UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte BO LI

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Appeal 2008-1213
Application 10/463,287[1]
Technology Center 2100

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Decided: November 6, 2008

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Before: JAY P. LUCAS, ST. JOHN COURTENAY III,
and CAROLY D. THOMAS, *Administrative Patent Judges*.

LUCAS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellant appeals from a final rejection of claims 22 to 42 under authority of 35 U.S.C. § 134. The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b). Claims 1 to 21 are canceled.

Appellant's invention relates to a method and system for generating a report using software modules adapted for easy modification and updating (Spec, p. 1, bottom). In the words of the Appellant:

> Custom business reports for a WEB application are generated by parsing a configuration file, processing data logic, and organizing data. The result of the parsed configuration file is further processed by the data logic processing. The data logic processing prepares the data to generated languages suitable for a data query from a database or for locating files. The data is then organized into a form suitable for display.
> (Spec, p. 28)

Claim 32 and Claim 42 are exemplary:

32. A method for generating a report, said method comprising:
providing a system, wherein the system comprise distinct software modules embodied on a computer-readable medium, and wherein the distinct software modules comprise a logic processing module, a configuration fill processing module, a data organization module, and a data display organization module;

parsing a configuration file into definition data that specifies: a data organization of the report, a display organization of the report, and at lest one data source comprising report data to be used for generating the report, and wherein said parsing is performed by the configuration file processing module in response to being called by the logic processing module;

extracting the report data from the at least one data source, wherein said extracting is performed by the data organization module in response to being called by the logic processing module;

receiving, by the logic processing module, the definition data from the configuration file processing module and the extracted report data from the data organization module;

organizing, by the data display organization module in response to being called by the logic processing module, a data display organization of the report, wherein said organizing comprises utilizing the definition data received by the logic processing module and the extracted report data received by the logic processing module; and

storing the data display organization of the report in a database.

42. A computer program product, comprising a computer usable medium having a computer readable program code embodied therein, said computer readable program code adapted to be executed to implement a method for generating a report, said method comprising:

providing a system, wherein the system comprises distinct software modules, and wherein the distinct software modules comprise a logic processing module, a configuration file processing module, a data organization module, and a data display organization module;

parsing a configuration file into definition data that specifies: a data organization of the report, a display organization of the report, and at least one data source comprising report data to be used for generating the report, and wherein said parsing is performed by the configuration file processing module in response to being called by the logic processing module;

extracting the report data from the at least one data source, wherein said extracting is performed by the data organization module in response to being called by the logic processing module;

receiving, by the logic processing module, the definition data from the configuration file processing module and the extracted report data from the data organization module; and

organizing, by the data display organization module in respone to being called by the logic processing module, a data display organization of the report, wherein said organizing comprises utilizing the definition data received by the logic processing module and the extracted report data received by the logic processing module.

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

Shaughnessy   US 7,015,911 B2   Mar. 21, 2006

REJECTIONS

R1:   Claim 42 stands rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter.

R2:   22 to 42 stand rejected under 35 U.S.C. 103(a) for being obvious over Shaughnessy.

Groups of Claims:

Claims will be discussed in the order of the rejections and arguments. See 37 CFR § 1.41.37(c)(vii). See *also In re McDaniel*, 293 F.3d 1379, 1383 (Fed. Cir. 2002) ("If the brief fails to meet either requirement [of 37 CFR § 1.192(c)(7)], the Board is free to select a single claim from each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim.").

Appellant contends that claim 42 is statutory, for relating to a physical device. Appellant further contends that the claimed subject matter is not rendered obvious by Shaughnessy for failure of Shaughnessy to teach all of the claimed limitations. The Examiner contends that each of the claims is properly rejected.

Rather than repeat the arguments of Appellant or the Examiner, we
make reference to the Briefs and the Answer for their respective details.
Only those arguments actually made by Appellant have been considered in
this opinion. Arguments which Appellant could have made but chose not to
make in the Briefs have not been considered and are deemed to be waived.

We affirm.

