

2010 WL 3441058 (Bd.Pat.App. & Interf.)

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

\*1 Ex Parte Joseph A. Russo, Mustansir Banatwala, Miguel A. Estrada, and Sami M. Shalabi

Appeal 2009-001876  
Application 10/744,301  
[FN1]

Technology Center 2100

August 30, 2010

CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP  
STEVEN M. GREENBERG  
950 PENINSULA CORPORATE CIRCLE  
SUITE 2022  
BOCA RATON, FL 33487

Before ROBERT E. NAPPI, JAY P. LUCAS, and BRADLEY W. BAUMEISTER  
Administrative Patent Judges  
LUCAS  
Administrative Patent Judge

DECISION ON APPEAL<sup>[FN2]</sup>

**STATEMENT OF THE CASE**

Appellants appeal from a final rejection of claims 1 to 12 under authority of 35 U.S.C. § 134(a). The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

We affirm the rejections.

Appellants' invention relates to a system and method supporting collaborative work by a community of users using a directory structure to assign tools to the roles that the users assume. In the words of Appellants:

The present invention is a method, system and apparatus for hierarchically grouping a community of users within in a directory structure for hierarchically grouping a community of users within a directory structure. A hierarchical grouping system can include a collaborative context having a community of subscribers, one or more roles assigned to the subscribers, and one or more tools and resources configured for access by the subscribers the access being limited by the roles. The system further can include a directory having entries associated with the subscribers. Notably, the directory can have a single hierarchical structure. Finally, the system can include a mapping between the directory and the roles in the collaborative context. Notably, the collaborative context can be a named collaborative space disposed in a portal environment and the directory can include an LDAP directory.

(Abstract, Spec. 17).

The following illustrates the claims on appeal:

Claim 1:

1. A hierarchical grouping system comprising:
  - a collaborative context comprising a community of subscribers, a plurality of roles assigned to said subscribers, and a plurality of tools and resources configured for access by said subscribers said access being limited by said roles;
  - a directory comprising entries associated with said subscribers, said directory having a single hierarchical structure;
  - and,
  - a mapping between said directory and said roles in said collaborative context.

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

Barnett	US 2003/0163438	Aug. 28, 2003
Keats	US 6,738,828	May 18, 2004 (filed on Jul. 06, 2000)

### REJECTIONS

\*2 The Examiner rejects the claims as follows:

R1: Claims 1 to 12 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

R2: Claims 1 and 3 to 12 stand rejected under 35 U.S.C. § 102(e) for being anticipated by Barnett.

R3: Claim 2 stands rejected under 35 U.S.C. § 103(a) for being obvious over Barnett in view of Keats.

We will review the rejections in the order argued, and as grouped in the Briefs. We have only considered those arguments that Appellants actually raised in the Briefs. Arguments that Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

### ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 101, 35 U.S.C. § 102(e), and 35 U.S.C. § 103(a). The issue under 35 U.S.C. § 101 specifically turns on whether Appellants' claims are statutory under the new guidance we have received from the Supreme Court in *Bilski v. Kappos*, 130 S.Ct. 3218 (2010). The issue in the rejections under 35 U.S.C. § 102 and 35 U.S.C. § 103 revolve around teachings in the Barnett reference concerning a collaborative context and the assignment of tools to users' roles.

### FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellants have invented a system and method for assisting a community of users to achieve a common goal, such as completing a software project or managing human resources (Spec. 2, l. 2). The "context" of the collaborative group is the objective they intend to address with an environment (Spec. 2, l. 5). A hierarchical directory structure assigns tools to the users depending on the role they play in the collaboration (Spec. 10, ¶ [0021]).
2. The Barnett reference teaches computer support for a community of people sharing a common interest, such as employees or partners working on an enterprise (¶¶ [0002], [0003]). A hierarchical organizational model (¶ [0026])

is modeled in a directory structure and supports an administration tool 28 used to manage the collaboration (§ [0039]). Roles are assigned to users, which roles confer rights to access and manage the system (Fig. 10c, ¶¶ [0049], [0034]).

### PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

\*3 All of the disclosures in a reference must be evaluated for what they fairly teach one of ordinary skill in the art. “The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain.” *In re Lemelson*, 397 F.2d 1006, 1009 (CCPA 1968) (citing *In re Boe*, 355 F.2d 961, 965 (CCPA 1966)).

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citation omitted).

“[The Supreme] Court's precedents establish that the machine-ortransformation test is a useful and important clue, an investigative tool, for determining whether some claimed inventions are processes under §101. The machine-or-transformation test is not the sole test for deciding whether an invention is a patent-eligible ‘process.’” *Bilski v. Kappos*, 130 S.Ct. 3218, 3227 (2010).

Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. *See In re Warmerdam*, 33 F.3d 1354, 1361 (Fed. Cir. 1994).

“Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment.” *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004).

### ANALYSIS

The first section addresses the issue of statutory subject matter under 35 U.S.C. § 101; the second addresses the issues of anticipation and obviousness.

