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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte FLETCHER JAMES

Appeal 2017-004708
Application 13/569,843
Technology Center 2100

Before JOSEPH L. DIXON, JOHN A. EVANS, and SCOTT B. HOWARD,
Administrative Patent Judges.

DIXON, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ appeals under 35 U.S.C. § 134(a) from a rejection of claims 1, 6–13, 22, and 27–34. We have jurisdiction under 35 U.S.C. § 6(b). An oral hearing was scheduled for January 17, 2019, but Appellant waived the oral hearing. Therefore, we decide the appeal on the Briefs.

We reverse.

The claims are directed to a method and system for persisting add-in data in documents. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A system for adding functionality to a document-based application comprising a computer with a processor and non-transitory system memory storing executable instructions which, when executed by the processor, further comprise:
 - a. an add-in module;
 - b. at least one rich item store for storing rich items; and
 - c. a data store for storing supplemental data elements created by the add-in module within a document created by the document-based application, where at least one supplemental data element is associated with a content segment in the document by a bookmark comprising a marked location of the content segment in the document, at least one rich item is associated with the at least one supplemental data element, the data store and the at least one rich item store are stored within the document as meta-data of the document, and each of the at least one rich item stores comprises rich items whose type is one of: text, image data, sound data, or binary data.

¹ Appellant indicates that Fletcher James is the real party in interest. (App. Br. 1).

REFERENCE

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

Levit and James, *Best Authority User's Guide*, Version 2.7 (2010) (“Levit”).

REJECTIONS

The Examiner made the following rejections:

Claims 1, 6–13, and 27–34 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Levit (hereinafter Best Authority User's Guide).

We consider the obviousness rejection of independent claim 22 over Chun in view of Coulson to be withdrawn from consideration.²

² The Examiner expressly only lists the anticipation rejection in the Examiner's Answer, and the Examiner's Answer does not contain a “WITHDRAWN REJECTIONS” section. In the Pre-Appeal Brief Conference Request, Appellant includes an argument regarding independent claim 22 and identifies that the Examiner does not address Appellant's argument that “Coulson does not disclose loading deserialized data into at least one rich item store object.” (Pre-Appeal Brief Conference Request, dated May 24, 2016, citing to the [Non-Final] Action of June 10, 2015 where the Examiner withdrew the obviousness rejection to all other claims). Because the Examiner has not addressed Appellant's prior arguments and has not repeated the rejection, we interpret the obviousness rejection to be withdrawn, and we do not consider the merits thereof. Any rejection not repeated and discussed in the answer may be taken by the Board as having been withdrawn. *Ex Parte Emm*, 118 USPQ 180 (Bd. App. 1957).

ANALYSIS

With respect to independent claims 1 and 27, Appellant sets forth arguments to both claims together. (App. Br. 12).³ We address independent claim 1 as the illustrative claim for the group.

“[A]nticipation is a question of fact.” *In re Hyatt*, 211 F.3d 1367, 1371–72, (citing *Bischoff v. Wethered*, 76 U.S. 812, 814–15 (1869); *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997)).

[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.

Net MoneyIn, Inc. v. VeriSign, Inc., 545 F.3d 1359, 1371 (Fed. Cir. 2008). “Thus, it is not enough that the prior art reference discloses part of the claimed invention, which an ordinary artisan might supplement to make the whole, or that it includes multiple, distinct teachings that the artisan might somehow combine to achieve the claimed invention.” *Id.* (citation omitted).

Appellant argues that the Best Authority User’s Guide does not enable independent claims 1 and 27. (App. Br. 12). Appellant argues that the Best

³ We note that the language of independent claim 27 is similar yet different than independent claim 1 and does not expressly recite the “add in unit” in the method, but the steps are similar when read in context of the disclosed invention. We leave it to the Examiner to further consider the lack of antecedent basis for “the supplemental data element” in step c.

Authority User's Guide does not anticipate the data store of claims 1 or 27 under 35 U.S.C. § 102(b). (App. Br. 14).

The Examiner asserts that Best Authority User's Guide anticipates claims 1 and 27 under 35 U.S.C. § 102(b) because it discloses "a data store for storing supplemental data elements created by the add-in module ... where at least one supplemental data element is associated with a content segment in the document by a bookmark comprising a marked location of the content segment in the document." (Final Act. 3).

Appellant argues that:

[T]he document dictionary may be capable of storing "words, phrases, and phrase patterns to enable it to detect citations in a document," nothing in *Best Authority User's Guide* describes an add-in module that (1) associates supplemental data elements in the document dictionary with a content segment in the document; or (2) uses a bookmark to effectuate that association. The Examiner's evidence is therefore insufficient to qualify as an anticipatory reference.

(App. Br. 14) (footnote omitted). Appellant further contends "*Best Authority User's Guide Does Not Anticipate the Rich Item Store of Claims 1 or 27 Under 35 U.S.C. § 102(b).*" (App. Br. 16).

The Examiner attempts to piece together various words and disclosures from the Best Authority User's Guide to support the Examiner's finding of anticipation. (Ans. 5–12). The Examiner makes specific findings that the Best Authority User's Guide "discloses a rich item store as meta-data stored within the document has formatted text in a Table of Authorities (TOA)" (Ans. 2); "*at least one rich item store are stored within the document as meta-data of the document*" (Ans. 3); "BAU teaches that the

citations, statues etc. discovered in the document including the BA settings are managed with the BA add-on and stored ‘. . . **with the document.**’ (see pg. 50 Fig[.] 31).” (Ans. 12).

