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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the board

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SRINIVASA R. **KOPPOLU**, C. DOUGLAS HODGES, BARRY B. MacKICHAN, RICHARD McDANIEL, RAO V. REMALA, and ANTONY S. WILLIAMS

Appeal No. 2005-1431
Reissue Application 09/442,070
Patent 5,801,701
Technology Center 2100

Decided: May 24, 2007

Before MICHAEL R. FLEMING, *Chief Administrative Patent Judge*, JOHN C. MARTIN, *Administrative Patent Judge*, FRED E. McKELVEY, *Senior Administrative Patent Judge*, ADRIENE LEPIANE HANLON and ROMULO H. DELMENDO, *Administrative Patent Judges*.

MARTIN, *Administrative Patent Judge*.

NEW DECISION ON APPEAL

This New Decision on Appeal replaces the Decision on Appeal entered September 28, 2006, which is hereby vacated in its entirety.[1]

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[1] This New Decision on Appeal is entered in response to the Request for

(Continued on next page.)

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of reissue application claims 40-50 for failing to satisfy the written description and enablement requirements of 35 U.S.C. § 112, first paragraph, and also from some related objections. Claims 1-39 have been allowed.

We have jurisdiction under 35 U.S.C. § 134(a). We reverse.

I. Background

Appellants' reissue application was filed on November 16, 1999, with claims 1-49. Claims 1-39 are the unamended original claims from Patent 5,801,701 (hereinafter "'701 patent" or "Appellants' patent"), of which reissue is sought.[2] Claims 40-49 as filed were exact copies of claims 1-10, respectively, of Doyle et al. Patent 5,838,906 ("the Doyle patent"),[3] which were copied for the purpose of provoking an interference with that patent.

The Doyle patent is the basis of a pending infringement action brought in the U.S. District Court for the Northern District of Illinois by The Regents of the University of California and its exclusive licensee, Eolas Technologies, Inc., (collectively "Eolas") against Microsoft Corporation. *Eolas Technologies, Inc. v. Microsoft Corp.*, No. 99 C 0626 (N.D. Ill.). The district court's award of judgment to Eolas on the infringement issue was vacated and the case remanded for further

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Rehearing dated November 28, 2006. Oral argument on the Request for Rehearing was heard on April 11, 2007.

[2] Claim 50 was added by "Amendment C" (Paper No. 37), dated August 19, 2002.

[3] Issued November 17, 1998, based on an application filed October 17, 1994.

proceedings by the Federal Circuit in *Eolas Technologies, Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1328, 1341, 73 USPQ2d 1782, 1785, 1795 (Fed. Cir. 2005).

The Doyle patent was until recently the subject of Reexamination Control No. 90/006,831, a Director-initiated reexamination proceeding initiated under 37 C.F.R. § 1.520. On June 6, 2006, a reexamination certificate was issued confirming the patentability of Doyle patent claims 1-10, which were not amended during the reexamination proceeding and which constitute all of the Doyle patent claims.

The Doyle patent is currently involved in another reexamination proceeding, Reexamination Control No. 90/007,858, which was initiated at the request of a third party, Klarquist Sparkman, LLP.[4] The paper ordering reexamination of Claims 1-10 was entered on February 9, 2006.

The owners of the Doyle patent, i.e., The Regents of the University of California, have filed three protests during the examination of Appellants' reissue application.

II. The rejections and objections

Claims 40-50 stand rejected under 35 U.S.C. § 112, first paragraph, on two grounds: (1) as lacking written description support in the '701 patent (hereinafter the "new matter rejection") and (2) as based on a nonenabling disclosure. In addition, the Examiner has objected to amendments to the specification and proposed new drawing Figures 57-91 under 35 U.S.C. § 251 for containing new

[4] Identified as "Microsoft Preferred Legal Counsel" at
(Continued on next page.)

matter and also has objected to the specification under 37 C.F.R. § 1.75(d)(1) for failing to provide clear support or antecedent basis in the specification for some of the terms in Claims 40-50. The new matter objections under 35 U.S.C. § 251 are within our jurisdiction because they involve the merits of the rejection for lack of written description support. *Manual of Patent Examining Procedure* (MPEP) § 608.04(c) (2006). The objection based on 37 C.F.R. § 1.75(d)(1) is not within our jurisdiction. The appeal is therefore dismissed with respect to that objection.

