

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte THOMAS L. DISTEFANO III

Appeal 2011-001447
Application 10/868,312
Technology Center 2100

Before CARL W. WHITEHEAD JR., ERIC S. FRAHM, and
ANDREW J. DILLON, *Administrative Patent Judges*.

DILLON, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellant filed a Request for Rehearing under 37 C.F.R. § 41.52 and from our Decision on Remand mailed July 16, 2014. We maintain the Decision on Remand.

STATEMENT OF THE CASE

In a Decision on Appeal mailed May 30, 2013, we sustained the Examiner's rejections of: claims 22 and 23 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,930,777 to Barber; and claims 24–28 under § 102(b) as anticipated by U.S. Patent No. 6,026,433 to D'Arlach.

Appeal 2011-001447
Application 10/868,312

On July 30, 2013, Appellant filed a Request for Rehearing (herein “First Rehearing Request”) arguing *inter alia* that the Decision on Appeal presented a new ground of rejection for claim 24.

In a Decision on Request for Rehearing mailed August 20, 2013 (herein “First Rehearing Decision”), we denied Appellant’s First Rehearing Request.

On October 18, 2013, Appellant filed a Petition for Review of the First Rehearing Decision before the United States Court of Appeals for the Federal Circuit. On March 14, 2014, Appellant filed a corresponding Opening Brief (herein “CAFC Brief”) to address claim 24.¹

On June 4, 2014, the Court issued an Order remanding the First Rehearing Decision and requiring us to enter a new ground of rejection for claim 24.

On July 16, 2014, we entered a Decision on Remand (herein “Remand Decision”) vacating and replacing the prior Decision on Appeal and First Rehearing Decision. In the Remand Decision, we affirmed the Examiner’s decision rejecting claims 22 and 23 as anticipated by Barber, reversed the Examiner’s decision rejecting claims 24–28 as anticipated by D’Arlach, and pursuant to 37 C.F.R. § 41.50(b) entered a new ground of rejection for claims 24–26 under 35 U.S.C. § 102(b) as anticipated by D’Arlach.²

¹ The CAFC Brief states that the First Rehearing Decision’s “affirmance of the rejection of claims 22 and 23 is not the subject of the present appeal before this Court.” CAFC Br. 6. However, the CAFC Brief addresses only claim 24 and, thus, not claims 22, 23, and 25–28.

² The “Decision” section of the Remand Decision incorrectly states that claim 24 is newly rejected under 35 U.S.C. § 103(a) as unpatentable over D’Arlach. Remand Dec’n 19. As stated in the “New Grounds of Rejection

Appeal 2011-001447
Application 10/868,312

The Remand Decision repeats the findings and holdings of the Decision on Appeal and First Rehearing Decision, but also presents two changes. First, as noted above, the Remand Decision reversed the Examiner's decision rejecting claims 24–28 and entered the new ground of rejection for claims 24–26. Second, the Remand Decision further explained our prior findings that:

- (i) Claim 24's "web assets" cannot, pursuant to the printed matter doctrine, patentably distinguish the claimed method over the prior art. Remand Dec'n 8–14.
- (ii) Claim 25's "search request" has a broadest reasonable interpretation that encompasses (*i.e.*, broad enough to read on) a user-selective retrieving of data. *Id.* at 15–18.

On September 16, 2014, in response to the Remand Decision, Appellant filed the present Request for Rehearing (herein "Second Rehearing Request"). According to Appellant, we err as follows with respect to claim 24:

- (a) Appellant contends that the printed matter doctrine does not apply to data. Second Reh'g Req. 3–7.
- (b) Appellant contends that claim 24's web assets are functionally related to the claimed method. *Id.* at 7–9.

for Claim 24" section, claim 24 is rather newly rejected under § 102(b) as anticipated by D'Arlach. *Id.* at 8. The "Decision" section of the Remand Decision also incorrectly states that the Examiner's decision rejecting claims 25 and 26 is affirmed. Remand Dec'n 19. Because claims 25 and 26 depend from claim 24, we should have stated, and herein clarify, that claims 25 and 26 are newly rejected under 35 U.S.C. § 102(b) as anticipated by D'Arlach; that is, newly rejected in light of the new grounds for base claim 24.

