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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TIMOTHY ALAN DIETZ, WALID M. KOBROSLY,
NADEEM MALIK, and AVIJIT SAHA

Appeal 2009-008029
Application 10/713,726
Technology Center 2100

Before: JOHN A. JEFFERY, DEBRA K. STEPHENS, and
JAMES R. HUGHES, *Administrative Patent Judges*.

STEPHENS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) (2002) from a final rejection of claims 1-11 and 17-25. Claims 12-16 have been canceled. (App. Br. 2). We have jurisdiction under 35 U.S.C. § 6(b) (2008).

We AFFIRM-IN-PART.

Introduction

According to Appellants, the invention is a system and method for controlling Web traffic in transmitted Web documents or pages so as to optimize Web throughput for the hosts or owners of Web sites creating and distributing hypertext Web documents. (Spec. 1).

STATEMENT OF CASE

Exemplary Claim

Claim 1 is an exemplary claim and is reproduced below:

1. In a World Wide Web (Web) communication network with user access via a plurality of data processor controlled interactive receiving display stations for displaying received hypertext Web documents, transmitted from source sites on the Web, including at least one display page containing text, images and a plurality of embedded hyperlinks, each hyperlink being user activatable to access and display a respective linked hypertext Web document from source sites on the web, a system for controlling access activity from activated hyperlinks and their respective Web document source sites comprising:

means at said source sites for prioritizing said plurality of embedded hyperlinks in a Web document; and

means for applying said prioritization in the determination of the order in which the web documents linked to activated embedded hyperlinks in said web document are to be accessed.

(5) Appellants argue the § 102(b) rejection of independent claims 1, 7, 17, and 21 based on similar arguments. (App. Br. 13-16). We select independent claim 1 as the representative claim. We will, therefore, treat claims 7, 17, and 21 and the dependent claims 2-6, 8-11, 18-20, and 22-25 in this rejection as standing or falling with representative claim 1.

See 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE 1

35 U.S.C. § 101 claims 1-6

Appellants assert claims 1-6 are not directed to non-statutory subject matter because they are “not some abstract concept but rather a tangible and conventional business organization structure for distribution over the World Wide Web.” (App. Br. 10 and 11.)

The Examiner finds that claims 1-6 may be directed to software *per se* since the ‘means ... for prioritizing’ and ‘means for applying’ are not defined in the specification as exclusively hardware. The Examiner then finds “the use of the word ‘system’ do[es] not inherently mean that the claim is directed to a machine” and absent recitation of at least one hardware element, the claim is directed to non-statutory subject matter (Ans. 3 and 16).

Issue 1: Has the Examiner erred in concluding that claims 1-6 are directed to non-statutory subject matter?

FINDINGS OF FACT (FF)

Appellants' Invention

(1) “Provision is made for the conventional embedding of hyperlinks in the pages that may be activated to access linked documents maintained in the several databases at this Web source site, step 71.” (Spec. 11, ll. 16-19 and Fig. 3, step 71).

(2) “The Web source site maintains a conventional set of served databases each including Web pages linked to the 30 embedded hyperlinks, step 75.” (Spec. 11, ll. 28-30 and Fig. 3, step 75).

ANALYSIS

Under 35 U.S.C. § 101, four categories of subject matter are eligible for patent protection: (1) processes; (2) machines; (3) manufactures; and (4) compositions of matter. Patentable subject matter must fall within one of the categories set out in 35 U.S.C. § 101 – “Those four categories define the explicit scope and reach of subject matter patentable under 35 U.S.C. § 101” (*In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007).)

Patentable subject matter must fall within one of the categories set out in 35 U.S.C. § 101 (*See In re Ferguson*, 558 F.3d 1359, 1363 (Fed. Cir. 2009); *In re Nuijten*, 500 F.3d at 1359). As directed in *Ferguson*, we analyze Appellants’ claims to determine if they fall within one of the statutory categories (*See Ferguson*, 558 F.3d at 1363, 1365).