Of the three independent claims on appeal (40, 45, and 50), only claims 40 and 50 are separately argued by the Examiner and Appellants. Claim 40 employs the term "network"; claim 50 does not. The limitations that allegedly lack written description support are italicized in Claims 40 and 50 as reproduced below. The principle limitations at issue are the "network" limitations in claim 40 and the term "a browser application" in claims 40 and 50. As evidence that these limitations have written description support in the '701 patent, the Brief relies on *The Windows Interface: An Application Design Guide* (hereinafter *Windows Interface*), which Appellants contend is incorporated by reference in its entirety into the '701 patent by the incorporating language that appears at column 12, ll. 13-21. More particularly, they rely on Chapters 5 and 9, of which the text thereof has been added by amendment to their specification and the figures thereof have been presented as

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http://klarquist.com/home.aspx.

proposed new drawing Figures 57-91.[5] The Examiner has objected to the added text and the proposed new drawing figures as containing new matter.

In the Request for Rehearing, Appellants additionally argue that support for the network limitations can be found in *Programmer's Reference, Volume 2: Functions*, Microsoft Corp. (1992) (hereinafter *Programmer's Reference*), which is one of three other documents they contend are incorporated by reference in their entirety by the incorporating language that appears at column 12, lines 30-36. Portions of each of these three documents were added by amendment to the specification of the '701 patent[6] without objection by the Examiner. The Request for Rehearing was accompanied by a copy of three pages of *Programmer's Reference* (Req. Reh'g Attach. J), which contain a definition of the "OpenFile" command, on which Appellants specifically rely. Req. Reh'g 10.[7]

During the oral argument, Appellants additionally argued that further support for the "network" limitations is provided by the term "net bios" in the incorporated material, Hr'g Tr. 12:8-16, which we assume is a reference to "NetBIOSCall" in *Programmer's Reference*.

[5] "Amendment A" (Paper No. 20), filed July 25, 2001. Chapters 5 and 9 of *Windows Interface* accompanied the Brief as Attachment B. A complete copy of *Windows Interface* was filed concurrently with the Request for Rehearing.

[6] "Response to Office Action Dated October 19, 2001" (Paper No. 25), filed January 17, 2002.

[7] Appellants identify the page numbers, which do not appear in the attachment, as 731-33. Req. Reh'g 10.

Claims 40 and 50 read as follows (emphasis added):

40. A method for running an application program in a computer *network* environment, comprising:

providing *at least one client workstation* and one *network server* coupled to said *network* environment, wherein said *network* environment is a *distributed hypermedia environment*;

executing, at said client workstation, *a browser application, that parses a first distributed hypermedia document to identify text formats included in said distributed hypermedia document and for responding to predetermined text formats to initiate processing specified by said text formats;*

utilizing said browser to display, on said client workstation, at least a portion of a first hypermedia document *received over said network from said server*,

wherein the portion of said first hypermedia document is displayed within a first browser-controlled window on said client workstation,

wherein said first distributed hypermedia document includes an *embed text format*, located at a first location in said first distributed hypermedia document, *that specifies the location of at least a portion of an object external to the first distributed hypermedia document*,

wherein *said object has type information associated with it to identify and locate an executable application external to the first distributed hypermedia document*, and

wherein said embed text format is parsed by said browser to automatically invoke said executable application to execute on said client workstation in order to display said object and enable interactive processing of said object within a display area created at said first location within the portion of said first distributed hypermedia document being displayed in said first browser-controlled window.

