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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte YEN-FU CHEN, JOHN HANS HANDY-BOSMA,
SUSAN ELISE LEE, and KEITH RAYMOND WALKER¹

Appeal 2017-000704
Application 11/379,610
Technology Center 2100

Before: ROBERT E. NAPPI, IRVIN E. BRANCH, and
PATRICK M. BOUCHER *Administrative Patent Judges*.

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's Final rejection of claims 4, 10, 14 through 24, 28 through 30, 33 through 35, and 37 through 40. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

¹ According to Appellants, the real party in interest is International Business Machines Corporation. Br. 2.

INVENTION

Appellants' disclosed invention relates to content sharing based on regular-expression pattern analysis. Spec. para. 1. Claim 4 is representative of the invention and reproduced below.

4. A method for embedding content prediction instructions in a document while the document is being edited by a user, the method comprising:
 - customizing a content prediction instruction using content prediction logic of a document editor program;
 - determining a regular expression that describes differences between content for a plurality of cells associated with the document; and
 - embedding, by a computer, the content prediction instruction in the document being edited by the user, wherein the content prediction instruction is customized based on the regular expression.

REJECTIONS AT ISSUE²

The Examiner rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Stinson et al. (Microsoft Office Excel 2003, hereinafter "Stinson"), Whittle et al. (US 2005/0050547 A1; pub. Mar. 3, 2005, hereinafter "Whittle"), Kantrowitz et al. (US 6,618,697 B1; iss. Sept. 9, 2003, hereinafter "Kantrowitz '697"). Answer 2.

The Examiner rejected claims 10 and 21 through 24 under 35 U.S.C. § 103(a) as being unpatentable over Whittle and Kantrowitz et al. (US

² Throughout this Decision, we refer to the Appeal Brief filed March 21, 2016 ("App. Br."); Reply Brief filed October 19, 2018 ("Reply Br."); Final Office Action mailed December 23, 2015 ("Final Act."); and the Examiner's Answer mailed August 25, 2016 ("Answer").

2002/0156816 A1; pub. Oct. 24, 2002, hereinafter “Kantrowitz ‘816”).

Answer 2.

The Examiner rejected claims 14 through 20 and 28 through 30 under 35 U.S.C. § 103(a) as being unpatentable over Whittle, Kantrowitz ‘816 and Kantrowitz ‘697. Answer 2.

The Examiner rejected claims 33 through 35 under 35 U.S.C. § 103(a) as being unpatentable over Stinson, Whittle, Kantrowitz ‘816 and Kantrowitz ‘697. Answer 2.

The Examiner rejected claims 37 through 39 under 35 U.S.C. § 103(a) as being unpatentable over Whittle and Kantrowitz ‘816, and Brummel (US 5,771,241; iss. June 23, 1998). Answer 3.

The Examiner rejected claim 40 under 35 U.S.C. § 103(a) as being unpatentable over Stinson, Whittle, Kantrowitz ‘816, Kantrowitz ‘697 and Brummel. Answer 3.

ANALYSIS

We have reviewed Appellants’ arguments in the Briefs, the Examiner’s rejections, and the Examiner’s response to Appellants’ arguments. Appellants’ arguments have persuaded us of error in the Examiner’s obviousness rejection of claims 4, 21 through 24, 28 through 30, 33 through 35, and 37 through 40, but have not persuaded us of error in the obviousness rejection of claims 10, and 14 through 20.

Claims 4, 33 through 35.

Appellants argue on pages 10 through 12 and pages 7 and 8 of the Reply Brief, that the Examiner’s obviousness rejection of claim 4 is in error.

Appellants' arguments present us with several issues, the dispositive of which is did the Examiner err in finding the combination of the references teaches embedding content prediction instructions while the document is being edited.