ISSUE

The issue is whether Appellant has shown that the Examiner erred in
rejecting the claims under 35 U.S.C. §§ 101 and 103(a). The first issue turns
on whether the outputting of a report is necessary to render claim 42
statutory. The second issue turns on whether Shaughnessy supports a
conclusion that all of the claimed limitations are obvious over the prior art.

FINDINGS OF FACT

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

1. Appellant has invented a system and method for generating reports in a
    Web based system which can be easily updated. (Spec., p. 1, middle).
    Appellant uses a set of software modules to first parse an XML definition
    file to define from where the data shall be collected and how it shall be
    reported. (¶ 18, 19). The method/system, called ReportGate (*Id.*) permits
    program modules to act within its framework to accept data from
    databases and organize it into tables suitable for reports. (¶ 20 – 28).
    Final reports are based on the XML configuration files. (¶ 35).

2. Shaughnessy teaches a system and method for generating reports in a
   Web environment. (Col. 2, l. 55). A report specification 36 directs
   processing modules in a report rendering engine 38 to compile data from
   various data sources (34) and to update the report when the data changes.
   (Col. 2, l. 14). (Fig. 1). The report specification contains a data structure
   from which various sub specifications are extracted, and which specify
   where the data is to be found, how it is to be visually represented, which
   report templates are to be used and in what format the report is to be
   rendered.

PRINCIPLES OF LAW

Appellant has 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)).

"It is common sense that familiar items may have obvious uses
beyond their primary purposes, and a person of ordinary skill often will be
able to fit the teachings of multiple patents together like pieces of a puzzle."
KSR Int'l Co. v. Teleflex, Inc., 127 S. Ct. 1727, 1732 (2007).

The analysis begins with an interpretation of the claims: "[b]oth
anticipation under § 102 and obviousness under § 103 are two-step inquiries.
The first step in both analyses is a proper construction of the claims . . . .

The second step in the analyses requires a comparison of the properly construed claim to the prior art." *Medichem S.A. v. Rolabo S.L.*, 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted).

Our reviewing court states in *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989) that "claims must be interpreted as broadly as their terms reasonably allow." Our reviewing court further states that "the words of a claim 'are generally given their ordinary and customary meaning.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted). The "ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." Id. at 1313.

Laws of nature, physical phenomena and abstract ideas are excluded from patent protection. *Diamond v. Diehr*, 450 U.S. 175, 185 (1981).

The test for statutory subject matter is whether the claimed subject matter is directed to a "practical application," i.e., whether it is applied to produce "a useful, concrete and tangible result." *See State St. Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373 (Fed. Cir. 1998).

"Therefore we also conclude that the "useful, concrete and tangible result" inquiry is inadequate and reaffirm that the machine-or-transformation test outlines by the Supreme Court is the proper test to apply." [Footnote: "As a result, those portions of our opinions in State Street and AT&T relying solely on a "useful, concrete and tangible result" analysis should no longer be relied on." *In re Bilski,* Case 2007-1130, page 20, (Fed. Cir, Oct 30, 2008).

ANALYSIS

From our review of the administrative record, we find that the Examiner has presented a prima facie case for the rejections of Appellant's claims under 35 U.S.C. §§ 101 and 103. The prima facie case is presented on pages 3 to 8 of the Examiner's Answer. In opposition, Appellant presents a number of arguments.

*Arguments with respect to the rejection
of claim 42
under 35 U.S.C. § 101*

The first argument addresses the issue of whether the method of claim 42 comprises statutory subject matter under 35 U.S.C. § 101. The Examiner explains the rejection as, "[t]he final step of the claim, 'organizing', does not output a report; it merely prepares it for output. Thus, the invention claimed by claim 42 does not produce a tangible result." (Ans., p. 9, middle).

Appellant argues that the parsing step, as well as the extracting step, produce a tangible result, and thus the claim should be considered statutory. (Br., p. 7).

We believe the Examiner has erred in rejecting this claim. The Examiner's argument centers on the test for being statutory by producing "a useful, concrete and tangible result" as indicated in *State St. Bank & Trust Co. v. Signature Fin. Group, Inc.* (See citation above). In accordance with *In re Bilski* (cited above) the arguments of *State Street* will no longer be considered dispositive of this issue. (See the comments on *State Street* in the Legal Principles section above.)