#### *Arguments with respect to the rejection of claims 1 to 12 under 35 U.S.C. § 101 [R1]*

The Examiner has rejected the noted claims for being non-statutory, as not producing “a useful, concrete and tangible” result, as guided by *State Street Bank & Trust v. Signature Financial Group*, 149 F.3d 1368,1373 (Fed. Cir. 1998). This test has been superseded by that of *Bilski v. Kappos* (cited above) which endorses the “Machine or Transformation” test as an important guide in determining whether an invention is statutory. The CAFC summarized the test as being satisfied “when the process ‘either [1] was tied to a particular apparatus’ or [2] operated to change materials to a ‘different state or thing.’” *In re Comiskey*, 554 F.3d 967, 978 (Fed. Cir. 2009). With regard to method claims 6 and 12, and the claims dependent on them, upon inspection we find that they are not tied to a particular machine, nor do they act to transform a

material to a different state. We find these method claims to be non-statutory. We further find that claim 1 is directed to a system comprising a set of pure data structures, such as 1) a directory with entries, 2) roles assigned to subscribers of a community, and 3) a nonspecified mapping between the roles and the directory. The claim is thus directed to a mere relationship between data elements; not even an algorithm. Thus, consistent with *Gottschalk v. Benson*<sup>[FN3]</sup>, 409 U.S. 63 (1972), we find this system claim to also be non-statutory.

 \*4 Appellants argue that claim 9 is drawn to a “machine readable storage” having stored thereon a computer program, and that this is equivalent to the “computer readable medium” which is a term common for “manufacture” (device) statutory patents issued by the Office (App. Br. 6, bottom). We agree and will not sustain the rejection under 35 U.S.C. § 101 of this claim 9 or those claims dependent thereon.

*Arguments with respect to the rejection of claims 1 and 3 to 12 under 35 U.S.C. § 102(e) [R2]*

The Examiner has rejected the noted claims for being anticipated by Barnett. Appellants argue that “[n]owhere in Barnett is a collaborative context disclosed.” (App. Br. 8, bottom) (emphasis omitted). We cannot agree with that broad assertion, especially as Barnett mentions that his disclosure relates to “administration of community-based computer services,” and “a community is a group of people who typically share a common interest” helping “employees, suppliers, partners and clients to work together.” (¶¶ [0002], [0003]).

Appellants refine the argument by asserting that screen shots of Barnett’s Figures 10A-10C “show only the mapping of ‘profiles’ to ‘roles’” and not a teaching of “restricting access to tools and resources (both plural) based upon a role - an expressly claimed limitation of claim 1.” (App. Br. 9, middle) (emphasis omitted). That is not the exact wording of claim 1, but we need not quibble. In ¶ [0032] and ¶ [0033] an assigned role (in the administrative domain or sub domain) is linked to access to the administration tool 28 and administrative privileges 32, access to which is not provided to the general population in Barnett. We find this teaching sufficient to satisfy the noted limitation of claim 1.

Appellants then state that “Obviously, the ‘delegate administration tool’ of Barnett does not provide ‘combinations of collaborative technologies in order to provide a means for members of a collaborative community to pool their strengths and experiences to achieve a common goal.’” (App. Br. 10). This Board does not recognize the Appellants’ statement to be obvious at all and does not find that the claim requires such details. Though a specification may define words in the claim, we cannot read a whole limitation into a claim when it is not recited there, as proposed by Appellants. *See Super-guide Corp. v. DirecTV Enterprises, Inc.*, cited above. Collaborative tools are not a requirement of the claim, merely a “collaborative context”, which is defined by Appellants’ Specification as an “objective.” (Spec 2, ¶ [0003]).

*Arguments with respect to the rejection of claim 2 under 35 U.S.C. § 103(a) [R3]*

\*5 The rejection of claim 2 over Barnett in view of Keats is affirmed for the reasons stated by Examiner Chen, namely the argued features are not found in the claim’s limitations.

## CONCLUSIONS OF LAW

Based on the findings of facts and analysis above, we conclude that Appellants have not shown error in the rejections R2 and R3 of the Examiner. With regard to claim 9 (and dependent claims 10 and 11), the Appellants have demonstrated error in rejection R1, under 35 U.S.C. § 101.

## DECISION

We reverse the Examiner’s rejection R1 of claims 9, 10 and 11 under 35 U.S.C. § 101. We affirm the Examiner’s rejec-

tion of claims 1 to 8 and 12 under 35 U.S.C. § 101.

We affirm the Examiner's rejections R2 and R3 of claims 1 to 12 under 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a) respectively.

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)(v).

AFFIRMED

FN1. Application filed December 22, 2003. The real party in interest is IBM Corp.

FN2. 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.

FN3. "It is conceded that one may not patent an idea. But in practical effect that would be the result if the formula for converting ... numerals to pure binary numerals were patented in this case." 409 U. S. 63, 71 (1972). A contrary holding "would wholly pre-empt the mathematical formula and in practical effect would be a patent on the algorithm itself." *Id.* at 72.

2010 WL 3441058 (Bd.Pat.App. & Interf.)

END OF DOCUMENT