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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/421,903	04/10/2009	Geoffry A. Westphal	31083.30US1	5418
34018	7590	01/02/2019	EXAMINER	
Greenberg Traurig, LLP 77 W. Wacker Drive Suite 3100 CHICAGO, IL 60601-1732			ZELASKIEWICZ, CHRYSTINA E	
			ART UNIT	PAPER NUMBER
			3621	
			NOTIFICATION DATE	DELIVERY MODE
			01/02/2019	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GEOFFRY A. WESTPHAL

Appeal 2017-008356¹
Application 12/421,903²
Technology Center 3600

Before ANTON W. FETTING, CYNTHIA L. MURPHY, and
BRADLEY B. BAYAT, *Administrative Patent Judges*.

BAYAT, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 1, 2, 5, 6, 13, 14, 19, 21, and 25. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Our Decision references Appellant’s Appeal Brief (“App. Br.,” filed Jan. 11, 2017), Reply Brief (“Reply Br.,” filed May 10, 2017), the Final Office Action (“Final Act.,” mailed Sept. 13, 2016), and the Examiner’s Answer (“Ans.,” mailed Mar. 20, 2017).

² Appellant identifies the real party in interest as W.W. Grainger, Inc. (App. Br. 2).

STATEMENT OF THE CASE

Claimed Invention

Appellant's invention relates to "a system and method for displaying, searching, and interacting with a two dimensional, electronic version of a product catalog" (Spec. 3:1-2). Claim 1, the sole independent claim on appeal, is representative of the claimed subject matter. It recites:

1. A non-transitory computer readable media having stored thereon computer executable instructions for use in presenting information relevant to a product catalog, the instructions performing steps comprising:
 - presenting to a user via use of a client device in a two-dimensional format a plurality of links, each of the plurality of links being a link to a page of a product catalog on which is listed a plurality of products;
 - receiving a search request via use of the client device;
 - in response to the search request, causing the client device to retrieve from a server device having an associated search engine a set of product catalog pages wherein each product catalog page within the retrieved set of product catalog pages has at least one product that is determined by the search engine to be responsive to the search request and causing only those links within the presented plurality of links that are linked to a product catalog page within the retrieved set of product catalog pages to be visually altered;
 - receiving a selection of a one of the plurality of visually altered links via use the client device; and
 - in response to the selection, selecting from a memory of the client device a one of the product catalog pages within the retrieved set of product catalog pages that is linked to the selected one of the plurality of visually altered links and presenting to the user via use of the client device the selected one of the product catalog pages within the retrieved set of product catalog pages.

App. Br. 11, Claims Appendix.

REJECTIONS

The following rejections are before us on appeal.

1. Claims 1, 2, 5, 6, 13, 14, 19, 21, and 25 stand rejected under 35 U.S.C §112, first paragraph, as failing to comply with the written description requirement.

2. Claims 1, 2, 5, 6, 13, 14, 19, 21, and 25 stand rejected under 35 U.S.C §101 because the claimed invention is directed to a judicial exception without significantly more.

3. Claims 1, 2, 5, 6, 13, 14, 19, 21, and 25 stand rejected under 35 U.S.C § 103(a) as being unpatentable over Mayle et al. (US 2008/0109327 A1, pub. May 8, 2008) (“Mayle”) and Rothery et al. (US 2009/0254455 A1, pub. Oct. 8, 2009) (“Rothery”).

ANALYSIS

Written Description Noncompliance

The Examiner finds the Specification does not sufficiently support Appellant’s amendment³ of independent claim 1, in which “recites ‘in the response to the selection, selecting from a memory of the client device a one of the product catalog pages within the retrieved set of product catalog pages that is linked to the selected one of the plurality of visually altered links and presenting to the user via use of the client device the selected one of the product catalog pages within the retrieved set of product catalog pages.’” (Final Act. 3).

Appellant argues the rejection is improper because the subject application describes that the server device may *return to the client device each catalog page in a set of catalog*

³ Amendment to the Claims filed June 28, 2016.

pages that meet the provided request. The subject application then continues that a user may interact with highlighted icons *to navigate between the catalog pages in the returned set*. When navigated to, a catalog page within the returned set is displayed as a .pdf image, for example, in a pop-up window that lies over the catalog navigator page. (See, e.g., ¶ 0025 of US 2010/0262514).