In the analysis of *In re Nuijten,* 500 F.3d 1346 (Fed. Cir., 2007), the Federal Circuit considers the four statutory classes for a signal, and bases the determination of statutory subject matter on that basis. It has been the practice for a number of years that a "Beauregard Claim" of this nature be considered statutory at the USPTO as a product claim. (MPEP 2105.01, I). Though not finally adjudicated, this practice is not inconsistent with *In re Nuijten.* (*Ibid.*). Further, the instant claim presents a number of software components, such as the claimed logic processing module, configuration file processing module, data organization module, and data display organization module, that are embodied upon a computer readable medium. This combination has been found statutory under the teachings of *In re Lowry,* 32 F.3d 1579 (Fed. Cir., 1994). In view of the totality of these precedents, we decline to support the rejection under 35 U.S.C. § 101.

Arguments with respect to the rejection
of claims 22 to 42
under 35 U.S.C. § 103

Appellant contends that the Examiner erred in rejecting claims 22 to 42 for being obvious over Shaughnessy for a number of reasons.

Appellant first argues that Shaughnessy fails to teach or suggest "the claimed logical interrelationships that connect the claimed software modules with one another." (Br. 9, middle). The logical relationships are explained to be the parsing, the extracting, and the organizing of the data according to a definition, each by a certain one of the processing modules. The Examiner argues that the method of breaking down the program into modules would

be a concept well known to one of ordinary skill in the art. For the reasons expressed by the Examiner, (Ans., p. 10, bottom) we decline to see error in the rejection on this point. Shaughnessy's processing modules perform the equivalents of parsing the report specification and data structure to sub-specifications (col. 2, l. 48), extracting data report data from information sources (col. 2, l. 55; col. 4, l. 3), and organizing the data according to templates (col. 3, top). We agree with the Examiner that it would be obvious to assign out the processing to modules as claimed.

Appellant contends that Shaughnessy does not teach or suggest the parsing of the configuration file as claimed. (Br., p. 10, bottom). As discussed above, we do not find error in the Examiner's rejection. The Examiner's Answer discusses the actual use of the word "parsing" as commonly understood. (Ans., p. 11, bottom). We find the common meaning of the word, absent any special and express definition in the Specification, to be suggested by Shaughnessy. (See *Phillips v. AWH Corp.*, cited above).

Appellant contends that Shaughnessy does not teach that the parsing being "performed by the configuration file processing module in response to being called by the logic processing module…". (Br., p. 13, middle). In view of the logic expressed above, we do not find it erroneous for the Examiner to maintain the rejection over Shaughnessy. In the paragraph starting in column 2, line 48, and following, the reference teaches processing to generate the extraction (read on parsing) from the data structure of the same elements of data as claimed – the specifications of which data to accumulate, how to organize the data, which templates to use to display the

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data in a report. The naming of a module by certain nomenclature, for example "configuration file processing module", does not render the module structurally or functionally unobvious. We decline to find error in the Examiner's rejection.

For the same reasons, we decline to find error in the Examiner's reading of the extraction of report data performed by a data organization module. (Br., p. 14, middle). The reference performs the same function in the same manner as claimed. (Col. 3, line 63).

Appellant argues that the retrieval of "external data" from external sources by Shaughnessy cannot be read on the claimed retrieval of program code. (Br., p. 21, middle). We decline to find error in view of the Examiner's pointing out that the retrieved data in Shaughnessy is in the form of stored procedures, i.e., program code. (Ans., p. 15, middle).

Other arguments concerning the execution parameters of an SQL statement (Br., p. 26, top) and nested tables (Br., p. 27) are considered appropriately answered by the Examiner's Answer.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner erred in rejecting claim 42 under 35 U.S.C. § 101. However, we further conclude that the Examiner did not err in rejecting claims 22 to 42 under 35 U.S.C. § 103.

DECISION

The Examiner's rejection of claim 42 under 35 U.S.C. § 101 for being non-statutory is reversed. The Examiner's rejection of claims 22 to 42 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. §1.136(a). <u>See</u> 37 C.F.R. § 1.136(a)(1)(iv).

<u>AFFIRMED</u>

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