The Examiner further finds that the Best Authority User’s Guide is add-on software that works with MICROSOFT WORD® and therefore comprises “an add-in module.” (Ans. 8). The Examiner further finds that pages 3, 94, and 107 of the Best Authority User’s Guide “teach that BA stores everything including settings and entries *with the document.*” (Ans. 9)(emphasis added).

Appellant contends:

First, the Examiner mistakenly equates the claimed “data store” with an entire Word document. In the first sentence of his reasoning (the *only* sentence where the Examiner attempts to identify a data store in the prior art), he states, “[t]his section [referring to *Best Authority User’s Guide* at p. 63] teaches a data store *which is the document* for storing supplemental data ... “). This is wrong. A data store cannot be a document. Claim 1 states “the data store and the at least one rich item store *are stored within the document* as meta-data of the document.” This difference between “data store” and “document” is also supported by the specification, which explains “the data store saves and retrieves data (including data associated with the rich item store) *to and from the designated storage areas in the document*, in ways that have minimal or no effect *on the body of that document.*” Based on the claim language and the specification, one of ordinary skill in the art would understand that a data store must at least correspond to a storage area within a document, and cannot refer to an entire document itself.

(Reply Br. 4) (footnotes omitted). Appellant further contends:

In the present application, because both the language of the claims and the teaching of the specification narrow the scope of the term “data store,” and specifically by distinguishing a

“data store” from a “document,” the Examiner may not apply a “broadest-construction possible” rubric to this claim term.

It is therefore inappropriate for the Examiner to equate an entire Word document with a data store. On the contrary, the Examiner was required to cite prior art showing a defined data storage area being utilized *within* a document. The prior art must also show a data storage area implemented as meta-data, and the data storage area must permit the storage of supplemental data elements without significantly affecting the body of the document. The examiner failed to satisfy these criteria, which is not surprising given that *Best Authority User’s Guide* is a user’s guide, not a software design document. Moreover, the *only* evidence the Examiner offers to show the existence of a data store in the prior art is the single statement cited above. He cites no other evidence.

(Reply Br. 5) (footnote omitted). Finally, Appellant contends:

The Examiner continues his “data store” rejection by further asserting that the related “supplemental data” limitation of claim 1 corresponds to “a Flag associated with a citation and represented [as] a bookmark having a marked location of the citation segment in the document.” This too is wrong because it inappropriately equates supplemental data with a bookmark, as if they are the same. Claim 1 makes it clear that supplemental data and bookmark are two different things. A legitimate prior art reference must therefore teach this difference. *Best Authority User’s Guide* does not, and the Examiner’s rejection must therefore be reversed.

(Reply Br. 5–6).

We agree with the Appellant that the Examiner has not persuasively shown that the Best Authority User’s Guide discloses the invention as recited in the language of independent claim 1.

We agree with Appellant that the Examiner’s claim interpretation is overly broad and not a reasonable interpretation. The language of

independent claims 1 and 27 recite “system for adding functionality to a document-based application” and “computer-implemented method for adding functionality to a document-based application.”

Although the Examiner has found respective words (“bookmark,” “add in,” “metadata”) in the *Best Authority User’s Guide*, the presence of those words is not in the relative context as claimed in claims 1 and 27. The Specification provides appropriate context for the claimed invention, and it is clear that the claimed “add-in unit” provides additional functionality and additionally provides the storage for the rich item store and the “data store.” (Spec. ¶ 13 “The add-in includes at least two distinct sub-components: one or more rich item stores and a data store. The rich item stores allow for the in-memory storage and retrieval of identified items of data of types normally used in the document based application (formatted text, spreadsheet cells, graphics, etc.)”). (*See also* App. Br. 1–10).

With respect to independent claims 1 and 27, Appellant also argues that the “*Best Authority User’s Guide* states that citations are marked only with custom fields or add-in fields, and the fact that the document never mentions the use of bookmarks to perform this function, demands that it be rejected as an anticipatory reference. *Best Authority User’s Guide* describes the old prior art method of building a Table of Authorities using embedded fields.” (App. Br. 18).

The Examiner finds that “BAU already teaches that all BA entries are saved along with the document, he further discloses on pg. 63 “[t]he Flag is a regular Word Bookmark. If you drop the Flag inside some text, and then move that text to another part of the document, the Flag will move with it. Therefore, if, you are going to move a citation to another TOA group”

(Ans. 10)(emphasis omitted). The Examiner then explains what the section “teaches” rather than relying upon what the sections expressly “discloses” as required for an anticipation rejection. The Examiner further identifies pages 45 and 46 of Best Authority User’s Guide regarding the use of Quick Mark flag. (*Id.*).

We find the Examiner’s showing to be insufficient to support the Examiner’s finding of anticipation, and the Examiner speculates as to how the software uses the regular bookmarks of WORD[®] software.

As a result, we find that the Examiner has not made the requisite showing that the Best Authority User’s Guide discloses all the limitations as set forth in independent claims 1 and 27 and their corresponding dependent claims 6–13 and 28–34.

CONCLUSION

The Examiner erred in rejecting claims 1, 6–13, and 27–34 based upon anticipation under 35 U.S.C. § 102.

DECISION

For the above reasons, we reverse the Examiner’s rejection of claims 1, 6–13, and 27–34 based upon anticipation under 35 U.S.C. § 102.

REVERSED