Appeal 2011-001447
Application 10/868,312

According to Appellant, we err as follows with respect to claim 25:

- (c) Appellant contends that claim 25's search request requires a corresponding search condition, keyword, or criterion. *Id.* at 10–13.

The above contentions (a), (b), and (c) represent the general issues presently before us.³

CLAIM 24

Reproduced Claim

Claim 24 is reproduced below with emphasis on the web assets.⁴

24. A method of designing, by a user in a user interface having first and second display regions each capable of displaying a plurality of element, an electronic document, comprising:

³ Appellant states that the Second Rehearing Request arguments are “comparable” to the CAFC Brief arguments. Second Reh’g Req. 2. Appellant also, nonetheless, attempts to incorporate some CAFC Brief arguments into the Second Rehearing Request. *See, e.g., id.* at 3, fn. 1 (seeking to incorporate CAFC Brief arguments by reference); *id.* at 4 (implying we must address the CAFC Brief arguments). We address herein only the arguments submitted — not merely referenced — by the Second Rehearing Request. *Accord* 37 C.F.R. § 42.6(a)(3) (“Arguments must not be incorporated by reference from one document into another document.”). In other words, we have read the CAFC brief, but will not evaluate those arguments for reversible error.

⁴ Throughout this appeal and herein, we use: “web assets” to reference the emphasized language of reproduced claim 24 (*i.e.*, the database’s web asset content); and “web assets’ origins” to reference the emphasized language’s “authored by third party authors” and “provided to the user interface from outside the user interface by the user.”

Appeal 2011-001447
Application 10/868,312

selecting a first element from a database including *web assets authored by third party authors and web assets provided to the user interface from outside the user interface by the user*;

displaying the first element in the second display region;

interactively displaying the electronic document in the first display region;

modifying the first element displayed in the second display region upon receiving a first command to modify the first element in the second display region; and

displaying the modified first element in the first display region, wherein the modified first element forms at least part of the electronic document.

In re Lowry

As to claim 24, Appellant presents several arguments focusing on *In re Lowry*, 32 F.3d 1579, 1583 (Fed. Cir. 1994). We therefore first address *Lowry*.

Lowry confirms that “merely underlying data in a database” is analogous to printed matter and thus subject to the printed matter doctrine. *See* 32 F.3d at 1583. In addition, *Lowry* explains why the at-issue data structures — the “ADOs” — are not analogous to printed matter. *Id.* at 1583–84. And, *Lowry* explains why, even assuming *arguendo* the ADOs are analogous to printed matter, they are not functionally related to the claimed invention. *Id.* at 1584.

Lowry’s analysis begins by summarizing the claimed invention’s description of the ADOs, stating:

According to the claimed invention, ADOs have both hierarchical and non-hierarchical interrelationships. A few specific rules govern these relationships. Because the claimed

Appeal 2011-001447
Application 10/868,312

invention uses single ADOs governed by simple organizational rules, Lowry asserts that it may flexibly and accurately represent complex objects and relationships.

Id. at 1581. *Lowry* then describes how “[t]he hierarchical relationships form a conceptual pyramidal structure” by which multiple ADOs nest within another (multiple within one) and thereby “fan out” from an apex ADO. *Id.* And, *Lowry* describes how the non-hierarchical relationships are “essentially ‘pointing’ relationships between ADOs.” *Id.*

In light of the above, *Lowry* found the ADOs are not analogous to printed matter. In doing so, *Lowry* emphasized the ADOs relation to application and memory functions of the claimed invention, stating:

Nor are the data structures analogous to printed matter. Lowry’s ADOs do not represent merely underlying data in a database. ADOs contain both information used by application programs and information regarding their physical interrelationships within a memory. Lowry’s claims dictate how application programs manage information. Thus, Lowry’s claims define functional characteristics of the memory.