The Examiner provides a detailed response to Appellants' arguments. We have reviewed the Examiner's response and the underlying findings, rationale and conclusions. We disagree with the Examiner's conclusion that the limitation in the preamble, directed to embedding the content prediction instruction in a document being edited by a user, is not to be afforded patentable weight. Answer 5. We also disagree with the Examiner's finding that Whittle teaches this limitation. Answer 7 (citing Whittle para. 77). The preamble of claim 4 states "embedding content prediction instructions in a document while the document is being edited by the user" and the claim includes "embedding, by a computer, the content prediction instruction in the document being edited by the user." Thus, we concur with the Appellants' argument that the preamble is to be afforded patentable weight. Appellants' Specification discusses this feature as occurring while the user is reformatting calls, i.e. editing the data (*see* Specification para. 77). While the discussion in paragraph 77 of Whittle identifies a document includes embedded script, we do not find sufficient evidence to support the Examiner's finding that such scripts are embedded while the document is being edited. Accordingly, we do not sustain the Examiner's obviousness rejection of claim 4.

With respect to claim 33 through 35, Appellants' assert the rejection is in error for the same reasons. The Examiner's rejection of independent claim 33 relies upon the same rationale as claim 4 and the Examiner has not

found the additional teachings of Kantrowitz '816 remedy the deficiencies discussed above in the rejection of claim 4. Answer 24. Accordingly, we similarly do not sustain the Examiner's rejection of claim 33 through 35.

Claims 10 and 21 through 24

Appellants argue on pages 12 through 15 and pages 9 through 12 of the Reply Brief, that the Examiner's obviousness rejection of claim 10 and 24 is in error. Appellants' arguments present us with three issues did the Examiner err in finding the combination of the references teaches: 1) receiving a user input to select a plan for importing the content prediction instructions; 2) the content prediction instruction is imported into the content prediction logic in response to receiving a user update; and 3) a step which determines that the content prediction instruction is in a queue.

The Examiner provides a detailed response to Appellants' arguments. Answer 10–16. We have reviewed the Examiner's response and the underlying findings, rationale and conclusions. We disagree with the Examiner's rationale with respect to claim 21 and are persuaded of error by Appellants' argument. However, Appellants' arguments are not commensurate with the scope of claim 10, and we are accordingly not persuaded of error.

Initially, as noted in our prior decision, which considered a claim similar in scope with the currently appealed claim 10, independent method claim 10 recites several limitations which are "responsive to" actions such as receiving a document or user input, which are conditional limitations. As such in considering the broadest reasonable interpretation of method claim 10, the steps dependent upon the condition would not necessarily be invoked

and as such it is not incumbent upon the Examiner to show that the art performs those steps. See *Ex Parte Katz* 2011 WL 514314 (BPAI Jan. 27 2011) (citing *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)). The limitations at issue in Appellants' arguments, discussed above, are all recited as being responsive to some condition, and as such Appellants' arguments are not commensurate with the broadest reasonable interpretation of method claim 10. Accordingly, we are not persuaded of error in the Examiner's rejection of claim 10.

However, we reach a different conclusion with respect to system claim 21 and computer readable medium claim 24, which stand similarly rejected. Our decisions have drawn a distinction between method claims and system/apparatus claims for purposes of conditional "if" language. See *Ex parte Gary M. Katz*, 2011 WL 514314, *4–5 (BPAI 2011) (Interpreting a similar "if" condition in a method claim.); see also *Gary M. Katz*, 2011 WL 1211248, *2 (BPAI 2011) (Denying request for rehearing.); and *In re Johnston*, 435 F.3d 1381, 1384 (Fed. Cir. 2006) ("[O]ptional elements do not narrow the claim because they can always be omitted.").

With respect to the first issue the Examiner identifies the claim limitation of receiving a user input to select a plan does not limit when the input is received and could encompass pre-defined preferences. Answer 11. Further, the Examiner identifies that "plan for importing" can be simply a way in which the content prediction script is received. Answer 11. Based on these findings the Examiner finds that Whittle's teaching of the control passing script and client based preferences (set by a user) to meet the claimed user input to select a plan. Answer 11 (citing Whittle para. 68). Appellants' arguments, do not address this claim interpretation by the

Examiner or the Examiner's findings regarding Whittle paragraph 68. Accordingly, we are not persuaded of error in the rejection of claim 24 based upon Appellants' arguments directed to the first issue.