Appellants’ “system” claim recites a World Wide Web communication network. Claim 1 also recites source sites. Interpreting “source site” broadly, but reasonably in light of the Specification and as one of ordinary skill in the art would have defined the term at the time of

invention, we conclude “source site” encompasses hardware – such as a server as shown in Fig. 2 (*See In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004); *See also*, FF1 and FF 2). A “machine is a ‘concrete thing, consisting of parts, or of certain devices and combination of devices.’ This ‘includes every mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result.” *Ferguson*, 558 F.3d at 1364 (quoting *Nuijten*, 500 F.3d at 1355). Thus, a close review of Appellants’ claims shows that they do recite physical structure – the source sites and World Wide Web communication network and such recitations serve as structural limitations. Even if we were to presume the recited “means” are software based, the system still recites that embedded hyperlinks are prioritized by the means at the source sites and the various information supplied by the source sites are used to apply the prioritization.

Thus, we conclude that claim 1 recites a machine and accordingly, that claim 1 is directed to statutory subject matter. Claims 2-6 which depend from claim 1 add limitations that lead us to conclude that each of these claims are also directed toward statutory subject matter.

ISSUE 2

35 U.S.C. § 101 claims 17-20

Appellants assert their invention is not directed to non-statutory subject matter because in claims 17-20, “[t]here is a tangible result provided” and “[t]here is clearly a practical application in the technological arts i.e. the Web page has embedded hyperlinks which the user, who receives the Web page, may interactively select to receive further Web

documents.” (App. Br. 11. *See also* Reply Br. 1 and 2.) Appellants further contend the whole HTML document is a tangible document structure that “provides the tangible result wherein this prioritization of tags determines the order in which linked documents may be interactively accessed via the World Wide Web by users from a displayed HTML document.” (Reply Br. 1 and 2.)

The Examiner states that claims 17-20 “lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. . . . As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.” (Ans. 3-4.) The Examiner further states that “[a]n HTML tag does not produce a result, even if stored on a storage medium, which this tag is not.” (*Id.*) Thus, according to the Examiner, claims 17-20 do not recite statutory subject matter.

Issue 2: Has the Examiner erred in concluding that claims 17-20 are directed to non-statutory subject matter?

ANALYSIS

Claim 17 recites:

A World Wide Web (Web) hypertext document including at least one display page containing text, images and a plurality of embedded hyperlinks, each hyperlink being user activatable to access and display a respective linked hypertext Web document from source sites on the Web further including:

a hypertext markup language tag associated with each embedded hyperlink indicating the priority of each hyperlink in the determination of the order in which the Web documents linked to the activated embedded hyperlinks in

said Web document are to be accessed.

Claim 17 recites a hypertext document. The document does not have any physical structure and thus, does not fall within the machine category of statutory subject matter. Nor does the document fall within the process or composition of matter categories. Specifically, no “act or series of acts” is recited (*See Nuijten*, 500 F.3d at 1355) and the claims do not recite a composition “of two or more substances” or “composite articles” that are the result “of chemical union, or of mechanical mixture . . . whether they be gases, fluids, powders or solids.” (*See id.* at 1357 (quoting *Diamond v. Chakrabarty*, 447 U.S. 303, 308 (1980).) Although one might argue that the claims are directed toward an article of manufacture, we conclude they are not. “Articles” of “manufacture” are “tangible articles or commodities” “result[ing] from the process of manufacture.” (*See Nuijten*, 500 F.3d at 1356 (citing *Chakrabarty*, 447 U.S. at 308); *Bayer AG v. Housey Pharms., Inc.*, 340 F.3d 1367, 1373 (Fed. Cir. 2003).)

A claim that recites no more than software, logic or a data structure (i.e., an abstract idea) – with no structural tie or functional interrelationship to an article of manufacture, machine, process or composition of matter – does not fall within any statutory category and is not patentable subject matter (*Warmerdam*, 33 F.3d at 1361; *see Nuijten*, 500 F.3d at 1357). The scope of such a claim is not limited to any particular practical application. In particular, data structures in the abstract, i.e., not claimed as embodied in a non-transitory tangible computer-readable medium are descriptive material per se and are not statutory subject matter because they are not capable of causing functional change in a computer (*In re Warmerdam*, 33 F.3d 1354,

1361 (Fed. Cir. 1994); *cf. In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994); *accord* MPEP § 2106.01 (2007)).

Claim 17 recites a hypertext document—data. Claim 17 does not recite any functionality. Claim 17 merely describes a function that the data (the hyperlink) may have – that it is user activatable. In addition, the hyperlink document is not directed to a data structure in a non-transitory tangible computer-readable medium. Therefore, we conclude since claim 17 merely recites data, claim 17 recites an abstract idea. Accordingly, claim 17 is directed toward non-statutory subject matter.