Id. at 1583. *Lowry* concluded the printed matter analysis by again emphasizing the ADOs functional relationship to the claimed invention, stating:

[T]he Board erred in its reliance on [*In re Gulack*, 703 F.2d 1381 (Fed. Cir. 1983)]. . . . The PTO did not establish that the ADOs, within the context of the entire claims, lack a new and nonobvious functional relationship with the memory. The ADOs follow a particular sequence that enables more efficient data processing operations on stored data. The ADOs facilitate addition, deletion, and modification of information stored in the memory. In sum, the ADO’s perform a function.

Id. at 1584.

Appeal 2011-001447
Application 10/868,312

In addition to addressing the functional relationship between the ADOs and claimed invention, *Lowry* arguably suggested that “data structures” might not be analogous to printed matter. *Id.* (“Even assuming, arguendo, that data objects and data structures are analogous to printed matter” *Lowry* described the ADOs as having “data structure” because:

Indeed, *Lowry* does not seek to patent the Attributive data model in the abstract. Nor does he seek to patent the content of information resident in a database. Rather, *Lowry*’s data structures impose a physical organization on the data.

In *Lowry*’s invention, the stored data adopt no physical “structure” per se. Rather, the stored data exist as a collection of bits having information about relationships between the ADOs. Yet this is the essence of electronic structure.

Id. at 1583–84.

First Argument and Analysis

Appellant argues that claims 24’s web assets fall outside the printed matter doctrine insofar as being stored and processed. Second Reh’g Req. 3–4. Appellant particularly contends:

In declining to extend the scope of printed matter rejections, the Federal Circuit held that “the Board erroneously extended a printed matter rejection under sections 102 and 103 to a new field in this case, which involves information stored in a memory,” [*In re Lowry*, 32 F.3d 1579, 1583 (Fed. Cir. 1994)] (emphasis added). The Federal Circuit also stated “[t]he printed matter cases have no factual relevance where ‘the invention as defined by the claims requires that the information be processed not by the mind but by a machine, the computer.’” *Id.* (emphasis in original, internal citations omitted).

Appeal 2011-001447
Application 10/868,312

The limitations of claim 24 recite information (i.e., web assets) stored in memory (e.g., a database) and necessarily processed by a computer (i.e., via the user interface). Thus, *Lowry* is binding precedent and mandates that the printed matter line of cases have no factual relevance to the limitations at issue within claim 24.

Id.^{5and 6}

We agree that claim 24’s web assets are electronic data (herein “data”); that is, are information intrinsically stored and processed by machine. We also agree that *Lowry* is instructive precedent. However, contrary to Appellant’s argument, *Lowry* does not categorically exclude all data from the printed matter doctrine. Rather, *Lowry* confirms that “merely underlying data in a database” is analogous to printed matter and thus subject to the printed matter doctrine. 32 F.3d at 1583.

As discussed *supra*, *Lowry* also clarified that data cannot fall under the printed matter doctrine if functionally related to the claimed invention. *Id.* at 1583–84. We accordingly explained that claim 24’s web assets have no functional relationship to the claimed method. Remand Dec’n 9. In fact, the web assets have no discernible function, whatsoever (unless being “authored . . .” and “provided . . .” (claim 24) somehow constitutes a web asset function).

⁵ For consistency with the Board’s standardized formatting, this opinion replaces Appellant’s underlining of case names with italicization. The opinion retains Appellant’s use of underlining for emphases.

⁶ The block quote’s “not by the mind but by a machine” statement is further addressed by a later section of the Second Rehearing Request (Second Reh’g Req. 6) and the “Second Argument and Analysis” section of this opinion.

Appeal 2011-001447
Application 10/868,312

As also discussed *supra*, *Lowry* suggested that “data structures” might not be analogous to printed matter. *Id.* at 1584. We accordingly explained that claim 24’s web assets have no data structure. Remand Dec’n 13; *accord* Second Reh’g Req. 7, fn. 2 (Appellant’s description of “data structure”).

Instead of addressing these findings, Appellant incorrectly contends that *Lowry* excludes all data from the printed matter doctrine. Because Appellant has not established an error in our findings, we maintain our holding that claim 24’s web assets fall under the printed matter doctrine.

That being said, we withdraw one of our previous findings. We found that, even assuming *arguendo* claim 24’s web assets constitute data structure, they would nonetheless lack a functional relationship to the claimed method and thus could not be accorded patentable weight.⁷ Remand Dec’n 14. We acknowledge, however, this finding *may* run afoul of *Lowry*’s above-noted “*arguendo*” statement. *See supra* 7 (quoting *Lowry*, 32 F.3d at 1584).

Second Argument and Analysis

Appellant argues that the printed matter doctrine applies only to information processed by the mind. Second Reh’g Req. 6. Appellant particularly states:

⁷ We expressed this view to stress the importance of establishing a functional relationship between claims 24’s method and web assets. Nonetheless, because claim 24’s web assets do not constitute data structure, we withdraw our finding so as to leave this issue (of whether data structure must be functionally related to a claimed method to be accorded patentable weight) with pertinent appeals.

Appeal 2011-001447
Application 10/868,312

[*Lowry*] also cited *In re Bernhart*, for the proposition that “the printed matter cases have no factual relevance where ‘the invention as defined by the claims *requires* that the information be processed not by the mind but by a machine, the computer’.” [*Lowry*, 32 F.3d at 1583 (quoting *Bernhart*, 417 F.2d 1395, 1399 (CCPA 1969))] (emphasis in original). The notion that printed matter cases only involve information processed by the human mind is also supported by the aforementioned [*King Pharmaceuticals, Inc. v. Eon Labs, Inc.*, 616 F.3d 1267 (Fed. Cir. 2010)] and [*In re Ngai*, 367 F.3d 1336 (Fed. Cir. 2004)], which both involve instructional limitations (i.e., instructions to be presented to a user and comprehended within the user’s mind).

Id. (original emphasis).

Appellant’s argument again mischaracterizes *Lowry* as categorically excluding all data — all information processed by machine — from the printed matter doctrine. Rather, *Lowry*’s above quotation of *Bernhart* emphasizes, and literally so (*see* above block quote), that the printed matter doctrine does not extend to a *claimed invention’s required processing of data*. *Bernhart*’s quoted excerpt explains this touchstone of analysis with reference to infringement, stating:

Looking first at the apparatus claims, we see no recitation therein of mental steps, nor of any element requiring or even permitting the incorporation of human faculties in the apparatus. These claims recite, and can be infringed only by, a digital computer in a certain physical condition, i.e., electromechanically set or programmed to carry out the recited routine. . . . Accordingly, we think it clear that applicants have not defined as their invention anything in which the human mind could be used as a component.

Nor are the ‘printed matter’ cases, cited by the board, *supra*, controlling as to these apparatus claims either on the facts or in principle. On their facts, those cases dealt with claims defining

Appeal 2011-001447

Application 10/868,312

as the invention certain novel arrangements of printed lines or characters, useful and intelligible only to the human mind. Here the invention as defined by the claims requires that the information be processed not by the mind but by a machine, the computer, and that the drawing be done not by a draftsman but by a plotting machine. Those ‘printed matter’ cases therefore have no factual relevance here.

417 F.2d at 1399 (paragraphing added). Appellant has not established any such required processing of claim 24’s web assets.

However, Appellant has incorrectly alleged such required processing within the CAFC Brief. Despite the fact that claim 24’s method does not select a web asset (but rather a “first element” which need not be a web asset), the CAFC Brief’s “Statement of the Case” section describes the invention as a computer-implemented method that selects a web asset. *Id.* at 2–3. For clarification, the CAFC Brief even adds a diagram. *Id.* at 3. Then, with reference to the diagram, Appellant contends: “As illustrated in the diagram . . . , claim 24 requires that a first web asset is selected, using the user interface, from two sources[.]” *Id.* at 13. Again, as noted above, the claimed method does not require selecting of a web asset.⁸

⁸ Appellant has never argued before the Board that claim 24’s selecting step requires selection of a web asset whatsoever (*see* Spec. 11, ll. 3–13 (general description of “web asset”)), much less selection of a web asset as particularly recited and referenced in this opinion (*see supra* 4, *fn.* 4 (“herein . . . ‘web assets’ . . . reference the emphasized language of reproduced claim 24”)). We nonetheless note that, if Appellant intended to require selection of a web asset whatsoever, then claim 24 would be directed to designing a “web page document” (not an “electronic document” as recited by the preamble) and require selecting of a “first web asset” (not a “first element” as recited by the selecting step). We also note that, even if such amendments were entered, claim 24 would then only require selection of

Appeal 2011-001447
Application 10/868,312

Appellant now argues that claim 24's selecting step "contemplates a step of receiving web asserts [sic] by the user interface and from the user." Second Reh'g Req. 8. In support, Appellant explains that "[t]he database cannot include both types of web assets without this [receiving] step being performed at some time." *Id.* In doing so, Appellant analogizes claim 24's selecting step to hypothetical claim steps of "heat treating a machined widget" and "storing, in a database, the encrypted data structure received from a client." *Id.* According to Appellant, the heating step "implicitly requires that the widget be machined." *Id.* And, the storing step "implicitly requires steps of 'encrypting a data structure' and 'receiving the encrypted data structure from the client'." *Id.*

Appellant's argument is unpersuasive for each of three reasons.

First and foremost, Appellant has not established that claim 24's "contemplated" step of receiving a web asset "at some time" is tantamount to a claimed invention's required processing of data. Clearly, a contemplated operation is not tantamount to a claimed invention's required operation.

Second, even assuming *arguendo* that a contemplated step is tantamount to a claimed invention's required step, the contemplated receiving step is not a function of the web asset. By comparison, *Lowry's*

web asset generally; not selection of a web asset from among the database's recited web assets (*i.e.*, not selection of a "web asset" as referenced in this opinion (*see supra* 4, *fn.* 4)). We lastly note that the Specification in no way limits the invention to selecting of a web asset received from a particular source. As opposed to such a disclaimer, the Specification confirms that web assets need not be received from a particular source. Spec. 15, ll. 11–26 ("variety of sources").

Appeal 2011-001447
Application 10/868,312

ADOs were not merely received or provided. Rather, the ADOs performed a function (and did so as part of the claimed invention's operation). 32 F.3d at 1584.

Third, there is a striking difference between the claimed selecting step and hypothetical steps. Namely, even if we construe claim 24 as selecting the first element from a web asset database, that is still not the selecting of a web asset nor does it yield any functional relationship between the claimed method and a web asset. By contrast, heating a machined widget heats the machined content (surface). Similarly, storing an encrypted data structure stores the encrypted content. Thus, the hypothetical steps yield a functional relationship between the required steps and the described contents of the operated-upon structures; that is, between heating and the widget's machined surface and between storing and the data structure's encrypted data.

In light of the above third concern, we have noted that even a required claim step can fall under the printed matter doctrine if lacking a functional relationship to the method. Remand Dec'n 10–11. As we explained, *King Pharmaceuticals* held so because a claimed method and informing step had no interdependence. Remand Dec'n 11 (quoting 616 F.3d at 1279). We correspondingly explained that, even assuming *arguendo* claim 24's method uploads the web assets to the database, the method and uploading also have no interdependence. *Id.*

Instead of addressing our above concerns, Appellant provides unreasonably narrow and expansive views of the case law. Namely, Appellant contends that *Lowry* "sweeping[ly]" excludes stored data from the printed matter doctrine. Second Reh'g Req. 6. Yet, Appellant contrastingly

Appeal 2011-001447
Application 10/868,312

contends that *King Pharmaceuticals* is limited to instructional limitations. *Id.* As discussed, Appellant's arguments as to *Lowry's* breadth are incorrect. Appellant presents no supporting arguments — and we find no support — as to *King Pharmaceuticals'* alleged narrow breadth.

That being said, we withdraw our above “uploading” finding. We do so because that finding *may* run afoul *Lowry's* and *Bernhart's* statements with respect to a claimed invention's required processing of data.⁹

Third Argument and Analysis

Appellant argues that the rationale behind the printed matter doctrine is to guard against endless patenting of a known product via additions of mere informational content. Second Reh'g Req. 4–5. Appellant particularly states:

As stated by the Federal Circuit, “[t]he rationale behind [the printed matter] line of cases is preventing the indefinite patenting of known products by the simple inclusion of novel, yet functionally unrelated limitations.” *King Pharmaceuticals*, [616 F.3d at 1278-79]. Similarly, in *Ngai*, the Federal Circuit stated “[*Ngai*] is not, however, entitled to patent a known product by simply attaching a set of instructions to that product.” *In re Ngai*, [367 F.3rd at 1339].

Second Reh'g Req. 4.^{10 and 11}

⁹ We had expressed this finding to stress the importance of establishing a functional relationship between claims 24's method and web assets. Nonetheless, because claim 24's method does not require uploading of the web assets, we withdraw our finding so as to leave this issue (of whether a claimed method's required processing of data must be functionally related to the method to be accorded patentable weight) with pertinent appeals.

Appeal 2011-001447
Application 10/868,312

The above rationale encapsulates why claim 24's web assets must functionally relate to the claimed method to be accorded patentable weight. Otherwise, assuming *arguendo* the web assets are novel, Appellant could patent any method that operates on a database including the web assets; regardless of the operation's relation to the web assets.

Conclusion

For the foregoing reasons, Appellant has not established an error in our rejection of claim 24.

CLAIM 25

Reproduced Claim

Claim 25 is reproduced below with emphasis on the search request.

25. The method of claim 24, further comprising, prior to displaying the first element in the second display region:

receiving a *search request*;

¹⁰ Appellant requests us to “(i) explicitly identify the alleged ‘known product’ associated with Appellant’s claimed invention and (ii) explicitly identify the alleged ‘functionally unrelated limitations.’” Second Reh’g Req. 4–5. The “known product” is analogous to the claimed method sans the web assets. The “functionally unrelated limitation” is analogous to the web assets.

¹¹ Appellant asks: “A) Is the Board applying a rejection based upon the printed matter doctrine to claim 24? [; B) What exactly within claim 24 does the Board consider to be the ‘substrate’? [; and] C) What exactly within claim 24 does the Board consider to be the ‘printed matter’?” Second Reh’g Req. 9. We are applying the printed matter doctrine. The “substrate” is analogous to the claimed method sans the web assets. The “printed matter” is analogous to the web assets.

Appeal 2011-001447
Application 10/868,312

displaying a list of available elements stored in the database in response to the *search request*;

receiving a selection command to select the first element from the results.

Analysis

We interpret claim 25's "search request" as broad enough to encompass a selective retrieving of data. In support, we stated:

In accord with an ordinary meaning of "search" within the computer arts and consistent with Appellant's Specification, we construe the claimed "search request" as meaning a selective retrieving of data. *See e.g.*, "search." Dictionary.com Unabridged. Random House, Inc. (<http://dictionary.reference.com/browse/search> (last visited August 11, 2013)) ("the act or process of electronically retrieving data, Web pages, database records, or other information from files, databases, etc."); *accord* Spec. 12, 1. 8–13, 1. 13 (describing "search buttons" that merely retrieve available style options (e.g., retrieve a "color pallet 640" [sic] of Appellant's Figure 6); also describing "search entry fields").

Remand Dec'n 15–16.

Our above statement presents a two-fold reason for construing claim 25's search request as encompassing a selective retrieving of data. First, a general dictionary states that the ordinary meaning of "search" includes "electronically retrieving data." Second, Appellant's Specification describes a "search button" for retrieving respective menus of web assets by category (e.g., color pallet 640) and without entering search criteria; as contrasted with "search entry fields."

"The specification is . . . the primary basis for construing the claims." *Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 452 (Fed. Cir. 1985).

Appeal 2011-001447
Application 10/868,312

The Specification describes (i) the search button as retrieving a search menu without any entry of a criterion, (ii) the search menu as retrieving a color palette without any entry of a criterion, and (iii) the color palette as retrieving color elements without any entry of a criterion. Spec. 13, ll. 24–26. The Specification also references the above retrieval of data, via the color palette 640, as a “search request.” Spec. 39, ll. 2–6 (“[I]nformation concerns color elements if the search request was made via color pallet 640”). Because the series (i) to (iii) of selecting the search button, then search menu, and then color palette retrieves data elements without any entry of search criteria, we found that claim 25’s search request encompasses a user-selective retrieval of data. *See* Remand Dec’n 15–16 (block-quoted above) (“*accord* Spec. 12, l. 8–13, l. 13 (describing ‘search buttons’ that merely retrieve available style options (e.g., retrieve a ‘color pallet 640’ [sic] of Appellant’s Figure 6)[]”).

Appellant argues that our interpretation of “search request” is too broad, stating:

The Board’s new claim construction for “search request” as a request for “selective retrieving of data” only requires that the retrieval of data involves a selection — as opposed to being non-selective (i.e., random). However, not all selectively retrieved data involves a “search request,” as claimed. Based upon the Board’s own evidence and consistent with its ordinary meaning, a “search request” is a request that includes conditions/keywords/criteria with which the search is to be performed. *See SuperGuide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 883 (Fed. Cir. 2004) (“we conclude the claim phrase ‘to perform a search’ means any examination of [thing to be searched] to find those that meet a user’s search criteria”).

Appeal 2011-001447
Application 10/868,312

Second Reh’g Req. 10.¹² Appellant presents no explanation of why our cited general dictionary definition, our cited Specification examples, and Appellant’s cited *SuperGuide* decision evidence that a “search” or “search request” requires a search condition, keyword, or criterion. Despite Appellant’s failure to do so, we note the following.

Our general dictionary definition does not evidence “search” as requiring entry of a condition, keyword, or criterion. Rather, the entire definition states: “act or process of electronically retrieving data, Web pages, database records, or other information from files, databases, etc.” Second Reh’g Req. 11 (quoting the definition and ensuing examples). Only the ensuing examples — “as in Boolean search; keyword search” — reflect a search criterion. *Id.* (Appellant’s emphasis omitted).

Our Specification examples of a search button, search menu, and search entry field (discussed *supra*) evidence Appellant’s intention that neither the disclosed “search button” nor disclosed “search menu” require a corresponding search criterion. Further, the Specification examples confirm that a “search request” may be performed by merely traversing the search button and search menu to select a color palette option. Thus, the Specification evidences an intention that “search” elements not require (but may include) a search criterion.

¹² Appellant contends the quoted “analysis was not presented by the Examiner and constitutes a new grounds of rejection.” Second Reh’g Req. 10, *fn.* 3. This is nothing more than a naked allegation that our interpretation changes the thrust of the rejection. Note also, the First Rehearing Decision presented the exact same interpretation. First Reh’g Dec’n 9.

Appeal 2011-001447
Application 10/868,312

Finally, *SuperGuide* does not hold that the ordinary meaning of “search” requires entering of criteria. Rather, in *SuperGuide*, the appealed District Court found the disputed “to perform a search” claim language means, in light of the Specification, “a user-directed examination . . . of all the television programming information . . . and the retrieval of a subset of that information which meets the criteria specified[.]” 358 F.3d at 881. The Federal Circuit found the District Court erred insofar as construing the “perform a search” language to mean a search of all programming information. *Id.* at 882–83. As part of the analysis, the Federal Circuit addressed “one” general dictionary definition of “search” and found that it “says nothing about how the search is to be conducted.” *Id.* at 882. In light thereof, the Federal Circuit found the ordinary meaning of “search” is broad enough to encompass the District Court’s construction; not that the ordinary meaning requires that construction. *Id.* Thus, the Federal Circuit did not find that the ordinary meaning requires a search criterion.

Conclusion

For the foregoing reasons, Appellant has not established an error in our rejection of claim 25.

DECISION

Appellant’s Second Rehearing Request is denied.

DENIED

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