50. A method for running an application program in a *computer environment*, comprising:

providing *at least one client workstation coupled to said environment,* wherein said environment is a *hypermedia environment*;

executing, at said client workstation, *a browser application, that parses a first hypermedia document to identify text formats included in said hypermedia document and for responding to predetermined text formats to initiate processing specified by said text formats;*

utilizing said browser to display, on said client workstation, at least a portion of a first hypermedia document,

wherein the portion of said first hypermedia document is displayed within a first browser-controlled window on said client workstation,

wherein said first hypermedia document includes an *embed text format*, located at a first location in said first hypermedia document, *that specifies the location of at least a portion of an object external to the first hypermedia document*,

wherein *said object has type information associated with it to identify and locate an executable application external to the first hypermedia document*, and

wherein said embed text format is parsed by said browser to automatically invoke said executable application to execute on said client workstation in order to display said object and enable interactive processing of said object within a display area created at said first location within the portion of said first hypermedia document being displayed in said first browser-controlled window.

III. Issues

Bearing in mind that Appellants have the burden to demonstrate error in the Examiner's position, *see In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1455 (Fed. Cir. 1998) ("On appeal to the Board, an applicant can overcome a

rejection [for obviousness] by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness."), the issues are as follows:

(1) Does the '701 patent, disregarding the material allegedly incorporated by reference therein, provide inherent written description support for the "network" language in Claim 40?

(2) Alternatively, does the '701 patent, including the material incorporated by reference therein, provide express written description support for the "network" limitations?

(3) Does the language "at least one client workstation coupled to said [computer] environment" in Claim 50 imply the presence of a network and thus stand or fall with the "network" language insofar as the new matter rejection is concerned?

(4) Do the terms "computer environment" and "hypermedia environment" in Claim 50, which are broad enough to read on a stand-alone computer or a network computer, lack written description support to the extent they encompass a network computer?

(5) Does the '701 patent provide written description support for the phrase "a browser application" in Claims 40 and 50?

(6) Does the '701 patent disclose the "embed text format" recited in Claims 40 and 50?

(7) Does the '701 patent disclose the "type information" recited in Claims 40 and 50?

(8) Does the '701 patent disclose using a browser application to perform the functions required of the browser application by Claims 40 and 50?

(9) Are Claims 40 and 50 based on a non-enabling disclosure?

(10) Do the amendments to the specification of the reissue application and the proposed new drawing Figures 57-91 contain new matter?

IV. Appellants' patent disclosure

The '701 patent discloses a computer system and method (col. 2, ll. 55-57) for editing a compound document which is generated by a first application and includes linked or embedded data generated by one or more other applications. '701 patent, col. 7, ll. 38-41.

Referring to Figures 1 and 2, a compound document 101 designated VAC1.DOC and entitled "VAC1 PROJECT" includes (a) text 104 created by a word processing program 206, (b) scheduling data 102 generated as a chart by a project management program 201, and (c) budgeting data 103 generated by a spreadsheet program 204. Col. 1, l. 22 to col. 2, l. 11.

The compound document 101 as a whole is referred to as a "container" object, and the project management and spreadsheet objects 102 and 103 that are embedded or linked therein are "containee" objects. Col. 7, ll. 46-53. An application that creates a compound document (e.g., Microsoft Word®, hereinafter "Word") is referred to as a container or client application, and an application that creates and manipulates containee objects (e.g., Microsoft Excel®, hereinafter "Excel") is referred to as a server application. Col. 8, ll. 50-53. "In a preferred embodiment, application programs ('applications') cooperate using object linking

and embedding (OLE) facilities to create and manipulate the compound documents." Col. 8, ll. 47-50.[8]

Figure 3 shows a compound document which is similar to the compound document depicted in Figure 1. The spreadsheet object (i.e., budgeting data 305) is described as being embedded rather than linked. Col. 8, ll. 9-10. Word treats embedded data as simple bitmaps that Word displays with a BitBlt operation when rendering the compound document on an output device. Col. 2, ll. 3-6. The main window 301 of the Word display, which shows the compound document after it has been opened by Word, includes: (a) a title bar 302 reading "Microsoft Word - VAC1.DOC"; (b) a menu bar 303 containing the standard Word menu groups File, Edit, View, Insert, Format, Tools, Table, Window, and Help; and (c) a client window 304 that includes the native text of the document as well as the embedded Excel spreadsheet object 305 and the embedded scheduling object (unnumbered).

