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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* STEVEN W. LUNDBERG

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Appeal 2017-011247  
Application 13/253,811  
Technology Center 2100

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Before JOHN A. JEFFERY, BRUCE R. WINSOR, and  
JUSTIN BUSCH, *Administrative Patent Judges*.

WINSOR, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant<sup>1</sup> appeals under 35 U.S.C. § 134(a) from the final rejection of claims 1–4 and 6–19 which constitute all the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b). Claim 5 is cancelled. Final Act. 2.

We affirm and enter a new ground of rejection within the provisions of 37 C.F.R. § 41.50(b) (2015).

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<sup>1</sup> The real party in interest identified by Appellant is Black Hills IP Holdings, LLC. App. Br. 2.

STATEMENT OF THE CASE

*The Invention*

Appellant's disclosed invention "relates to document management, [and] more particularly to . . . information disclosure statement [(IDS)] management and prior art cross-citation control." Spec. ¶ 2. Claim 1, which is illustrative, reads as follows:

1. A method comprising:
  - maintaining a patent case database, wherein the database includes data about each patent case in the patent case database,
  - receiving a reference document into the database;
  - associating the reference document with a first patent case in the patent case database;
  - identifying a set of target patent cases including at least one patent case related to the first patent case as potential propagation target cases for cross-citation of the reference document;
  - displaying the identity of the set of target patent cases and a citation pathway between a respective target case of the set of target patent cases and the reference document, the citation pathway providing an identification of patent cases between an original patent case in which the reference document was originally cited and the respective of the set of target cases;
  - associating the reference document with one or more of the set of target patent cases based on:
    - comparing a priority date of the reference document and a priority date of a target patent case of the set of target patent cases; and
    - a ground of rejection on which the reference document was cited by a patenting authority.

*The Prior Art*

The Examiner relies on the following prior art in rejecting the claims:

Lundberg	US 2005/0246194 A1	Nov. 3, 2005 ("Lundberg '194")
Lundberg et al.	US 2006/0190449 A1	Aug. 24, 2006 ("Lundberg '449")
Rivette et al.	US 2007/0208669 A1	Sept. 6, 2007 ("Rivette")
Casey	US 2009/0282054 A1	Nov. 12, 2009

*The Rejections*

Claims 1–4 and 6–19 stand rejected under 35 U.S.C. § 101<sup>2</sup> as being directed to non-statutory subject matter. *See* Ans. 2–7.

Claims 1–4 and 6–19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Casey, Lundberg '194, Lundberg '449, and Rivette. *See* Final Act. 2–11.

*The Record*

Rather than repeat the arguments here, we refer to (1) the Briefs ("App. Br." filed Mar. 13, 2017; "Reply Br." filed Aug. 30, 2017) and the Specification ("Spec." filed Oct. 5, 2011) for the positions of Appellant; and (2) the Final Office Action ("Final Act." mailed Apr. 11, 2016) and Examiner's Answer ("Ans." mailed June 30, 2017) for the reasoning, findings, and conclusions of the Examiner. Only those arguments actually

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<sup>2</sup> All rejections are under the provisions of 35 U.S.C. in effect prior to the effective date of the Leahy-Smith America Invents Act of 2011.

Appeal 2017-011247  
Application 13/253,811

made by Appellant have been considered in this Decision. Arguments that Appellant did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

*Related Appeals*

Appellant did not identify any related appeals. *See* App. Br. 3.  
However, there are at least thirty-one (31) related appeals, which are:

<u>Appeal No.</u>	<u>Application No.</u>	<u>Decided/Status</u>
2009-005709	10/128,141	Decision mailed Mar. 23, 2010
2009-006404	10/874,486	Decision mailed Aug. 2, 2010
2011-009966	11/061,383	Decision mailed Jan. 31, 2014
2012-004166	11/061,312	Decision mailed Nov. 4, 2014
2015-000319	13/309,080	Decision mailed May 27, 2016
2015-000321	13/309,127	Decision mailed July 26, 2017
2015-003180	13/309,039	Decision mailed Sept. 23, 2016
2015-007422	13/309,146	Decision mailed June 1, 2016
2016-000912	13/309,060	Decision mailed Aug. 25, 2017
2016-001687	11/888,632	Decision mailed Jan. 19, 2017
2016-002121	13/309,200	Decision mailed Aug. 28, 2017
2016-002680	13/310,279	Decision mailed Aug. 30, 2017
2016-002792	12/605,030	Decision mailed Sept. 1, 2017
2016-006797	13/310,368	Decision mailed Aug. 30, 2017
2016-007186	13/573,803	Decision mailed July 28, 2017
2016-007415	13/464,598	Decision mailed July 31, 2017
2016-007623	13/408,877	Decision mailed Sept. 6, 2017
2016-007787	13/310,322	Decision mailed Sept. 20, 2017

