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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/851,999	03/28/2013	Peter Daniel Wallis	31547-176 / LEN0045NA	4177
146524	7590	11/18/2019	EXAMINER	
Dinsmore & Shohl LLP 255 E. Fifth Street Suite 1900 Cincinnati, OH 45202			GOLDEN, STEVE PETER	
			ART UNIT	PAPER NUMBER
			2144	
			MAIL DATE	DELIVERY MODE
			11/18/2019	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PETER DANIEL WALLIS, ALYSON LEE PIPER,
MATTHEW DAVID LAWRENCE, and
TRISNADI KURNIAWAN

Appeal 2018-007409
Application 13/851,999
Technology Center 2100

Before JOSEPH L. DIXON, ST. JOHN COURTENAY III, and
CATHERINE SHIANG, *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 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

The claims are directed to a computer program products and methods for displaying digital looseleaf content. The method displays of a first table of contents page of a digital looseleaf. In response to receipt of a user selection of a representation of an individual one of the plurality of main sections, a second table of contents page is displayed overtop the first table of contents page such that an edge portion of the first table of contents page is unobstructed by the second table of contents page. In response to receipt of a user input in the edge portion of the first table of contents page, an entirety of the first table of contents page is displayed. (Abstract.) Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A computer program product comprising:
a non-transitory, processor-readable storage medium having computer readable instructions embodied therein for displaying information relating to one or more digital looseleaves, the computer readable instructions, when executed by a processor, cause the processor to:

display a first table of contents page of a digital looseleaf on a computer display, wherein:

the digital looseleaf comprises hierarchically organized content: and

¹ We use the word ‘Appellant’ to refer to ‘applicant’ as defined in 37 C.F.R. § 1.42 (2017). Appellant identifies the real party in interest as LexisNexis, a Division of Reed Elsevier Inc. (Appeal Br. 2.)

the first table of contents page displays a representation of a plurality of main sections associated with the hierarchically organized content:

receive a user selection of a representation of an individual one of the plurality of main sections;

automatically generate a second table of contents page in response to the user selection, wherein the second table of contents page contains existing content that has been updated in real time from information received from a publisher;

display the second table of contents page overtop the first table of contents page such that an edge portion of the first table of contents page is unobstructed by the second table of contents page, wherein the edge portion contains at least a portion of the representation of the plurality of main sections and the second table of contents page displays a representation of a plurality of first sub-sections associated with the selected representation of the individual one of the plurality of main sections; and

in response to receipt of a user input in the edge portion of the first table of contents page, display an entirety of the first table of contents page.

REFERENCES

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

Campagna	US 2009/0254802 A1	Oct. 8, 2009
Safars	US 2010/0005381 A1	Jan. 7, 2010
Tanaka	US 2010/0329567 A1	Dec. 30, 2010
Worrall	US 2011/0066966 A1	Mar. 17, 2011

REJECTION

The Examiner made the following rejection:

Claims 1–20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Worrall in view of Safars, Tanaka, and Campagna.

ANALYSIS

With respect to independent claims 1, 9, and 17, Appellant presents substantive arguments to independent claim 1 and relies upon those arguments with respect to independent claims 9 and 17. (Appeal Br. 36.) As a result, we select independent claim 1 as the illustrative claim and will address Appellant’s arguments thereto. *See* 37 CFR 41.37 (c)(1)(iv).

With respect to a representative independent claim 1, Appellant argues that the prior art does not teach “digital looseleafs,” but rather discloses “binder files” for printing out sections of a paper to be placed in a binder regarding the Worrall reference. (Appeal Br. 26–27.) Appellant contends that the “digital looseleaf” is described at paragraph 25 of the Specification:

term “looseleaf” is used herein to describe looseleaf publications, looseleaf titles, or looseleaf services that are documents made up of individually updated content particular to a topic (e.g., a legal topic or a medical topic). Embodiments described herein allow users to view digital rather than paper looseleafs. Each digital looseleaf comprises content pages that are organized into sections (e.g., main sections and various sub-sections).