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[8] OLE is defined as follows in Microsoft Press Computer Dictionary 278 (2d ed. 1994) (emphasis added) (copy enclosed):

> **OLE** . . . ; acronym for object linking and embedding, a way to transfer and share information among applications. When an object (such as an image file created with a paint program) is *linked* to a compound document (such as a spreadsheet or a document created with a word-processing program), the document contains only a reference to the object; any changes made to the contents of a linked object will be seen in the compound document. When an object is *embedded* in a compound document, the document contains a copy of the object; any changes to the contents of the original object will not be seen in the compound document unless the embedded object is updated.

Col. 8, ll. 3-14. Embedded objects (e.g., the Excel spreadsheet object) apparently are displayed automatically whenever Word is used to open the compound document.

After using Word to display the compound document, the user can use the mouse to select an object and then select an action (e.g., a menu item) to be performed upon the object. Col. 8, ll. 15-18; col. 11, ll. 13-16. When the user indicates that the budgeting data is to be edited, the word processing program (Word) determines which application should be used to edit the budgeting data (e.g., the Excel spreadsheet program) and launches (starts up) that application; the user can then manipulate the budgeting data using the launched application, with the resulting changes being reflected in the compound document. Col. 7, ll. 55-62. The above procedure is used whether the budgeting data is stored as an embedded object or as a linked object. Col. 7, ll. 62-63.

Figure 8 shows the contents of the drop-down Edit menu group when it is selected following selection of the Excel object. The available Edit options 802 include an entry 803 entitled "Microsoft Excel Worksheet Object Edit." If the Edit menu group is selected without first selecting an Excel object, entry 803 does not appear. Col. 11, ll. 28-29.

Figure 4 shows the appearance of the compound document after the user has selected the Excel object followed by selecting "Microsoft Excel Worksheet Object Edit" from the drop-down Edit menu (Fig. 8). Col. 8, ll. 25-46. The title bar changes to read "Microsoft Excel - Worksheet in VAC1.DOC," the Excel object becomes highlighted by a hatched border pattern 406, the menu bar displays a

different set of menu groups (*viz.*, File, Edit, Formula, Format, Data, Options, Macro, Window, and Help), and a rectangular spreadsheet selection cursor 408 appears that permits selection of the item to be edited within the spreadsheet object 405. *Id.*

Figure 9 shows that the menu bar shown in Figure 4, designated 901 in Figure 9, is a composite menu bar consisting of Word menu groups 902 ("File") and 905 ("Window") and Excel menu groups 903 ("Edit"), 904 ("Formula," "Format," "Data," "Options," and "Macro"), and 906 ("Help"). Col. 11, ll. 54-59. The composite nature of the menu bar is also depicted in Figure 10. One of the issues before us is whether Appellants are correct to construe the following passage as effective to incorporate by reference at least Chapter 9 of *Windows Interface*, which they cite as support for the "network" and "browser application" limitations:

> FIG. 10 is a diagram of the menu groups that compose a composite menu bar in a preferred embodiment of the present invention. The composite menu bar 1003 comprises menu groups 1001 from the container application and menu groups 1002 from the server application. The container application menu groups 1001 include the File group, the Container group, and the Window group. The server application menu groups 1002 include the Edit group, the Object group, and the Help group. In a preferred embodiment, the container and server application menus are interleaved in the final composite menu bar, according to the Microsoft application user interface style guidelines, which is [sic] specified in *"The Windows Interface: An Application Design Guide," Microsoft Corp., 1992, which is herein incorporated by reference.* Specifically, in the composite menu bar 1003, the groups are arranged left to right in the

following order: File, Edit, Container, Object, Window, and Help.

