2010 WL 3389297 (Bd.Pat.App. & Interf.)

Board of Patent Appeals and Interferences
Patent and Trademark Office (P.T.O.)

***1** Ex Parte Brian S. Christian, Russell M. Eames, Thomas Fakes, and Bhavesh R. Thaker

Appeal 2009-006589
Application 10/606,089 Technology Center 2400

August 23, 2010

Before JAMES D. THOMAS, ST. JOHN COURTENAY III, and JAMES R. HUGHES
Administrative Patent Judges
THOMAS
Administrative Patent Judge

DECISION ON APPEAL[FN1]

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1, 4-12, 16-21, and 24-28. Claims 2, 3, 13-15, 22, and 23 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We vacate the rejection under 35 U.S.C. §102 before us and institute a new ground of rejection within the provisions of 37 C.F.R. § 41.50(b).

Invention

SUMMARY

Systems and methods are described for declarative client input security screening. The techniques described herein are "declarative" in that the functional aspects of the techniques are performed outside individual page code. As a result, the security screening can be performed for one or more web pages in a single declarative location, thereby making maintenance, review and updates more efficient, reliable and manageable.

A configuration module in a web-based application (or project) that includes one or more web pages is designed to allow client input to be screened for the web pages by declaring particular screening attributes and actions therein. A global section in such a configuration module includes security screens that apply to input of all types, while other individual sections include security screens that apply only to input of particular type. The global section provides a way to consolidate screening that applies to all client input types, thereby precluding redundant screens having to be maintained in each individual section.

(Summary of Invention, Spec. 2, l.14- 3, l. 2; Figs. 2, 3.)

Representative Claim

1. A method, comprising:
receiving data input through a web page from a client device;

referencing a declarative module to determine a client input security screen to apply to the data input from the client device, wherein the declarative module comprises:

a global section that includes at least one client input security screen that applies to any type of client input value; and

an individual values section that includes at least one client input security screen that applies to a particular type of client input value; and

applying multiple client input security screens to the data input from the client device, including at least one client input security screen from the global section of the declarative module and at least one client input security screen from the individual values section of the declarative module, wherein the client input security screens are distinct from one another, and wherein said act of referencing comprises first using the global section to screen one or more client input values and then using the individual values section to screen at least one of said one or more client input values.

Prior Art and Examiner's Rejection

*2 The Examiner relies on the following reference as evidence of anticipation:

David Scott & Richard Sharp, Proceedings of the 11th International World Wide Web Conference: Abstracting Application-Level Web Security 396-407 (2002) ("Scott").

All claims on appeal 1, 4-12, 16-21, and 24-28, stand rejected under 35 U.S.C. §102(b) as being anticipated by Scott.

ANALYSIS

We vacate the prior art rejection encompassing all claims on appeal because we conclude that all claims on appeal, claims 1, 4-12, 16-21 and 24-28, are "barred at the threshold by § 101." *In re Comiskey,* 554 F.3d 967, 973 (Fed. Cir. 2009) (citing *Diamond v. Diehr,* 450 U.S. 175, 188 (1981)). Therefore, the following new ground of rejection is set forth in this Opinion within the provisions of 37 C.F.R. § 41.50(b).

NEW REJECTION UNDER 35 U.S.C. § 101

PRINCIPLES OF LAW

Statutory Subject Matter

The subject matter of claims permitted within 35 U.S.C. § 101 must be a machine, a manufacture, a process, or a composition of matter. Moreover, our reviewing court has stated that "[t]he four categories [of § 101] together describe the exclusive reach of patentable subject matter. If the claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful." *In re Nuijten,* 500 F.3d 1346, 1354 (Fed. Cir. 2007); *accord In re Ferguson,* 558 F.3d 1359 (Fed. Cir. 2009). This latter case held that claims directed to a "paradigm" are nonstatutory under 35

U.S.C. § 101 as representing an abstract idea. Thus, a "signal" cannot be patentable subject matter because it is not within any of the four categories. *In re Nuijten,* 500 F.3d at 1357. Laws of nature, abstract ideas, and natural phenomena are excluded from patent protection. *Diamond v. Diehr,* 450 U.S. at 185. A claim that recites no more than software, logic or a data structure (i.e., an abstraction) does not fall within any statutory category. *In re Warmerdam,* 33 F.3d 1354, 1361 (Fed. Cir. 1994). Significantly, "[a]bstract software code is an idea without physical embodiment." *Microsoft Corp. v. AT&T Corp.,* 550 U.S. 437, 449 (2007). The unpatentability of abstract ideas was reaffirmed by the U.S. Supreme Court in *Bilski v. Kappos,* 130 S.Ct. 3218 (2010).

*3 With this background in mind, all claims on appeal, 1, 4-12, 16-21, and 24-28, are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

Consistent with our earlier-noted invention statement taken from Appellants' Summary of Invention, the disclosed and claimed invention is directed to software per se, abstract ideas, abstract concepts and methodologies and the like, including various data structures and named entities, such as a declarative module and various sections thereof, software, software applications, and abstract intellectual processes associated with them within the claims on appeal.

The claimed declarative module appears to comprise the disclosed Client Input Security Screening Unit (CISS Unit) illustrated in Figure 2 to in turn comprise the claimed global screen concept and the claimed individual value screen concept. Figure 3 is characterized as a methodological implementation of a declarative client input security screening concept for web-based services. Essentially, it sets forth the software logic embodying the invention. To the extent recited in the claims, the web services, servers, browsers and clients appear to be software entities in and of themselves and they are not necessarily stated or claimed to be embodied in hardware structure.

This analysis is most descriptive of the subject matter of method independent claim 1 on appeal. Corresponding features from this claim are recited in the body of system independent claim 12 and the media independent claim 21. The recitation of the network in independent claims 12 and 21 as well as the recitation in the preamble of the computer-readable storage media in independent claim 21 appear to relate to signals per se. It appears that the computer program is directly intended to be recited in the independent claim 21 since the recited media is directed to computer-executable instructions that perform the methodology in the body of this claim substantially identically to the methodology of independent method claim 1 on appeal. Moreover, the claimed computer-readable media in the preamble of independent claim 21 is directly taught at Specification page 17, line 3 through page 18, line 2 to comprise communication media and thus signal embodiments per se, and media that include and encompass signals per se are proscribed by the earlier-noted case law. Note also the analysis provided by *Subject Matter of Eligibility of Computer Readable Media,* 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010).

CONCLUSION and DECISION

We have *pro forma* vacated the outstanding rejection over applied prior art of all claims on appeal, claims1, 4-12, 16-21 and 24-28. We have instituted a new ground of rejection within 37 C.F.R. § 41.50(b). This new rejection of all claims on appeal is based upon 35 U.S.C. § 101 since these claims are directed to non-statutory subject matter.

*4 A new ground of rejection is pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that: "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 C.F.R. § 1.197(b)) 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 proceeding will be remanded to the examiner….

(2) *Request rehearing.* Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record….

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

<u>VACATED; 37 C.F.R. § 41.50(b)</u>

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FN1. The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

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