Appeal 2017-011247  
Application 13/253,811

2016-008030	13/253,936	Decision mailed Aug. 3, 2017
2017-000280	13/408,917	Decision mailed Sept. 12, 2017
2017-000386	11/098,761	Pending
2017-002337	14/010,376	Decision mailed Sept. 8, 2017
2017-003702	14/483,903	Decision mailed Sept. 25, 2017
2017-003815	14/094,542	Decision mailed Sept. 18, 2017
2017-004158	14/010,391	Pending
2017-004159	14/010,380	Decision mailed Sept. 27, 2017
2017-004188	14/010,400	Pending
2017-006390	13/409,189	Pending
2017-006642	13/310,452	Decision mailed Sept. 27, 2017
2017-011549	14/608,520	Pending
2017-011552	14/628,941	Pending

### ISSUES

The issues presented by Appellant's arguments are as follows:

Does the Examiner err in finding claims 1–4 and 6–19 are directed to non-statutory subject matter under 35 U.S.C. § 101?

Does the Examiner err in finding Rivette, when combined with Casey, Lundberg '194, and Lundberg '449, teaches or suggests

displaying the identity of the set of target patent cases and a citation pathway between a respective target case of the set of target patent cases and the reference document, the citation pathway providing an identification of patent cases between an original patent case in which the reference document was

originally cited and the respective [target case<sup>3</sup>] of the set of target cases (the “citation pathway limitation”), as recited in claim 1?

Does the Examiner err in finding Lundberg ’449, when combined with Casey, Lundberg ’194, and Rivette, teaches or suggests “associating the reference document with one or more [target cases] of the set of target patent cases based on . . . a ground of rejection on which the reference document was cited by a patenting authority” (the “association based on a ground of rejection limitation”), as recited in claim 1?

## ANALYSIS

### REJECTION UNDER 35 U.S.C. § 101

In *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 71–73 (2012), the Supreme Court established an analytical framework under § 101 to distinguish patents that claim patent-ineligible laws of nature, natural phenomena, and abstract ideas—or add too little to such underlying ineligible subject matter—from those that claim patent-eligible applications of those concepts. To determine whether claims are patent eligible under § 101, we apply the Supreme Court’s two-step test as

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<sup>3</sup> Although, as discussed *infra* regarding a new ground of rejection, we conclude the citation pathway limitation is indefinite, for purposes of considering Appellant’s argument, and in the interest of compact prosecution, we presume the intended meaning is substantially as set forth here.

further articulated in *Alice Corp. Pty. Ltd. v. CLS Bank International*, 134 S. Ct. 2347 (2014).

*Alice Step One*

According to *Alice* step one, “[w]e must first determine whether the claims at issue are *directed to* a patent-ineligible concept,” such as an abstract idea. *Alice*, 134 S. Ct. at 2355 (emphasis added). “[T]he ‘directed to’ inquiry applies a stage-one filter to claims, considered in light of the [S]pecification, based on whether ‘their character as a whole is directed to excluded subject matter.’” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)).

The Background section of the Specification discusses the problem to be solved by the invention—that “[u]nder the laws and regulations of various patenting authorities, patent applicants are required to disclose various documents known to the applicant to be relevant to the patentability of the patent application,” which may be time consuming for various reasons. Spec. ¶ 3. According to the Specification, the inventor solved the problem by providing embodiments directed to collecting patent cases and reference documents, identifying patent cases related to a first patent case associated with a reference document, and displaying the patent cases related to the first patent case for user input. *Id.* ¶¶ 16, 20–21, 26. By allowing a user to select among the displayed patent cases related to the first patent case, cross-citation of reference documents between cases is regulated and controlled. *Id.* ¶ 19.