(Appeal Br. 27–28.) Appellant further contends that “digital looseleaf” is a specific collection of “individually updated content particular to a topic” as

stated in the present Specification as originally filed and a person having ordinary skill in the art would recognize a physical binder can be used to hold any collection of individual and separate documents together, but not individually updated sections that, as a whole make up a single document that is particular to a topic. (Appeal Br. 28.)

We additionally note that the Specification in paragraph 6 provides context for the interpretation of the “digital looseleaf” that comprises “hierarchically organized content, and the first table of contents page displays a representation of a plurality of main sections associated with the hierarchically organized content.”

Appellant contends that the Worrall reference merely mentions “looseleaves” with regards to printing out papers to add to a physical binder. (Appeal Br. 28.) Although we agree with Appellant that the Worrall reference mentions “looseleaves,” we agree with the Examiner that the Worrall reference at least teaches and suggests separable content for different subjects which we find to be “digital looseleaves” under the broadest reasonable interpretation of the claimed invention.

Appellant argues that the art of record does not evidence “a non-transitory, processor-readable storage medium having computer readable instructions embodied therein for displaying information relating to one or more digital looseleaves.” (Appeal Br. 28.) We disagree with Appellant and find the Worrall reference discloses a storage medium for a computer which does have instructions for displaying information relating to digital data about looseleaves. Therefore, Appellant’s argument does not show error in the Examiner’s underlying factual findings or legal conclusion of obviousness of representative independent claim 1.

Appellant further argues that the combination Worrall and Safars with Tanaka discloses a second table of contents that is displayed over a first table of contents such that a portion of the first table of contents page is unobstructed is incorrect. (Appeal Br. 29–30.)

We find that although the Tanaka reference does not specifically teach overlaying the table of contents with a second table of contents, Tanaka clearly teaches cascading pages of content, which was well-known at the time of the invention. For example, the Tanaka reference discloses the cascading of pages in Figure 10 and described in paragraph 71. (Ans. 5.) Furthermore, the Safars reference in Figures 8A–8D shows the use of tabs with corresponding labels for the sections or functions for organizing information on the screen. As a result, we find that displaying the edge of the table of contents with a portion of the reviewable text under the top cascaded sheet is not different functionally and would have been the mere placement of the nonfunctional descriptive material at a different location on the page/screen.²

Furthermore, we note that the Safars reference discloses the overlaying of pages with cascading pages with the table of contents in Figure 9. (Safars ¶ 37 “In order to navigate through the book from the table

² “[W]here the claim as a whole is directed to conveying a message or meaning to a human reader independent of the intended computer system, and/or the computer-readable medium merely serves as a support for information or data, no functional relationship exists.” MPEP § 2111.05 (III.). *See also Ex parte Nehls*, 88 USPQ2d 1883, 1889 (BPAI 2008) (precedential) (“[T]he nature of the information being manipulated does not lend patentability to an otherwise unpatentable computer-implemented product or process.”).

of contents, the reader has the option of converting the page of the table of contents into a ‘loose leaf’ separator, by reference to FIG. 9, placed above the left-hand page of the book.”)

Therefore Appellant’s argument that the prior art does not teach a “storage medium having computer readable instructions embodied therein for displaying information relating to one or more digital looseleaves” is not persuasive because Appellant has not shown that the claimed “digital looseleaves” are distinguishable from the disclosed pages taught by the Safars, Tanaka, and Worrall references. (Appeal Br. 29.)

Appellant further argues that the Examiner’s reasoning for the proposed combination is deficient based upon impermissible hindsight. (Appeal Br. 33–35.) Appellant further contends that the Examiner’s reasoning was deficient and relies upon the reasoning present in the Specification and “the fact that such reasoning is only present in the present specification at paragraph [0051], it logically follows that the reasoning has been improperly obtained from the present specification and the combination of Worrall, Safars, and Tanaka is an exercise of impermissible hindsight.” (Appeal Br. 35.)

While we are fully aware that hindsight bias often plagues determinations of obviousness, *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 36 (1966), we are also mindful that the Supreme Court has clearly stated that the “combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, 550 U.S. at 401.