Claim 18, however, recites that the web document is at a source Web site. More than mere abstraction, data structures are specific electrical or magnetic structural elements in a memory. In *In re Lowry*, 32 F.3d 1579 (Fed. Cir. 1994), the data structures provide tangible benefits: data stored in accordance with the claimed data structures are more easily accessed, stored, and erased. The opinion further notes that, unlike prior art data structures, Lowry’s data structures simultaneously represent complex data accurately and enable powerful nested operations. In short, Lowry’s data structures were found to be physical entities that provide increased efficiency in computer operation. They are not analogous to printed matter (*id.* at 1584).

The additional recitation of the document at the source Web site moves the data into a physical structure or machine. The embedded hyperlink is user-activatable to access and display a linked hypertext Web document from source sites. Thus, the recited hypertext document is a physical entity that provides the access and display to the linked hypertext Web document from other source sites with an indicated priority. Thus,

unlike claim 17 which merely recites data (which could be on paper), this claim recites a data structure including structural elements.

Accordingly, claim 18 is directed toward statutory subject matter. Since claims 19 and 20 depend from claim 18 and add limitations that support the data structure and add functionality and structure, we conclude claims 19 and 20 are also directed toward statutory subject matter. As a result, Appellants *have not* shown the Examiner erred in concluding claim 17 is not directed toward statutory subject matter under 35 U.S.C. § 101, but *have* shown the Examiner erred in concluding claims 18-20 are not directed toward statutory subject matter under 35 U.S.C. § 101.

ISSUE 3

35 U.S.C. § 101 claims 21-25

Claim 21 recites:

A computer useable medium having a computer readable program stored thereon for controlling access activity from activated hyperlinks and their respective Web document source sites in a World Wide Web (Web) communication network with user access via a plurality of data processor controlled interactive receiving display stations for displaying received hypertext Web documents, transmitted from source sites on the Web, including at least one display page containing text, images and a plurality of embedded hyperlinks, each hyperlink being user activatable to access and display a respective linked hypertext Web document from source sites on the Web, wherein the computer readable program when executed on a computer causes the computer to:

prioritize said plurality of embedded hyperlinks in a source Web document at a source site; and

apply said prioritization in the determination of the order in which the Web documents linked to the activated embedded hyperlinks in said Web document are to be accessed.

Appellants assert that claims 21-25 are directed to statutory subject matter because the claims recite a computer usable medium on which the defined computer readable program is stored. Appellants further contend “the terminology ‘computer useable medium having a computer readable program stored thereon’ is the language which the Manual of Patent Office Examining Procedure (MPEP) finds to be acceptable in defining program products. Appellants additionally assert that “[e]ven if as Examiner contends, transmission waves are a computer usable medium, a computer program being transmitted over a network can not be considered as stored on such transmission waves” and that “it is clear from the Specification and [the] cited section that Appellants claim computer usable media with the programs stored thereon and this does not include the program in transmission.” (App. Br. 11-12 and Reply 2, emphasis original.)

The Examiner states that a computer readable medium that embodies carrier waves is not statutory under 35 U.S.C. 101. The Examiner determines that since the specification does not define “computer useable medium,” the Examiner must apply the broadest reasonable interpretation to the term. The Examiner then determines computer useable (readable) mediums generally include carrier waves. Thus, claims 21-25 are not directed toward statutory subject matter. (Ans. 17).

Issue 3: Has the Examiner erred in concluding that claims 21-25 are directed to non-statutory subject matter?

ANALYSIS

The USPTO is obliged to give claims their broadest reasonable interpretation consistent with the Specification during proceedings before the USPTO (*See In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989) (during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow)). The broadest reasonable interpretation of a claim drawn to a computer readable medium (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media and transitory propagating signals *per se* in view of the ordinary and customary meaning of computer readable media, particularly when the Specification is silent (*See* MPEP § 2111.01; U.S. Patent & Trademark Office, *Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101*, Aug. 2009, at 2, available at http://www.uspto.gov/web/offices/pac/dapp/opla/2009-08-25_interim_101_instructions.pdf (emphasis in original) (“Interim Instructions”); and David J. Kappos, Subject Matter Eligibility of Computer Readable Media, 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010) (“Kappos”).) When the broadest reasonable interpretation of a claim covers a signal *per se*, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter (*See In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and *See also* Kappos.)