In light of the Specification discussed above, we agree with the Examiner that claim 1 is directed to the abstract idea of collecting,



analyzing, and displaying data, like the claim at issue in *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016). *See* Ans. 3. Here, claim 1 requires, in essence, maintaining a database of patent cases and reference documents, associating a reference document with a first patent case, identifying target patent cases, and displaying the target patent cases and a citation pathway. Appellant’s contention that the claims are directed toward “patent case cross-citation management” (*see* Reply Br. 2–6) involves the type of collecting, analyzing, and displaying data that *Electric Power* found directed to an abstract idea. Thus, we find “[t]he focus of the asserted claims . . . is on collecting information, analyzing it, and displaying [i.e., generating a report that presents] certain results of the collection and analysis.” *Electric Power*, 830 F.3d at 1353.

Further, Appellant’s argument that the claims have an inventive means for achieving a result because the claims describe the citation pathway limitation does not demonstrate Examiner error. Reply Br. 3. Similar to the claims in *Electric Power*,

the claims do not go beyond requiring the collection, analysis, and display of available information in a particular field, stating those functions in general terms, without limiting them to technical means for performing the functions that are arguably an advance over conventional computer and network technology. The claims, defining a desirable information-based result and not limited to inventive means of achieving the result, fail under § 101.

*Electric Power*, 830 F.3d at 1351. “Accordingly, we have treated collecting information, including when limited to particular content (which does not change its character as information), as within the realm of abstract ideas.” *Id.* at 1353. Therefore, we find that the Examiner did not err in determining

that the claims are directed to the abstract idea of receiving, analyzing, and displaying information.

*Alice Step Two*

Turning to the second step of the *Alice* analysis, because we find that claim 1 is directed to an abstract idea, we “consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 78). The Supreme Court describes the second step of this analysis as “a search for an inventive concept—*i.e.*, an element or combination of elements that is sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.” *Id.* (brackets in original) (internal quotations omitted).

Appellant argues the Examiner fails to provide a discussion of the claims as an ordered combination, as *Bascom Global Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1348 (Fed. Cir. 2016), suggests is necessary for a proper analysis under step two of the *Alice/Mayo* test. Reply Br. 2–3. We disagree. The Examiner explicitly states “the additional elements, when *considered* both individually and *as an ordered combination* do not amount to significantly more than the abstract idea.” Ans. 4 (emphases added). The Examiner explains as follows:

Looking at the limitations as an ordered combination adds nothing that is not already present when looking at the elements taken individually. There is no indication that the combination of elements improves the functioning of a computer or improves any other technology. Their collective functions merely provide conventional computer implementation.

*Id.*

Appellant further argues *Bascom* holds that an inventive concept is found in an arrangement of elements known in the art, in general, and not just for arrangements involving a filter action. Reply Br. 3. We disagree. First, *Bascom* did not hold that merely having an arrangement of elements known in the art was sufficient to satisfy the second step of *Alice*. Instead, *Bascom* held that “an inventive concept can be found in the non-conventional and non-generic arrangement of known, conventional pieces.” *Bascom*, 827 F.3d at 1349–50. Second, the record here shows that the claimed arrangement is entirely conventional. Appellant does not provide any persuasive explanation of how the recited ordered combination of these elements amounts to an inventive concept that converts an abstract idea into patent-eligible subject matter.

Thus, “the claims at issue amount to ‘nothing significantly more’ than an instruction to apply the abstract idea . . . using some unspecified, generic computer.” *Alice*, 134 S. Ct. at 2360 (citing *Mayo*, 566 U.S. at 71). Accordingly, we find the Examiner did not err in finding the additional elements do not transform the nature of the claim into a patent-eligible application of the abstract idea.

#### *Summary*

We conclude Appellant has not demonstrated that the Examiner erred in rejecting claim 1 under § 101. Accordingly, we sustain the rejection of claim 1 and claims 2–4 and 6–19, which are not argued separately with particularity. *See* Reply Br. 7.

REJECTION UNDER 35 U.S.C. § 103

*Citation Pathway Limitation*

Appellant contends as follows:

[T]he *citation pathway [limitation]* recites a definite start, *the reference document*, and a definite end, *the respective target case of the set of target patent cases*. . . . The *citation pathway [limitation]* is constructing a path between the target case and the reference document through *identification of patent cases*. Appellant's citation pathway . . . identifies the specific patent cases that connect the reference document and target case. Appellant's *citation pathway* provides a relationship chain informing the user of the path between the *target case* and the *original patent case* that is the source of the *reference document*. . . . If any of the patent cases in the pathway are not cited by the *original patent case*, then it is not a *citation pathway*.

App. Br. 11 (emphases in original and added in brackets); *see also* Reply Br. 9. In support of these contentions, Appellant provides an example, without directing attention to a section of Appellant's Specification, involving a citation pathway including a definite start labeled "Reference Document," a definite end labeled "Target Case," and a finite number (three) of patents between the definite start and the definite end. App. Br. 11.

