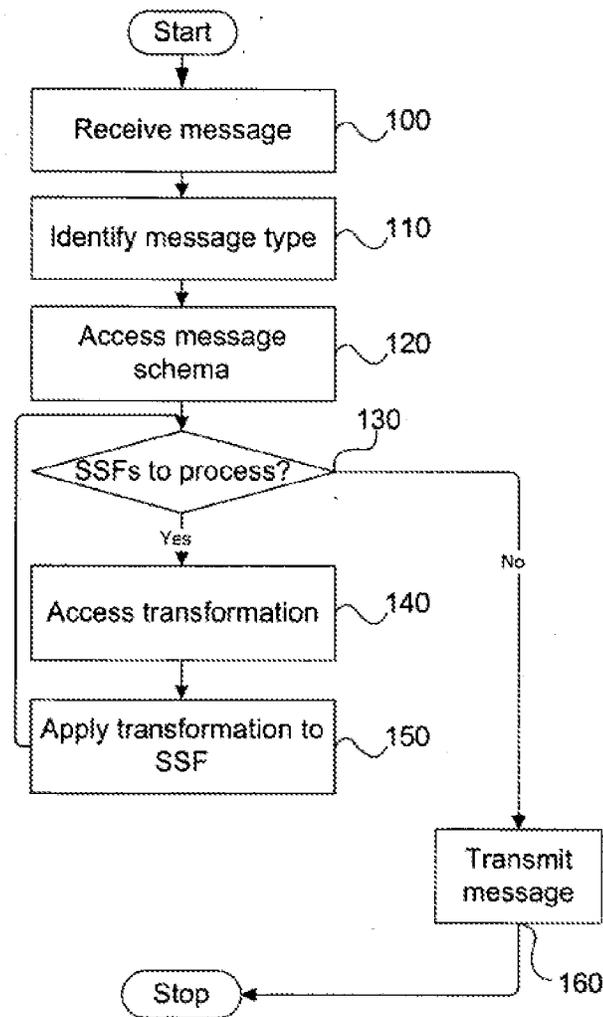


Figure 5

Figure 5, 100–160 depicts the steps “of the operation of the present invention, in accordance with one embodiment.” Spec. ¶ 35. “Identifier 60 identifies the message type at step 110.” *Id.* at ¶ 36. Further, “transforming component 80 accesses the appropriate transformation at step 140 and applies that transformation to the scope sensitive field of the received message at step 150.” *Id.* at ¶ 42. Thus, according to Appellants’ disclosure, the second determining step occurs *before* the first determining

step, not *after* and, therefore, the second determining step cannot be *responsive to* the first determining step as claimed.

For the reasons discussed *supra*, Appellants' arguments are not persuasive and we sustain the Examiner's rejection of claim 25 under 35 U.S.C. § 112, first paragraph. For similar reasons, we sustain the Examiner's rejection of claim 26, which recites a similar limitation and was not argued separately.

Claims 27 and 28

Claim 27 recites, *inter alia*, "the data schema indicates which of the data fields of the message are scope sensitive by flagging the data fields of the message that are scope sensitive using a stereotype of 'scope_sensitive_location'." The Examiner finds this recitation is not supported by the original disclosure. Final Act. 7–8. In particular, the Examiner finds paragraph 38 of the Specification discloses that SSFs related to location "are flagged using the stereotype of 'scope_sensitive_location' rather than any or all scope sensitive data fields that aren't related to location." *Id.* at 7; *see also* Ans. 11–12. Appellants contend support for the disputed limitation at issue is found in paragraph 38 of the Specification. App. Br. 7–8; *see also* Reply Br. 7.

We are persuaded by Appellants' contention. Paragraph 38 of the Specification provides "if the event schema was specified in Unified Markup Language (UML), a scope-sensitive location field could be flagged using a stereotype of <<scope_sensitive_location>>. This indicates that the information within the location field is scope sensitive." Spec. ¶ 38. Thus, we find paragraph 38 of the Specification supports, upon flagging data

location fields of the message using a stereotype of “scope_sensitive_location,” indicating which of the data fields of the message are scope sensitive.

For the reasons discussed *supra*, we reverse the Examiner’s rejection of claim 27 under 35 U.S.C. § 112, first paragraph. For similar reasons, we do not sustain the Examiner’s rejection of claim 28, which recites a similar limitation.

Rejection under 35 U.S.C. § 112, second paragraph

Claim 1 recites, in part, “data fields with at least one data field able to be populated with content of different levels of detail.” The Examiner finds this recitation “is indefinite as to whether [the at least one data field] is a scope sensitive field, or whether there is some criteria by which a data field is ‘able to be’ populated with content of different levels of detail even if it is not actually a scope sensitive field.” Final Act. 8–9. Appellants contend “the claims when read in light of the specification would allow a hypothetical person possessing the ordinary level of skill in the pertinent art to understand the metes and bounds of the invention.” App. Br. 9–10. In particular, the Specification conveys to one skilled in the relevant art that some data fields may or may not change depending on what is appropriate for a specific entity. Reply Br. 3–4 (citing Figure 4a; Spec. ¶¶ 30–34, 37).