This reasoning is applicable here, and we find unavailing Appellant’s contention that the Examiner has relied on impermissible hindsight

reconstruction. That is, given the breadth of Appellant's claims, we are not persuaded that combining the respective familiar elements of the cited references in the manner proffered by the Examiner was "uniquely challenging or difficult for one of ordinary skill in the art." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 418). Therefore, we find the Examiner's proffered combination of familiar prior art elements according to their established functions would have conveyed a reasonable expectation of success to a person of ordinary skill having common sense at the time of the invention.

We disagree with Appellant and do not find the Examiner has relied upon improper hindsight reconstruction in the combination.

Appellant further argues that the Examiner's assertion that purported combination of the Worrall, Safars, and Tanaka with Campagna references disclose a second table of contents that contains content that has been updated in real time from information received by a publisher is incorrect. (Appeal Br. 31).

The Examiner maintains that the Campagna reference teaches the claimed "automatically generate a second table of contents page in response to the user selection, wherein the second table of contents page contains existing content that has been updated in real time from information received from a publisher." (Final Act. 6). The Examiner further finds that the Campagna reference teaches "the real-time aspect and monitoring of the creation of the book in real-time." (Final Act. 6, citing Campagna ¶ 109.) We find the Examiner's reliance upon paragraph 109 (along with Campagna ¶¶ 21, 23, 51, 70, and 85; Ans. 7-8) to teach the claimed "real-time" updating of content to be unsupported by the cited paragraphs of the

Campagna reference because we find the real-time processing relied upon in the Campagna reference pertains to generating and creating the e-book and not to updating of the content of an already generated digital publication. Moreover, none of the paragraphs identified by the Examiner disclose any updating of content because we find those paragraphs in the Campagna reference disclose a tool to generate an original work in a digital publication or e-book and this original digital publication merely contains a table of contents.

The Examiner also maintains that the Safars reference also teaches the updating function, but the Examiner identifies the function of creating a new blank book which has a table of contents automatically created, but only creates one single table of contents within a blank e-book, and the Examiner not has not identified any additional teaching of automatically updating in real-time. (*See generally* Ans. 9, Response IV.) Furthermore, we find the Examiner's reliance upon the Safars reference to be unreasonable because the update function would not be from the "publisher," as required by the language of independent claim 1.³

Although the Safars reference teaches multiple chapters with multiple tables of contents for each of the separate chapters, the Examiner has not identified any teaching or suggestion in the Safars reference that there is a

³ We leave it to the Examiner, in any further prosecution on the merits, to determine if the label/name of the source of the update makes a functional distinction.

linkage between an initial tables of contents for the chapters that makes the corresponding update in the initial table of contents.⁴

Appellant contends that Worrall, Safars, Tanaka, and Campagna, whether considered alone or in any combination, fail to teach or fairly suggest each and every recitation of independent claim 1. (Appeal Br. 35.)

We agree with Appellant that the Examiner is not shown each of the steps to be performed by a programmed processor as recited in the language of illustrative claim 1. Because Appellant has identified an error in the Examiner's factual findings and conclusion of obviousness of independent claim 1, we reverse the Examiner's obviousness rejection of illustrative independent claim 1 and dependent claims 2–8 containing the same limitations.

With respect to independent claims 9 and 17, Appellant relies upon the same arguments is stated with regards to independent claim 1. Because independent claims 9 and 17 contain similar limitations, we cannot sustain the Examiners obviousness rejection of independent claims 9 and 17 and dependent claims 10–16 and 18–20.

⁴ We further note that the Safars reference discloses the use of a "navigation book," hyperlinks, and automatic updates of programs into the library. (*See* Safars ¶ 56 et seq.) We also find that the Safars reference also teaches and suggests updating of content, but the Examiner did not rely upon these disclosures in the rejection. (*See* Safars ¶¶ 99, 179, 188, 193–199.) We leave it to the Examiner to further evaluate these additional teachings in the Safars reference in any further prosecution on the merits.

CONCLUSION

The Examiner erred in rejecting claims 1–20 based upon obviousness under 35 U.S.C. § 103 (a).

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Basis	Affirmed	Reversed
1–20	103	Worrall, Safars, Tanaka, Campagna		1–20
Overall outcome				1–20

REVERSED