We find Appellants' Specification to be broad enough to be interpreted as directed to a transitory signal. Additionally, although Appellants argue the computer readable program cannot be stored on a computer readable medium, we find this unpersuasive. The computer readable program may be

stored on the transmission wave, even if the computer readable program is only temporarily retrievable. Accordingly, the claimed invention is broad enough to be reasonably interpreted as software per se or a transitory signal with the software embodied thereon. Therefore, we conclude the invention as recited in claim 21 is not directed toward statutory subject matter. Claims 22-25 do not add limitations which would cause the claims to be directed toward statutory subject matter. Thus, Appellants have not shown the Examiner erred in concluding claims 21-25 are not directed toward statutory subject matter under 35 U.S.C. § 101.

ISSUE 4

35 U.S.C. § 102(b): claims 1-11 and 17-25

Appellants argue their invention is not anticipated by Pogrebisky because the applied reference does not teach “prioritizing said plurality of embedded hyperlinks in a source Web document at a source site” and “applying said prioritization in the determination of the order in which the Web documents linked to the activated embedded hyperlinks in said Web document are to be accessed” as commensurately recited in independent claims 1, 7, 17, and 21. (App. Br. 13-16). Specifically, Appellants contend Pogrebisky ultimately sorts the links, and sorting is different from prioritizing (App. Br. 14). In Pogrebisky, according to Appellants, the sort is by the count of the number of links to each node in the Web site; therefore, the “prioritization in Pogrebisky applies to nodes at a particular Web site” (*id.*).

In response, the Examiner maintains that The American Heritage Dictionary of the English Language, Fourth Edition, defines “prioritize” as “to put things in order of importance” and defines “sort” as “to arrange

according to class, kind, or size” (Ans. 18). Thus, according to the Examiner, a user sorting the link list in Pogrebisky is putting them in the order of importance to the user, which is prioritizing (*id.*). Thus, the Examiner finds Pogrebisky teaches “prioritizing ... hyperlinks in a source Web document” (*id.*). The Examiner notes that the claim does not recite where the hyperlinks are prioritized, or who will access the documents or if the documents will ever be accessed (Ans. 19).

Issue 4: Has the Examiner erred in finding Pogrebisky discloses the limitations of claims 1, 7, 17, and 21?

ANALYSIS

We find the Examiner has not shown that Pogrebisky discloses the invention as recited in claim 1. Specifically, the Examiner contends that Pogrebisky describes that the program applies the prioritization by automatically sorting the list according to the clicked header and that then the user/webmaster can access the links in the prioritized order (Ans. 19). Although Pogrebisky discloses a prioritized list, an ordinarily skilled artisan would view Pogrebisky’s disclosure as at most a mere suggestion of the order that the prioritized (or sorted) list in which the Web documents linked to the activated embedded hyperlinks are to be accessed. While such a suggestion might be adequate to show obviousness, it is insufficient to show anticipation. Absent a showing that Pogrebisky expressly or inherently describes “applying said prioritization in the determination of the order in which the Web documents linked to the activated embedded hyperlinks in said Web document are to be accessed,” we find that the Examiner has improperly relied upon Pogrebisky’s disclosure to describe the disputed limitation.

“[A]bsence from the reference of any claimed element negates anticipation.” (*Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986) (citation omitted), *overruled on other grounds by Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, 383 F.3d 1337 (Fed. Cir. 2004)). We therefore cannot sustain the § 102 rejection of claim 1, and commensurately recited claims 7, 17, and 21, nor that of claims 2-6, 8-11, 18-20, and 22-25, which depend from claim 1, 7, 17, and 21, respectively.

DECISION

The Examiner’s rejection of claims 1-6 under 35 U.S.C. § 101 as being directed to non-statutory matter is reversed.

The Examiner’s rejection of claim 17 under 35 U.S.C. § 101 as being directed to non-statutory matter is affirmed.

The Examiner’s rejection of claims 18-20 under 35 U.S.C. § 101 as being directed to non-statutory matter is reversed.

The Examiner’s rejection of claims 21-25 under 35 U.S.C. § 101 as being directed to non-statutory matter is affirmed.

The Examiner’s rejection of claims 1-11 and 17-25 under 35 U.S.C. § 102(b) as being anticipated by Pogrebisky is reversed.

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) (2009).

AFFIRMED-IN-PART

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