Col. 12, ll. 5-21 (emphasis added).

The '701 patent further explains that the applications are preferably provided with an implementation-independent Application Programming Interface (API) that provides OLE functionality. Col. 8, l. 65 to col. 9, l.1. The API is a set of functions that are invoked by container and server applications to manage, among other things, the setup and initialization necessary for container applications to send and receive messages and data to and from server applications. Col. 9, ll. 1-5. The API provides functions to invoke server applications to manipulate containee objects. Col. 9, ll. 5-7. The patent also explains that in a preferred embodiment, the in-place interaction API is implemented using the capabilities of the underlying window system, which the discussion of the invention indicates is similar to the Microsoft Windows 3.1 operating system, although one skilled in the art will appreciate that the invention can be implemented in a different underlying window system. Col. 12, ll. 23-30.

Issue 1 -- Does the '701 patent, disregarding the material allegedly incorporated by reference, provide inherent written description support for the "network" language in Claim 40?

A. Principles of law

The Examiner "bears the initial burden . . . of presenting a prima facie case of unpatentability." *In re Alton*, 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996) (quoting *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). Insofar as the written description requirement is concerned, that

burden is discharged by "presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims." *Alton*, 76 F.3d at 1175, 37 USPQ2d at 1583 (quoting *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976)).

> [T]he burden placed on the examiner varies, depending upon what the applicant claims. If the applicant claims embodiments of the invention that are completely outside the scope of the specification, then the examiner or Board need only establish this fact to make out a prima facie case. [*Wertheim*] at 263-64, 191 USPQ at 97. If, on the other hand, the specification contains a description of the claimed invention, albeit not in ipsis verbis (in the identical words), then the examiner or Board, in order to meet the burden of proof, must provide reasons why one of ordinary skill in the art would not consider the description sufficient. *Id.* at 264, 191 USPQ at 98.

Alton, 76 F.3d at 1175, 37 USPQ2d at 1583. Once the Examiner or Board has met the initial burden of making out a prima facie case of unpatentability, "the burden of coming forward with evidence or argument shifts to the applicant." *Id.* (quoting *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444). To overcome a prima facie case, an applicant must show that the invention as claimed is adequately described to one skilled in the art. *Alton*, 76 F.3d at 1175, 37 USPQ2d at 1583. "After evidence or argument is submitted by the applicant in response, patentability is determined on the totality of the record, by a preponderance of the evidence with due consideration to persuasiveness of argument." *Id.* (quoting *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444).

The relevant date for construing the claim terms at issue is the September 4, 1996, filing date of Appellants' Application 08/707,684, which matured into the

'701 patent. *See Reiffin v. Microsoft*, 214 F.3d 1342, 1346, 54 USPQ2d 1915, 1917 (Fed. Cir. 2000) (a determination of whether a patent disclosure provides 35 U.S.C. § 112, first paragraph, written description support for a claim in a validity determination is to be judged as of the filing date of that patent disclosure, not the filing date of an ancestor application).

Reissue claims are given their broadest reasonable interpretation consistent with the disclosure of the original patent, i.e., the patent sought to be reissued. *In re Reuter*, 651 F.2d 751, 756, 210 USPQ 249, 253 (CCPA 1981). This rule of claim construction applies even where, as here, the claim is copied from a patent for the purpose of provoking an interference. *See Cultor Corp. v. A.E. Staley Mfg. Co.*, 224 F.3d 1328, 1332, 56 USQ2d 1208, 1211 (Fed. Cir. 2000) ("When a claim is copied from another patent for interference purposes, it must be supported by the specification of the copier."). Appellants disagree, contending at oral argument that *In re Spina*, 975 F.2d 854, 24 USPQ2d 1142 (Fed. Cir. 1992) is controlling and requires that we construe the claims in light of Doyle's specification, from which the claims were copied (Hr'g Tr. 7:9 to 8:2). While it is true that *Spina*[9] states that "[a] claim is not interpreted one way in light of the specification in which it originally was granted, and another way in light of the specification into which it is copied as a proposed interference count," 975 F.2d at 858, 24 USPQ2d at 1145, *Cultor*[10] subsequently characterized *Spina* as consistent with the proposition that a

[9] Opinion by Newman, J., joined by Cowan, S.J., and Lourie, J.
[10] Opinion by Newman, J., joined by Friedman, S.J., and Rader, J.

claim copied for interference purposes is to be construed in light of the copier's specification:

> Every patent claim is construed in the context of the specification in which it appears as part of the patent document. When a claim is copied from another patent for interference purposes, it must be supported by the specification of the copier. In *Spina* the application into which the claim was copied was deemed to contain sufficient written description to support the claim, although the structure by which the claimed function was performed was not the same as the structure shown in the specification from which the claim was copied. The court in *Spina* did not hold that the copier of a claim for interference purposes thereby acquires the benefit of the descriptive text of the copied patent.
>
> The claims to which Cultor demonstrated priority in the interference are construed in light of Cultor's specification; it becomes irrelevant whether the specific text of the claim was copied from the interfering patent. *See Young Dental Mfg. Co. v. Q3 Special Prods., Inc.*, 112 F.3d 1137, 1143, 42 USPQ2d 1589, 1594 (Fed. Cir. 1997) ("The specification that is relevant to claim construction is the specification of the patent in which the claims reside.")

Cultor, 224 F.3d at 1332, 56 USPQ2d at 1211.[11]

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[11] In *Rowe v. Dror*, 112 F.3d 473, 42 USPQ2d 1550 (Fed. Cir. 1997), the court characterized *Spina* as holding that when determining "whether an applicant was eligible to copy a patentee's claim and thereby challenge priority of invention, . . . a copied claim is interpreted in light of its originating disclosure." 112 F.3d at 479, 42 USPQ2d at 1554. However, *Rowe's* characterization of *Spina* as setting forth such a rule is *dictum* and thus not controlling because the issue of written description support for a copied claim was not before the court. As the *Rowe* court explained,

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At oral argument, counsel stated that "the Federal Circuit refused to overrule *Spina* . . . in 2004," Hr'g Tr. 34:1-2, which we assume is a reference to *Bilstad v. Wakalopulos*, 386 F.3d 1116, 72 USPQ2d 1785 (Fed. Cir. 2004). Rather than refusing to overrule *Spina*, the court found it unnecessary to consider the merits of Bilstad's *Spina* argument:

> Bilstad also argues that the Board erred in construing the term "plurality" in view of Bilstad's disclosure, instead of looking to the '657 patent. Bilstad cites *In re Spina*, 975 F.2d 854 [24 USPQ2d 1142] (Fed. Cir. 1992), for the proposition that a count is construed in view of the originating disclosure. Wakalopulos concedes that the Board erred in this respect. Because we conclude that the construction of the term "plurality" is the same in view of either disclosure, we need not reach this issue.

386 F.3d at 1121 n.2, 72 USPQ2d at 1789 n.2. The court's failure to consider the merits of Bilstad's *Spina* argument does not imply agreement with that argument.

Written description support can be either express or inherent. *Reiffin*, 214 F.3d at 1346, 54 USPQ2d at 1917 (citing *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991); and *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991)). "In order for a disclosure to be inherent, 'the missing descriptive matter

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> that [*Spina*] rule does not apply in cases, such as this one, where the issue is whether the claim is patentable to one or the other party in light of prior art. In this posture, the PTO and this court must interpret the claim in light of the specification in which it appears.