We disagree because Appellant's argument is not consistent with the broadest reasonable interpretation of claim 1. Claim construction is an issue of law that is reviewable *de novo*. *See Cordis Corp. v. Boston Scientific Corp.*, 561 F.3d 1319, 1331 (Fed. Cir. 2009). Arguments must be commensurate in scope with the actual claim language. *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982).

The citation pathway limitation of claim 1 recites:

displaying the identity of the set of target patent cases and a citation pathway between a respective target case of the set of target patent cases and the reference document, the citation

pathway providing an identification of patent cases between an original patent case in which the reference document was originally cited and the respective of the set of target cases.

App. Br. 15 (Claims App'x). Contrary to Appellant's contentions (App. Br. 11; Reply Br. 9), the Examiner finds, and we agree, that (1) "[n]owhere does the claim language require a 'definite start' and a 'definite end'" (Ans. 10); (2) "[t]here is no indication in the claim language that any patent case has any relevance over another" (*id.*); (3) and "[t]he claims . . . do not specify that the patent cases must be cited by the original patent case" (*id.* at 11).

Appellant further contends Rivette's branching tree, as illustrated in Figure 65 of Rivette, does not teach the citation pathway limitation. App. Br. 9–10. In particular, Appellant argues that although patent 1 cites patents 2–4 and patents 2–4 cite patents 5–12, "PATENTS 5–12 have no direct relation to PATENT 1 and thus none are a *reference document* that was *originally cited.*" *Id.*

Appellant's contention regarding Rivette's shortcomings pertaining to the citation pathway limitation do not demonstrate error. Notably, the Examiner's rejection is not based on Rivette standing alone, but rather the Examiner relies on the collective teachings of Casey and Rivette to teach or suggest the citation pathway limitation. *See* Final Act. 3–6 (citing (1) Casey ¶¶ 28–29, 33–34, Figs. 1–2, 5; and (2) Rivette ¶ 946, Fig. 65). One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *See In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986); *see also In re Keller*, 642 F.2d 413, 426 (CCPA 1981).

We agree with the Examiner’s findings in the Final Office Action and adopt them as our own.

Casey is generally directed “to track[ing] information about patent cases and the references that have been and will be cited therein.” Casey, Abstract. Casey’s patent application is associated with a reference either submitted by a user or considered by an examiner. *Id.* ¶¶ 28–29. Thus, in that sense, then, Casey at least suggests identifying a patent application (the claimed “original patent case”) in which a reference (the claimed “reference document”) was originally cited.

The Examiner finds Rivette teaches displaying a citation pathway between cases. Final Act. 3–6 (citing Rivette ¶ 946, Fig. 65). Figure 65 of Rivette is illustrative and is reproduced below:

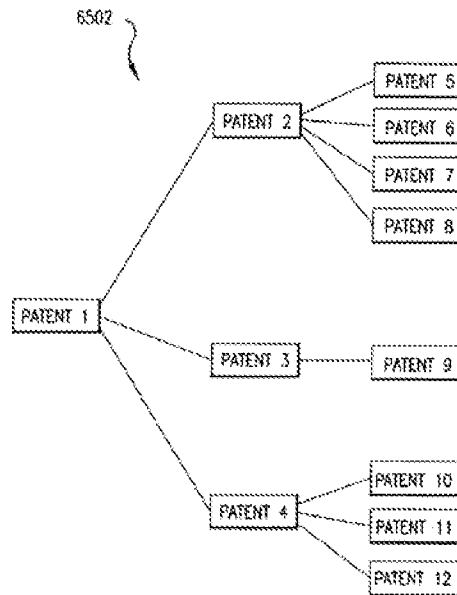


FIG. 65

Rivette’s Figure 65 illustrates a two-level “patent citation report.”  
Rivette ¶ 946.

As illustrated in Figure 65 of Rivette, “patents 2–4 are cited in source patent 1[,] . . . patents 5–8 are cited in patent 2, patent 9 is cited in patent 3, and patents 10–12 are cited in patent 4.” *Id.* ¶ 946.

In other words, the person of ordinary skill in the art would have learned from Casey to identify a patent application in which a reference was originally cited, and would have learned from Rivette to present citation relationships among patents in the form of a pathway.