App. Br. 5.

Responding to Appellant’s argument, the Examiner asserts “[t]here is no discussion, or support, for selecting the product catalog pages from a memory of the client device, and then presenting the selected catalog pages on the client device . . . [because] the cited portion explicitly states that activation of the link is communicated to and acted upon by the server, not the client device.” Ans. 3. We disagree.

Whether a specification complies with the written description requirement of 35 U.S.C. § 112, first paragraph, is a question of fact and is assessed on a case-by-case basis. *See, e.g., Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000) (citing *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1561 (Fed. Cir. 1991)). The disclosure, as originally filed, need not literally describe the claimed subject matter (i.e., using the same terms or *in haec verba*) in order to satisfy the written description requirement. Rather, the Specification must convey with reasonable clarity to those skilled in the art that, as of the filing date, Appellant was in possession of the claimed invention. *See id.*

Although Appellant’s Specification does not literally disclose selecting the product catalog pages from a memory of the client device, those skilled in the art, upon reviewing the Specification, would discern that

Appellant was in possession of the claimed subject matter as of the filing date. For example, the above-cited paragraph in the Specification discloses “that a user may interact with highlighted icons *to navigate between the catalog pages in the returned set*, i.e., the set of catalog pages that was provided to the client device by the server device before the icon was interacted with by the user.” Reply Br. 2 (citing Spec. 12:6–13:10). We agree with Appellant that selecting “catalog pages within the returned catalog page set” (Spec. 12:16–17) conveys with reasonable clarity to those skilled in the art that those catalog pages were provided and stored to the client device by the server.

Accordingly, we do not sustain the rejection of claims 1, 2, 5, 6, 13, 14, 19, 21, and 25 as failing to comply with the written description requirement.

Patent Ineligible Subject Matter

Section 101 defines patent-eligible subject matter as “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” 35 U.S.C. § 101. Laws of nature, natural phenomena, and abstract ideas are not patent-eligible matter. *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 70 (2012). A two-step analysis determines whether claim 1 falls outside the realm of patent-eligible subject matter: (1) whether the claim, as a whole, is “directed to” patent-ineligible subject matter—here, an abstract idea—and (2) if so, whether the elements of the claim, considered individually or as an ordered combination “‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 78). We

conclude the Examiner has not established that claim 1 is directed to an abstract idea, and therefore we do not reach the second step.

The Examiner determines “[t]he claims are directed to an abstract idea of visually altering links presented to a user in a two-dimensional format, wherein the links correspond to retrieved catalog pages that include products responsive to a search request, which is an idea of itself.” Final Act. 3–4; Ans. 4. According to the Examiner, “[t]his invention simply requires presenting data (e.g. plurality of links); receiving data (e.g. search request, retrieved catalog pages); and altering data (e.g. links that correspond to retrieved catalog pages). The claim limitations do not add a meaningful limitation because they can be performed by a human manually.” Final Act. 4–5.

Appellant disagrees and argues the claims are directed to an application of a concept that “cannot be said to be an uninstantiated concept, plan or scheme or a mental process (thinking) that can be performed in the human mind, or by a human using a pen and paper.” App. Br. 6; Reply Br. 3. Appellant contends that “the claims are directed to fixing a problem that arises from the use of computer systems.” *Id.* at 7; Reply Br. 4.

In response to Appellant’s argument, the Examiner repeats the above characterization of the abstract idea and asserts that “[t]he instant claims are similar to obtaining and comparing intangible data (see *CyberSource*); and collecting information, analyzing it, and displaying certain results (see *Electric Power Group*).” Ans. 4–5. As to each step performed in claim 1, the Examiner indicates:

- a. Presenting to a user in a two-dimensional format a plurality of links, wherein each link corresponds to a catalog page that

- lists a plurality of products (obtaining data, collecting information);
- b. Receiving a search request from the user (obtaining data, collecting information);
- c. Retrieving a set of catalog pages that have at least one product responsive to the search request (comparing data, analyzing information);
- d. Causing only those links that correspond to the retrieved set of catalog pages to be visually altered (comparing data, analyzing information);
- e. Receiving a selection of the visually altered links (obtaining data, collecting information);
- f. Selecting catalog pages within the retrieved set of catalog pages that correspond to the visually altered links, and presenting those catalog pages to the user (comparing data, displaying certain results).