However, Appellants' arguments directed to the third issue are dispositive of the appeal of claim 24 as they have persuaded us of error in the Examiner's rejection of claim 24. Appellants' arguments directed to the third issue assert that Whittle, does not teach a determination is performed as to whether a content prediction instruction is in a queue. Answer 15. The Examiner responds to this argument stating:

the queue may be interpreted as simply a container for instructions. There is no context as to the location of this 'queue' nor further details of its functionality. Thus, the claim . . . involves determining if an instruction is being held somewhere.

Answer 15–16. The Examiner finds that Whittle's discussion of the OneE-MaiPerContact parameter, teaches this limitation. Answer 16 (citing Whittle para. 102). We have reviewed the cited teachings and do not find sufficient evidence to support the Examiner's finding that Whittle teaches that the content prediction instruction is in a queue or that there is a step which determines that the instruction is in the queue. Accordingly, we do not sustain the Examiner's rejection of independent claim 24.

Independent claim 21 is similarly rejected and also contains a limitation directed to a step which determines that the content prediction instruction is in a queue. The Examiner's rejection of claim 21 relies upon the same rationale as discussed with respect to claims 10 and 24. Final Act. 12. Accordingly, we do not sustain the Examiner's rejection of independent

claim 21 and dependent claims 22 and 23, for the same reasons as discussed above with respect to claim 24.

Dependent claims 14 through 20 and 28 through 30.

Claims 14 through 20 all depend upon method claim 10. Appellants argue on pages 17 through 21 of the Brief, that the rejections of these claims are in error. Each of these claims recites a limitation further limiting one of the conditional steps of claim 10, e.g. claim 14 states “wherein the importing step comprises;” where the importing step of claim 10 is dependent upon “receiving the user update input” which itself depends upon several other occurrences. Thus, in considering the broadest reasonable interpretation of claims 14 through 20, the steps dependent upon the condition would not necessarily be invoked and as such it is not incumbent upon the Examiner to show that the art performs those steps. Accordingly, Appellants’ arguments directed to these claims are not commensurate with the broadest reasonable scope of the claims and we sustain the Examiner’s rejection of these claims.

Claims 28 through 30 depend upon independent claim 24. The Examiner has not shown that the additional teachings of Kantrowitz ‘697 remedy the deficiency in the rejection of claim 24, accordingly, we do not sustain the Examiner’s rejection of these claims.

Dependent claims 37 through 39.

Claims 37 depends upon method claim 10. Appellants argue on pages 22 through 26 of the Brief that the Examiner’s rejection is in error as none of the references teaches a queue which contains content prediction instructions as claimed. App. Br. 23. The Examiner in response to Appellants’ argument, states that Whittle discloses the use of content prediction

instructions in a queue and that Brummel teaches that when an instruction is removed from a queue a new instruction is moved to the top. Answer 25–26. We disagree with the Examiner. Initially, we note that unlike the other claims which depend upon claim 10, claim 37 is not further modifying a conditional limitation, and thus the Examiner is required to show the limitation. As discussed above with respect to claim 24, we disagree with the Examiner’s findings regarding Whittle teaching a queue for the prediction instructions. Thus, we do not sustain the Examiner’s rejection of claim 37 for the same reasons discussed above with respect to claim 24.

Claims 38 and 39 depend upon independent claims 21 and 24 respectively. The Examiner has not shown that the additional teachings of Brummel remedy the deficiency in the rejection of claims 21 and 24, accordingly, we do not sustain the Examiner’s rejection of these claims.

Dependent claim 40.

Claim 40 depends upon independent claim 33. The Examiner has not shown that the additional teachings of Brummel remedy the deficiency in the rejection of claim 33, accordingly, we do not sustain the Examiner’s rejection of this claim.

DECISION

We reverse the Examiner’s rejection of claims 4, 21 through 24, 28 through 30, 33 through 35, and 37 through 40 under 35 U.S.C. § 103.

We affirm the Examiner’s rejection of claims 10, 14 through 20, under 35 U.S.C. § 103.

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

AFFIRMED-IN-PART