“[B]readth is not to be equated with indefiniteness.” *In re Miller*, 441 F.2d 689, 693 (CCPA 1971). “A broad claim is not indefinite merely because it encompasses a wide scope of subject matter provided the scope is clearly defined.” MPEP § 2173.04. We find “at least one data field able to be populated with content of different levels of detail,” as recited in claim 1,

concerns any type of criteria necessary such that the at least one data field is able to be populated with content of different levels of detail. We further find whether the criteria necessary is an SSF, other required element(s), neither, or both is a matter of claim breadth, not indefiniteness.

“The test for definiteness is whether one skilled in the art would understand the bounds of the claim when read in light of the specification.” *Miles Laboratories, Inc. v. Shandon Inc.*, 997 F.2d 870, 875 (Fed. Cir. 1993); *see also Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986). We agree with Appellants, in light of the Specification, one skilled in the art would understand the “at least one data field is able to be populated with content of different levels of detail including a first level of detail appropriate to a first entity.” Reply Br. 4. For the reasons discussed *supra*, we do not sustain the Examiner’s rejection of claim 1. For similar reasons, we do not sustain the Examiner’s rejection of claim 18, which recites a similar limitation. Additionally, we do not sustain the Examiner’s rejection of dependent claims 4–8 and 20–28.

Rejection under 35 U.S.C. § 103

We have reviewed the Examiner’s rejections in light of Appellants’ arguments the Examiner has erred. App. Br. 10–14. We disagree with Appellants’ conclusions regarding the obviousness rejection. We adopt as our own: (1) the findings and reasons set forth by the Examiner in the Action from which this appeal is taken (Final Act. 10–27), and (2) the reasons set forth by the Examiner in the Answer in response to arguments made in Appellants’ Appeal Brief (Ans. 15–22). We highlight and address specific findings and arguments below.

Appellants contend the Examiner erred in finding Abjanic teaches or suggests “determining, by a computer, whether the at least one data field of the message includes a scope sensitive field by accessing a data schema associated with the message,” as recited in claim 1. In particular, Appellants assert Abjanic teaches a received message in a specific format (e.g., a TypeAxml format) requires transformation to a different format (e.g., a TypeBxml format) according to a transformation template. App. Br. 11–13 (citing Abjanic ¶ 100). Appellants argue Abjanic’s transformation template transforms the entire message from the TypeAxml format to the TypeBxml format and “[t]here is no teaching in Abjanic that the transformation template is used to determine whether a message contains scope sensitive fields.” Reply Br. 12; *see also* App. Br. 13. Appellants further argue, although the example provided in Abjanic converts some elements (e.g., “Qty” and “Description”) and not other elements (e.g., “From,” “To,” and “Partnumber”), the “stylesheet accounts for each line of the TypeAxml format message, i.e. the entire message and, therefore, converts the entire TypeAxml format message to TypeBxml.” Reply Br. 12 (citing Abjanic ¶¶ 102–108).

We are not persuaded the Examiner erred. The Examiner finds Abjanic teaches or suggests determining whether at least one data field of a message includes an SSF by accessing a data schema associated with the message. Final Act. 11 (citing Abjanic ¶¶ 100, 102–103). As the Examiner explains, Abjanic teaches a transformation template that indicates transformation for some of the elements from the TypeAxml format, and no transformation for other elements from the TypeAxml format. *Id.* at 11.

Abjanic, in disclosing the transformation of *some* elements from the

TypeAxml format to the TypeBxml format, and not other elements, teaches or suggests a determination of which elements need and do not need a transformation. Thus, the transformation of *some* elements from the TypeAxml format to the TypeBxml format suggests determining whether an element (e.g., element “<From>”) (the claimed “at least one data field”) of the provided message in the TypeAxml format (the claimed “message”) includes an element that needs to be converted to the TypeBxml format (the claimed “scope sensitive field”) by accessing a transformation template (the claimed “data schema”) associated with the provided message in the TypeAxml format.

For the reasons discussed *supra*, we are unpersuaded of Examiner error. Accordingly, we sustain the Examiner’s rejection of independent claim 1 and, for similar reasons, the rejection of independent 18, which recites similar limitations and which was not argued separately. Additionally, we sustain the Examiner’s rejections of dependent claims 4–8 and 20–28, which were not argued separately. *See* App. Br. 10–14.

DECISION

We reverse the Examiner’s decision to reject claims 1, 4, 18, 20, 27, and 28 under 35 U.S.C. § 112, first paragraph.

We affirm the Examiner’s decision to reject claims 5–8 and 21–26 under 35 U.S.C. § 112, first paragraph.

We reverse the Examiner’s decision to reject claims 1, 4–8, 18, and 20–28 under 35 U.S.C. § 112, second paragraph.

We affirm the Examiner’s decision to reject claims 1, 4–8, 18, and

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20–28 under 35 U.S.C. § 103(a).

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

AFFIRMED