Thus, the Examiner finds, and we agree, the combination of Rivette and Casey teaches or suggests replacing Rivette’s patent 1 with Casey’s patent application in which a reference was originally cited. Thus, the combination of Rivette and Casey teaches or suggests a two-level patent citation report (the claimed “citation pathway”) providing an identification of patents 2–4 (the claimed “patent cases”) between patent 1 (Casey’s patent application associated with a reference as discussed above; the claimed “original patent case in which the reference document was originally cited”) and patents 5–12 (the claimed “respective [target case] of the set of target cases”). *See* Final Act. 3–6.<sup>4</sup>

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<sup>4</sup> We are mindful that the Examiner gives an alternative mapping in the Answer. *See* Ans. 9. We do not rely on that alternative mapping in the Answer, but rather the contested aspects of the final rejection under 35 U.S.C. § 103(a). The fact that we rely on fewer than all of the Examiner’s explanations does not, in itself, warrant a new ground of rejection. *Cf. In re Bush*, 296 F.2d 491, 496 (CCPA 1961). “The Board of Patent Appeals and Interferences shall, on written appeal of an applicant, review adverse decisions of examiners upon applications for patents.” 35 U.S.C. § 6. The appeal brief shall contain “arguments of appellant with respect to *each ground of rejection*, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the Record relied on.”

Therefore, Appellant’s arguments regarding Rivette’s individual shortcomings in this regard do not show nonobviousness where, as here, the rejection is based on the cited references’ collective teachings.

*Association Based on a Ground of Rejection Limitation*

The Examiner relies on Lundberg ’449, when combined with Casey, Lundberg ’194, and Rivette, to teach or suggest “associating the reference document with one or more of the set of target patent cases based on: . . . a ground of rejection on which the reference document was cited by a patenting authority,” as recited in claim 1. Final Act. 5 (citing Lundberg ’449 ¶¶ 78–80, 84–85).

Appellant asserts “[a]ssociating the reference documents based on the ground of rejection, [sic] provides a pertinent association and information that shows significance to the user.” App. Br. 13 (emphasis added). Appellant argues “nowhere in Lundberg [’]449 are the documents associated with the client matter based on the grounds of rejection. The documents listed in the IDS are merely listed because they may have been cited in a rejection, not based on the grounds of rejection.” *Id.* at 12 (emphasis in original and added).

We are not persuaded of error. At the outset, we note Appellant does not direct our attention to, nor do we find, any passage of the Specification or other evidence that would lead us to a construction of “based on” other

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37 C.F.R. § 41.37(c)(1)(iv) (emphasis added). “If an appellant fails to present arguments on . . . a *particular rejection* — the Board will not, as a general matter, unilaterally review those uncontested aspects of the rejection.” *See Ex parte Frye*, 94 USPQ2d 1072, 1075–76 (BPAI 2010) (precedential) (emphasis added).



than the plain meaning of “based”—“to find a base or basis for,” MERRIAM-WEBSTER’S COLLEGIATE DICTIONARY 94 (*vt.* def. 2) (10th ed. 1999); “base,” in turn, means “the fundamental part of something,” *id.* (*n.* def. 3a), while “basis” means “something on which something else is established” *id.* at 95 (*n.* def. 3a).

Lundberg ’449’s management of IDS citations includes automatically relating an IDS with related cases and files. Lundberg ’449 ¶ 83. Lundberg ’449 teaches or suggests that art cited during prosecution may originate from the United States Patent and Trademark Office (USPTO) using applicable legal statutes, such as 35 U.S.C. §§ 102, 103(a). *Id.* ¶ 84. In other words, Lundberg ’449 teaches that the art cited may be cited in a ground of rejection (i.e., pursuant to 35 U.S.C. §§ 102, 103(a)). Lundberg ’449’s management system maintains the cited art that originated from the USPTO in an “information disclosure document” that is copied from a first client matter to a second client matter (*id.* ¶ 85) and identifies the art as related to a rejection (*id.* ¶ 84). Thus, Lundberg ’449 teaches or suggests associating the cited art (the claimed “reference document”) with a first or second client matter (the claimed “one or more of the set of target patent cases”) *based on* a ground of rejection on which the cited art was cited by the USPTO (the claimed “patenting authority”) because Lundberg ’449’s information document is established, at least in part, from grounds of rejection cited by the USPTO. We note that nothing in the claim precludes associating additional documents, not cited in a ground of rejection, with the target cases.

*Summary*

Appellant has not established that the Examiner erred in rejecting claim 1 under § 103. Accordingly, we sustain the rejection of claim 1 and claims 2–4 and 6–19, which are not argued separately with particularity. *See* App. Br. 13.