Id. at 5.

Although the Examiner determines that the “abstract idea of visually altering links presented to a user in a two-dimensional format, wherein the links correspond to retrieved catalog pages that include products responsive to a search request” is an idea by itself that can be performed by a human manually (Ans. 4), the Examiner has not provided a reasoned rationale that identifies the judicial exception recited in the claim and why it is considered an exception. In other words, the Examiner does not adequately explain how *visually altering links* in the context of claim 1 can be performed by a human mind or by a human using pen and paper. The Examiner indicates that each of the steps performed in claim 1 is itself an abstract idea in light of the court’s decision in *CyberSource* and *Electric Power*, but the Examiner fails to articulate how the visually altering links by “[c]ausing only those links that correspond to the retrieved set of catalog pages to be visually altered” (*see* “d.” *supra*) constitutes comparing data and analyzing

information. Therefore, the record does not establish, sufficiently, that claim 1 is directed to a judicial exception (i.e., an abstract idea).

Accordingly, we do not sustain the rejection of independent claim 1 under § 101, including claims 2, 5, 6, 13, 14, 19, 21, and 25, which depend from claim 1.

Obviousness over Mayle and Rothey

Appellant contends that a prima facie case of obviousness has not been established because Mayle, on which the Examiner relies, does not disclose (1) causing the client device to retrieve from a server device a set of product catalog pages and (2) selecting from a memory of the client device a one of the product catalog pages with the retrieved set of product catalog pages that is linked to a selected one of a plurality of visually altered links. App. Br. 8–9.

However, the Examiner makes explicit findings regarding the elements taught by the prior art, explains how the elements are mapped to the respective claim elements, and cites to specific paragraphs in Mayle to support these findings. As for limitation (1), the Examiner finds that “Mayle discloses causing the client device (client, see [0433]) to retrieve (via a response, see [0434-0438]) from a server device (server, see [0433]) having an associated search engine a set of product catalog pages (matching items, see [0435]).” Ans. 8; *see also* Final Act. 8. And for limitation (2), the Examiner finds “Mayle discloses selecting from a memory (RAM, see [0447]) of the client device (client, see [0447]) a one of the product catalog pages (items, see [0432]) within the retrieved set of product catalog pages

that is linked to the selected one of the plurality of visually altered links⁴ (highlighted, colored overlay, bounding box, blinking field, see [0441]).”
Ans. 8; *see also* Final Act. 8.

Appellant’s arguments are unpersuasive because they are not aligned with the Examiner’s rejection. First, Appellant mischaracterizes the Examiner’s findings for limitations (1) and (2) by alleging that the Examiner “again asserted that Mayle discloses the claimed invention in paragraph 0432 thereof” (Reply Br. 4) implying that the Examiner relied *only* on this paragraph in rejecting the claim. Second, Appellant proceeds to distinguish the disputed limitations from paragraphs 77, 78, 94, and 365 of Mayle, *none* of which the Examiner relied upon in rejecting the claim. *See supra*. Thus, Appellant does not address why the argued claim limitations do not encompass the prior art disclosure cited by the Examiner. In other words, Appellant fails to persuade us of reversible error by distinguishing the Examiner’s actual findings in Mayle from the disputed limitations.

Therefore, we are not persuaded of error on the part of the Examiner in rejecting independent claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Mayle and Rothey. Thus, we sustain the rejection of claim 1, and dependent claims 2, 5, 6, 13, 14, 19, 21, and 25 for the same reasons, which are not argued separately.

⁴ “Note that Appellant has not lexicographically defined ‘visually altered links’, so under the broadest reasonable interpretation, Examiner finds that Mayle’s disclosure of a mask, highlighting, colored overlay, bounding box, and blinking field read on this claim limitation.” Ans. 8.

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DECISION

The rejection under 35 U.S.C. §112, first paragraph, is reversed.

The rejection under 35 U.S.C. § 101 is reversed.

The rejection under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED