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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANK J. CASTANEDA and DAVID L. ZANTER

Appeal 2009-013594
Application 11/392,137[1]
Technology Center 2100

Before MAHSHID D. SAADAT, MICHAEL R. ZECHER, and BRUCE R. WINSOR, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

DECISION ON APPEAL

[1] Filed on March 29, 2006. The real party in interest is International Business Machines Corp. App. Br. 1.

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) (2002) from the Examiner's rejection of claims 1-20. App. Br. 2. We have jurisdiction under 35 U.S.C. § 6(b) (2008).

We affirm.

Appellants' Invention

Appellants invented a method, system, and computer program product directed to date-related event management and, in particular, to the recurrences of date driven values. *See* Spec. ¶¶ [0001], [0006].

Illustrative Claim

> 1. A date driven date selective retrieval method for recurrences in date driven data, the method comprising:
>
> defining a date range;
>
> retrieving exactly three cached instances for each of the recurrences in the date driven data;
>
> selecting only those recurrences that fall within the date range according to the three cached instances for each of the recurrences; and,
>
> adding the selected recurrences to a subset of the date driven values, and otherwise excluding remaining ones of the recurrences from the subset.

Prior Art Relied Upon

Kasso	US 5,893,073	Apr. 6, 1999
Boothby	US 5,943,676	Aug. 24, 1999
Bocking	US 2006/0095859 A1	May 4, 2006 (filed Nov. 3, 2004)

BLACK'S LAW DICTIONARY (8th ed. 2004) (The term "therefor" is defined as "*adv*. For it or them; for that thing or action: for those thing or actions <she lied to Congress but was never punished therefor>.").

Rejections on Appeal

Claims 13-20 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Ans. 4-5.[2]

Claims 1-7, 9-11, and 13-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Bocking and Kasso.[3] *Id* at 5-20.

Claims 8, 12, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Bocking, Kasso, and Boothby. *Id* at 21-23.

Appellants' Contentions

1. Appellants contend that since the present Specification identifies several examples of a computer-usable or computer-readable medium that fall within the scope of § 101 (i.e., semiconductor or solid state memory, magnetic tape, a removable computer diskette, a random access memory ("RAM"), a read-only memory ("ROM"), a rigid magnetic disk,

[2] All references to the Answer are to the Answer mailed on April 3, 2009, which replaced the Answer mailed on March 3, 2009.

[3] In the statement of the rejection, the Examiner states that claims 1-7, 9-11, and 13-19 "may have been admitted by applicants" to be rejected under 35 U.S.C. § 102(e) as being anticipated by Bocking. Ans. 5-6. However, in the body of the rejection, the Examiner only provides support for rejecting claims 1-7, 9-11, and 13-19 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Bocking and Kasso. *Id* at 6-20. We therefore presume that claims 1-7, 9-11, and 13-19 only stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Bocking and Kasso.

and an optical disk), independent claims 13 is directed to statutory subject matter under § 101. App. Br. 5; Reply Br. 3-4.

2. Appellants contend that the Examiner fails to provide any claim construction with respect to the claimed terms "recurrences" and "cached instances," and fails to identify how Bocking or Kasso teach or suggest such claim limitations. App. Br. 13, 17; Reply Br. 8-13, 20-21. Moreover, Appellants argue that Bocking's disclosure of caching existing entries does not teach or suggest "retrieving [*exactly three cached*] instances for each of the recurrences in the date driven data," as recited in independent claim 1. App. Br. 13 (emphasis in original); Reply Br. 14-16, 21-22. Appellants also allege that Bocking's disclosure of both periodically recurring appointments/meetings and caching existing calendar entries does not teach or suggest "selecting only those recurrences that fall within the date [sic] range according to the [*three*] cached instances of each of the recurrences," as claimed. App. Br. 14, 20 (emphasis in original); Reply Br. 14-16. Finally, Appellants contend that the Examiner fails to provide a sufficient rationale for combining Bocking and Kasso. App. Br. 15, 21; Reply Br. 7-8, 17-18.

Examiner's Findings and Conclusions

1. The Examiner finds that the "…computer useable medium embodying computer usable program code…" recited in independent claim 13 encompasses non-statutory subject matter, such as propagation mediums (e.g., electronic, electromagnetic, and infrared signals). Ans. 25 and 27. Therefore, since the claimed "computer useable medium" encompasses carrier waves, the Examiner finds that the independent claim 13 is directed to non-statutory subject matter under § 101. *Id* at 25-26.

2. The Examiner finds that the claim terms "recurrences" and "cached instances" are notoriously well known to an ordinarily skilled artisan. *Id* at 33-34. In particular, the Examiner finds that since a reference need not teach or suggest what is notoriously well known to an ordinarily skilled artisan, the Examiner properly treated the claim term "recurrences" when rendering independent claim 1 obvious. *Id* at 34, 42. Moreover, given the prosecution history of the present application (i.e., Appellants state that "[b]oth a data store and a cache are devices (i.e., storage) in which data is stored"), the Examiner finds that an ordinarily skilled artisan would have understood that the claimed "cached instance" is an instance of anything stored in a cache. *Id* at 35-36.

In light of this claim construction, the Examiner finds that Bocking's disclosure of caching instances in a date range, in conjunction with Kasso's disclosure of a board meeting that takes place exactly three days every other week, teaches or suggests "exactly three cached instances," as recited in independent claim 1. *Id* at 37-38, 45. Moreover, the Examiner finds that Bocking's disclosure of a cache that provides repeated access to calendar data teaches or suggests both the claimed steps of "retrieving" and "selecting." *Id* at 43-44. Finally, the Examiner finds that there is a sufficient rationale to combine Bocking and Kasso. *Id* at 32-33, 39-40.

II. ISSUES

1. Did the Examiner err in finding that independent claim 13 is directed to non-statutory subject matter? In particular, the issue turns on whether the claimed "…computer useable medium embodying computer usable program code…" encompasses a transitory, propagating signal.

2. Did the Examiner err in concluding that the combination of Bocking and Kasso renders independent claim 1 unpatentable? In particular, the issue turns on whether:

(a) the proffered combination teaches or suggests "retrieving exactly three cached instances for each of the recurrences in the date driven data," as recited in independent claim 1; and

(b) the proffered combination teaches or suggests "selecting only those recurrences that fall within the date range according to the three cached instances for each of the recurrences," as recited in independent claim 1; and

(c) the Examiner provides a sufficient rationale for the proffered combination.

III. FINDINGS OF FACT ("FF")

Appellants' Specification

FF 1. Appellants' Specification states that:

> a computer-useable or computer readable medium can be any apparatus that can contain, store, communication, propagate, or transport the program for use by or in connection with the instruction execution system, apparatus, or device. The medium can be an electronic, magnetic, optical, electromagnetic, infrared, or semiconductor system (or apparatus or device) or a propagation medium.

Spec. ¶ [0024].

Bocking

FF 2. Bocking discloses a calendar application for managing appointments and meetings that automatically checks for and notifies a user of scheduling conflicts with new appointments or meetings. In particular,

Bocking discloses an associated calendar cache that includes a first subset of existing calendar entries falling within a first date range. Further, Bocking discloses creating a new calendar cache that includes a second subset of existing calendar entries falling within a second date range, and covers a predetermined time period (e.g., preferably before and after the date of the new calendar entry). ¶¶ [0009]-[0010].

FF 3. Bocking discloses that the new calendar entry may be one of a series of recurring appointments or meetings. For example, Bocking discloses that a user may have a weekly staff meeting he or she wishes to enter into the calendar application. ¶¶ [0012], [0034].

Kasso

FF 4. Kasso discloses entering the time and date into text boxes for the first occurrence of each recurring event. For purposes of explanation, Kasso disclose that the event at issue may be a board meeting that takes place at 9:00 am on Mondays, Wednesdays, and Fridays every other week. Col. 13, ll. 25-30.

FF 5. According to Kasso, once a user enters information about events, the user may wish to view a calendar that illustrates when the scheduled events will occur. Col. 14, ll. 57-59.

IV. ANALYSIS

35 U.S.C. § 101 Rejection

Claim 13

We do not find error in the Examiner's decision to reject independent claim 13 as being directed to non-statutory subject matter. In particular,

independent claim 13 recites, *inter alia*, "…a computer useable medium embodying computer usable program code…."

Upon reviewing Appellants' Specification for context, a computer-useable medium may include propagation mediums, such as electronic, magnetic, optical, electromagnetic, or infrared signals. FF 1. Consequently, we find that the claimed "…computer useable medium embodying computer usable program code…" can be broadly, but reasonably construed to encompass a transitory, propagating signal, which is non-statutory subject matter. Further, since the claim is not limited to a non-transitory, tangible medium within one of the four statutory classes of 35 U.S.C. § 101,[4] we agree with the Examiner that independent claim 13 is directed to non-statutory subject matter. Ans. 25-26. It follows that the Examiner has not erred in rejecting independent claim 13 as being directed to non-statutory subject matter.

[4] "A transitory, propagating signal . . . is not a 'process, machine, manufacture, or composition of matter' [under 35 U.S.C. § 101]" and, therefore, does not constitute patentable subject matter under § 101. *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007). Claims that are so broad that they read on nonstatutory as well as statutory subject matter are unpatentable. *Cf. In re Lintner*, 458 F.2d 1013, 1015 (CCPA 1972) (citation omitted) ("Claims which are broad enough to read on obvious subject matter are unpatentable even though they also read on nonobvious subject matter."). "A claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation 'non-transitory' to the claim." David J. Kappos, Subject Matter Eligibility of Computer Readable Media, 1351 OFF. GAZ. PAT. OFFICE 212 (Feb. 23, 2010).

Claims 14-20

For the same reasons set forth *supra*, we find that dependent claims 14-20 are also directed to non-statutory subject matter.

35 U.S.C. § 103(a) Rejection—Combination of Bocking and Kasso

Claim 1

We do not find error in the Examiner's obviousness rejection of independent claim 1. In particular, independent claim 1 recites, *inter alia*, 1) "retrieving exactly three cached instances for each of the recurrences in the date driven data;" and 2) "selecting only those recurrences that fall within the date range according to the three cached instances for each of the recurrences."

At the outset, we note that "[t]here has never been a requirement for an [E]xaminer to make an on-the-record claim construction of every term in every rejected claim and to explain every possible difference between the prior art and the claimed invention in order to make out a *prima facie* rejection." *In re Jung*, 637 F. 3d 1356, 1363 (Fed. Cir. 2011) (emphasis added). Nonetheless, we begin our analysis by considering the scope and meaning of the claim terms "recurrences" and "cached instances," which must be given their broadest reasonable interpretation consistent with Appellants' disclosure. As explained in *In re Morris*, 127 F.3d 1048 (Fed. Cir. 1997):

> [T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification.

Id. at 1054. *See also In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989) (stating that during examination "claims must be interpreted as broadly as their terms reasonably allow").

Appellants' Specification states that "[t]he user interface permits one to define the first instance of the repeating series and to specify how the series repeats. The definition of a repeating series often is referred to as a 'recurrence rule'." Spec. ¶ [0003]. Further, Appellants' Specification states that "cache memories…provide temporary storage of at least some program code in order to reduce the number of times code must be retrieved from bulk storage during execution." *Id* at ¶ [0025].

Upon reviewing Appellants' Specification for context, we find that the claim term "recurrences" and "cached instances" may be broadly, but reasonably construed as follows: 1) "recurrences" are a series of repeating or recurring instances (e.g., events); 2) "cached instances" are instances of memory (e.g., events) that are temporarily stored in a cache.

Consistent with our claim construction *supra*, we find that Bocking's disclosure of a calendar cache that temporarily stores a series of recurring appointments and meetings falling within a predetermined date range (e.g., week) (FFs 2 and 3), in conjunction with Kasso's disclosure of a recurring board meeting that takes place on exactly three days every other week (FF 4), teaches or suggests the claimed "exactly three cached instances" of date driven data. Further, we find that an ordinarily skilled artisan would have readily appreciated retrieving exactly three instances of Kasso's recurring board meetings (FF4) from Bocking's calendar cache (FF 2), and only selecting the recurring board meetings that fall within a defined date range (i.e., a week). FFs 2 and 3. Thus, we find that the combination of Bocking

and Kasso teaches or suggests the steps of "retrieving exactly three cached instances for each of the recurrences in the date driven data," and "selecting only those recurrences that fall within the date range according to the three cached instances for each of the recurrences," as recited in independent claim 1.