NEW GROUND OF REJECTION UNDER 35 U.S.C. § 112, 2ND PARAGRAPH,  
WITHIN 37 C.F.R. § 41.50(b)

Claims 1–4 and 6–19 are rejected on a new ground of rejection under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which the Appellant regards as the invention.

During prosecution, “[a] claim is indefinite when it contains words or phrases whose meaning is unclear.” Manual of Patent Examining Procedure (MPEP) § 2173.05(e), 9th ed., Rev. 7, Nov. 2015. Language in a claim is unclear if it is “ambiguous, vague, incoherent, opaque, or otherwise unclear in describing and defining the claimed invention . . .,” *In re Packard*, 751 F.3d 1307, 1311 (Fed. Cir. 2014), or if it is “is amenable to two or more plausible claim constructions . . .,” *Ex parte Miyazaki*, 89 USPQ2d 1207, 1211 (BPAI 2008) (precedential).

The USPTO is justified in using a lower threshold showing of ambiguity to support a finding of indefiniteness under 35 U.S.C. §112, second paragraph, [than that used in litigation] because the applicant has an opportunity and a duty to amend the claims during prosecution to more clearly and precisely define the metes and bounds of the claimed invention and to more clearly and precisely put the public on notice of the scope of the patent.

*Id.* at 1211–12.

*Claim 1*

Claim 1 recites a citation pathway providing an identification of patent cases between an original patent case in which a reference document was originally cited and “the respective of the set of target cases.” The phrase “the respective of the set of target cases” imparts ambiguity to the claim. More specifically, it is unclear as to what the phrase “the respective of” refers. Therefore, the phrase “the respective of the set of target cases” renders claim 1 indefinite.

*Claims 14–16*

Independent claims 14–16 recite the terms and phrases discussed above regarding claim 1. We conclude these terms and phrases render claims 14–16 indefinite for the same reasons they render claim 1 indefinite.

*Dependent Claims*

We have entered new grounds of rejection for independent claims 1 and 14–16 for indefiniteness. Claims 2–4, 6–13, and 17 depend, directly or indirectly, from claim 1 and are indefinite at least because they depend from, and incorporate, an indefinite claim. Similarly, (1) claim 18 depends from claim 15; and (2) claim 19 depends from claim 16, and are indefinite at least because they depend from, and incorporate, an indefinite claim. We note that we have not reviewed claims 1–4 and 6–19 to ascertain if there are additional words or phrases whose meaning is unclear.

DECISION<sup>5</sup>

The Examiner's decision to reject claims 1–4 and 6–19 under 35 U.S.C. §§ 101, 103(a) is affirmed.

We enter a new ground of rejection for claims 1–4 and 6–19 under § 112, second paragraph pursuant to 37 C.F.R. § 41.50(b).

Regarding the affirmed rejection(s), 37 C.F.R. § 41.52(a)(1) provides “Appellant may file a single request for rehearing within two months from the date of the original decision of the Board.”

In addition to affirming the Examiner's rejection(s) of one or more claims, this decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

Section 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of

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<sup>5</sup> In the event of further prosecution, the Examiner may wish to consider whether independent claim 15 meets the requirements of 35 U.S.C. § 112, first and sixth paragraphs. In particular, the Examiner may wish to consider: (1) whether or not the phrase “at least one module . . . to” (claim 15) is a generic placeholder for “means for” and invokes 35 U.S.C. § 112, sixth paragraph, *see* MPEP § 2181(I); (2) if the Examiner determines the at least one module invokes 35 U.S.C. § 112, sixth paragraph, whether “one or more computer processors” (claim 15) is a sufficient structural modifier, *id.*; and (3) if the Examiner determines the “one or more computer processor” (claim 15) is not a sufficient structural modifier, whether claim 15 is a single means claim and subject to an enablement rejection under 35 U.S.C. § 112, first paragraph. *See* MPEP § 2164.08(a). Although the Board is authorized to reject claims under 37 C.F.R. § 41.50(b), no inference should be drawn when the Board elects not to do so. *See* MPEP § 1213.02.

the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record.

Should Appellant elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If Appellant elects prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Patent Trial and Appeal Board for final action on the affirmed rejection, including any timely request for rehearing thereof.

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). *See* 37 C.F.R. §§ 41.50(f), 41.52(b).

AFFIRMED  
37 C.F.R. § 41.50(b)