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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex Parte JASON M. BLACKWELL, ROBERT B. DESAULNIERS, SEENIVASAGAM B. DHAMOTHARAKKANNAN, ANNIE FLEMING, BRIAN C. MEYER, and DOUGLAS SPADOTTO

Appeal 2017-006751
Application 11/833,078
Technology Center 2100

Before MICHAEL J. STRAUSS, JEREMY J. CURCURI, and BETH Z. SHAW, *Administrative Patent Judges*.

SHAW, *Administrative Patent Judge*.

DECISION ON APPEAL[1]

Appellants[2] seeks our review under 35 U.S.C. § 134(a) of the Examiner's final rejection of claims 1–39, which represent all the pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

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[1] Throughout this Decision we have considered the Appeal Brief filed November 10, 2016 ("App. Br."), Reply Brief filed March 21, 2017 ("Reply Br."), the Specification filed August 2, 2007 ("Spec."), the Examiner's Answer mailed January 26, 2017 ("Ans."), and the Final Rejection mailed July 19, 2016 ("Final Act.").

[2] Appellants identify International Business Machines Corporation as the real party in interest (App. Br. 2).

INVENTION

Appellants' invention is directed to previews of search results. Spec. ¶ 1.

Claim 1 is illustrative of the claims at issue and is reproduced below:

1. A method comprising:

providing search results in a first dedicated screen space of a user interface and associated with a first collection based on at least one search term, and which excludes search results associated with any of one or more second collections;

providing a separate customizable preview of search results based on the at least one search term in a separate pane located in a second dedicated screen space of the user interface and associated with at least one second collection which is different from the first collection; and

providing options to a user to customize the second dedicated space and the separate pane through an editing settings link in the user interface that is configured to provide customization controls which:

allow the user to remove the separate pane in the second dedicated space;

order the separate pane with at least one other customizable preview pane in the second dedicated space; and

allow the user to add another pane in the second dedicated space which includes the at least one second collection to be any web site that the user inputs through a text editable box in an add sidebar module,

wherein the first collection is a first category of information for the at least one search term and the at least one second collection includes a second category of information for the at least one search term which is different from the first category of information.

REJECTIONS

The Examiner rejected claims 1, 16, 25, and 36 under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter. Final Act. 3–4.

The Examiner rejected claims 2, 19, and 29 under 35 U.S.C. § 112(a) or 35 U.S.C. § 112 (pre-AIA), first paragraph, as failing to comply with the written description requirement. Final Act. 2–3.

The Examiner rejected claims 1–25 and 27–39 under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Karls et al. (US 7,873,622 B1, issued Jan. 18, 2011, hereafter Karls) in view of Jackson et al. (US 7,664,770 B2, issued Feb. 16, 2010, hereafter Jackson) and Dahn et al. (US 2005/0228788 A1, pub. Oct. 13, 2005, hereinafter Dahn). Final Act. 5–23.

The Examiner rejected claim 26 under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Karls and Wang et al. (US 8,037,060 B1, issued Oct. 11, 2011). Final Act. 23–24.

ANALYSIS

Section 101 Rejection

Appellants argue the Examiner erred in rejecting claims 1, 16, 25, and 36 under 35 U.S.C. § 101 as directed to non-statutory subject matter. App. Br. 6–31; Reply Br. 2–7. The Examiner finds:

> Claims 1, 16, 25, and 36, recite, in part, providing search results from different categories, providing separate preview for different search results with options to customize the display. These steps describe the concepts of collecting and comparing known information such as categories, which is similar to concepts that have been identified as abstract by the courts,

> such as comparing new and stored information and using rules to identify options, using categories to organize, store and transmit information, and obtaining and comparing intangible data.

Ans. 2–3. The Examiner finds that the claims do not include additional elements sufficient to amount to significantly more than the judicial exception because the additional elements when considered both individually and as an ordered combination do not amount to significantly more than the abstract idea. *Id.* at 4.

The claims provide search results from first and second collections and display the first and second search results on first and second panes. Appellants argue that "the features of the claimed invention include technological features (e.g., an editing settings link, customization controls, a text editable box, an add sidebar module, etc.) which are more than just well-understood, routine, and conventional activities." Reply Br. 3. We agree with Appellants.