Rationale to Combine

We are not persuaded by Appellants' argument that there is insufficient rationale to combine Bocking and Kasso. App. Br. 15, 21; Reply Br. 7-8, 17-18. The U.S. Supreme Court has held that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007). The Court further instructs that:

> [o]ften it will be necessary for a court to look to interrelated teachings of multiple patents; . . . and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in a the fashion claimed by the patent at issue.

Id. at 418. Additionally, the Court instructs that:

> "[[r]]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness"… however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

Id. (citation omitted).

Upon reviewing the record before us, we find that the Examiner's suggestion for the proposed modification in the prior art suffices as an articulated reason with some rational underpinning to establish a *prima facie* case of obviousness. *See* Ans. 7. In summary, we find that an ordinarily skilled artisan at the time of the claimed invention would have combined Bocking's disclosure of a calendar cache that temporarily stores a series of recurring appointments and meetings falling within a date range (e.g., week) (FFs 2 and 3), with Kasso's disclosure of a recurring board meeting that takes place on exactly three days every other week. FF 4. This proffered combination would predictably result in allowing a user who enters information about events to view a calendar that illustrates when such events will occur. FF 5.

Further, as prescribed by the controlling case law, while it is often necessary for an Examiner to identify a reason for combining the familiar elements obtained from the prior art in establishing a *prima facie* case of obviousness, the identification of such a reason is not a *sine qua non* requirement. *See KSR*, 550 U.S. at 418-19. So long as the Examiner provides an articulated reasoning with some kind of a rational underpinning to substantiate the obviousness rejection, such a conclusion is proper. *See id*. at 418. In this case, the Examiner provided more than just a mere conclusory statement. The Examiner states that it would have been obvious to an ordinarily skilled artisan at the time of the claimed invention "to modify the teaching of Bocking to include the selection of Monday, Wednesday, Friday of Kasso for exactly three cached instances because a user may wish to view a calendar that illustrates when the scheduled events will occur (Kasso, column 14, lines 57-58)." Ans. 7 (emphasis omitted). In

our view, such a statement suffices as an articulated reason with some rational underpinning to support the proffered combination. It follows that the Examiner has not erred in concluding that the combination of Bocking and Kasso renders independent claim 1 unpatentable.

Claims 2-7, 9-11, and 13-19

Appellants do not provide separate and distinct arguments for patentability with respect to independent claims 9 and 13, and dependent claims 2-7, 10, 11, and 14-19. *See* App. Br. 9-21; Reply Br. 6-25. Consequently, we accept Appellants' grouping of independent claims 9 and 13, and dependent claims 2-7, 10, 11, and 14-19, with independent claim 1. App. Br. 9. Therefore, independent claims 9 and 13, and dependent claims 2-7, 10, 11, and 14-19, fall with independent claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii).

35 U.S.C. § 103(a) Rejection—Combination of Bocking, Fasso, and Boothby

Claims 8, 12, and 20

Appellants do not provide separate and distinct arguments for patentability with respect to dependent claims 8, 12, and 20. *See* App. Br. 21-22; Reply Br. 6-25. Consequently, we accept Appellants' grouping of dependent claims 8, 12, and 20 with independent claim 1. App. Br. 21. Therefore, dependent claims 8, 12, and 20 fall with independent claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii).

V. CONCLUSIONS OF LAW

1. The Examiner has not erred in rejecting claims 13-20 as being directed to non-statutory subject matter under 35 U.S.C. § 101.

2. The Examiner has not erred in rejecting claims 1-20 as being unpatentable under 35 U.S.C. § 103(a).

VI. DECISION

1. We affirm the Examiner's decision to reject claims 13-20 as being directed to non-statutory subject matter under 35 U.S.C. § 101.

2. We affirm the Examiner's decision to reject claims 1-20 as being unpatentable under 35 U.S.C. § 103(a).

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).

AFFIRMED

ELD