We conclude that Appellants' claims are patent eligible as directed to a specific improvement (customization of previews of search results) in a technological process and solve a problem by producing pages with improved layouts. Our reviewing court has approved claims of this general character. *See, e.g.*, *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1316 (Fed. Cir. 2016) (finding eligible claims that use "limited rules" in a computerized "process specifically designed to achieve an improved technological result in conventional industry practice"); *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256–1259 (Fed. Cir. 2014) (finding eligible claims directed to creation of an improved type of web page); *see also Trading Techs. Int'l, Inc. v. CQG, Inc.*, 675 F. App'x 1001, 1005 (Fed.

Cir. 2017) ("Abstraction is avoided or overcome when a proposed new application or computer-implemented function is not simply the generalized use of a computer as a tool to conduct a known or obvious process, but instead is an improvement to the capability of the system as a whole."); *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1300–01 (Fed. Cir. 2016) (finding claims eligible where, although "[t]he solution requires arguably generic components," a specific limitation "requires that these generic components operate in an unconventional manner to achieve an improvement in computer functionality"). The instant claims are eligible because they are directed to an improvement in the functioning of a computer performing customization of previews of search results and customization of dedicated separate panes.

We note that, because the claims are narrowly directed to customization of previews of search results and customization of dedicated separate panes, any preemption is appropriately limited to Appellants' contribution to the art, and not to graphical user interfaces or searches in general. For these reasons, we do not sustain the rejection of claims 1, 16, 25, and 36 under 35 U.S.C. § 101.

Section 112 Rejection

Appellants also argue the Examiner erred in claims 2, 19, and 29 under 35 U.S.C. § 112 as failing to comply with the written description requirement. App. Br. 31–33; Reply Br. 7–8. In particular, Appellants argue the features of "'the customizable preview of search results is a subset of a search result for the at least one second collection by providing no more than three search results' is disclosed by paragraphs [0017] and [0019] of the

specification." Reply Br. 7. We agree. Here, Appellants point to paragraph 17 of the Specification for support of the claimed "no more than three search results." We agree with Appellants that Figure 3 and paragraphs 17 and 19 support claims 2, 19, and 29. Accordingly, we do not sustain the rejection of claims 2, 19, and 29 under 35 U.S.C. § 112 as failing to comply with the written description requirement.

Section 103 Rejection

Appellants argue the Examiner erred in rejecting claims 1–25 and 27–39 under 35 U.S.C. § 103(a) as being unpatentable over Karls, Jackson, and Dahn. In particular, Appellants argue Karls does not disclose "allowing the user to add another pane in the second dedicated space which includes the at late one second collection to be any web site that the user inputs through a text editable box in an add sidebar module." App. Br. 34–35; Reply Br. 8–9. We agree with Appellants.

The Examiner finds the combination of Karls and Jackson teaches this limitation. Ans. 6–7 (citing Karls, Fig. 7, 12:26–50). The Examiner explains that Karls teaches that one of the panes that can be added to a window is a "bookmarks" pane, which is a search of sites that the user has bookmarked. *Id.* Karls also discloses a column selector that also includes an add/remove link that links to a column selector preferences dialog box that permits users to configure their column selector and a bookmark category that contains a set of bookmarks where bookmarks that have been separately identified to the server using an appropriate bookmarking technique such as a short page title with a URL. Final Act. 8. The Examiner finds Jackson teaches a watch list, which can include functionality for user

updates at a client, where the watch list can be a list of URL's for websites. However, while we agree that Karls shows adding panes in a second space, on this record, the Examiner has not explained how Karls or Jackson teaches "allow[ing] the user to add another pane in the second dedicated space which includes the at least one second collection to be *any web site that the user inputs through a text editable box in an add sidebar module*," as recited in claim 1 (emphasis added).

Thus, we persuaded of error in the Examiner's rejection of claim 1 under 35 U.S.C. § 103(a). Therefore, we do sustain the § 103 rejection of claim 1. For the same reasons, we do not sustain the rejections of independent claims 16, 25, and 36, or the remaining dependent claims. Further, we also sustain the Examiner's rejection of claim 26 because the Examiner does not find that the additional reference Wang cures the deficiencies discussed above.

Because these issues are dispositive, we do not reach Appellants' other prior art arguments.

DECISION

The decision of the Examiner to reject claims 1–39 is reversed.

REVERSED