Id.

must necessarily be present in the [original] application's specification such that one skilled in the art would recognize such a disclosure.'" *TurboCare Div. v. Gen. Elec. Co.*, 264 F.3d 1111, 1119, 60 USPQ2d 1017, 1023 (Fed. Cir. 2001) (brackets in original) (quoting *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1159, 47 USPQ2d 1829, 1834 (Fed. Cir. 1998)). It is therefore essential to distinguish between inherency, which can be relied on to establish written description support, and obviousness, which cannot. *See Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997) ("One shows that one is 'in possession' of *the invention* by describing *the invention*, with all its claimed limitations, not that which makes it obvious.") (citing *Vas-Cath*, 935 F.2d at 1563-64, 19 USPQ2d at 1117).

Where a claim term does not appear explicitly or implicitly in the specification, it is appropriate to look to dictionary definitions to determine the meaning of the term as of the filing date of the patent application. *MIT v. Abacus Software*, 462 F.3d 1344, 1351, 80 USPQ2d 1225, 1229 (Fed. Cir. 2006).

B. Analysis

Claim 40 includes the following "network" language, which the Examiner held lacks support in the '701 patent: "computer network environment," "network

server," "one network server," "document received over said network from said server," "distributed hypermedia environment," and "distributed hypermedia document.[12] While the term "network" does not appear in the '701 patent, there is no dispute regarding the meanings of the terms "network" and "network server," which are defined as follows in *Microsoft Press Computer Dictionary* (3d ed. 1997) (hereinafter *1997 Microsoft Dictionary*) at 327, 329, 430:[13]

> **network** . . . *n.* A group of computers and associated devices that are connected by communications facilities. . . .
>
> **network server** . . . *n.* *See* server.
>
> **server** . . . *n.* 1. On a local area network (LAN), a computer running administrative software that controls access to the network and its resources, such as printers and disk drives, and provides resources to computers functioning as workstations on the network. 2. On the Internet or other network, a computer or program that responds to commands from a client. . . .

The Examiner, relying on the Background of the Invention ("Background") (col. 1, l. 22 to col. 2, l. 43), determined that the '701 patent specifically discloses a stand-alone computer environment and not a network environment. More particularly, he held (1) that one skilled in the art would have understood the '701 patent to be disclosing "an improvement over [a] prior art compound document, in a single workstation environment; as set forth in [the] Background," Final Action 9,[14]

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[12] Appellants concede that the terms "distributed hypermedia environment" and "distributed hypermedia document" imply a network. Br. 26, last two lines.

[13] Copies of these definitions were enclosed with the April 26, 2001, Office action (Paper No. 18).

[14] References to the Final Action are to the last final Action (Paper No. 41),

(Continued on next page.)

and (2) that "no teaching explicitly or implicitly related to [a] network environment, distributed hypermedia, hyperlink, network server, network browser, [or] browser application can be found in the '701 disclosure or drawings that may lead one . . . skilled in the art to the networking aspect of the disclosed in-place activation of [a] containee object." *Id.* The Examiner thus rejected Appellants' argument that the '701 patent would have been understood by persons skilled in the art to be either inherently or expressly (via the incorporated-by-reference material) disclosing the use of both stand-alone and network computers.

We will begin with the Background, which describes using "computer systems" (col. 1, ll. 22-23) to prepare compound documents containing (a) text generated by a word processing program and (b) information generated by a different type of program, such as scheduling data in chart format generated by a project management program or budgeting data represented in spreadsheet format by a spreadsheet program. Col. 1, ll. 23-34. Two known, alternative techniques are described: embedding and linking. Embedding is discussed at column 1, line 58 to column 2, line 26, which explain that the user creates the compound document by (1) using the project management program and spreadsheet program to create scheduling data and spreadsheet data, respectively, which are then copied to a clipboard in a presentation format, such as bitmap (col. 1, ll. 41-56), (2) using the word processing program to create a document containing text (col. 1, ll. 58-63), and (3) pasting the data from the clipboard into the document at the desired

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mailed March 3, 2003.

locations, thereby embedding the data in the document, col. 1, l. 63 to col. 2, l. 3, for display as bitmap data. Col. 2, ll. 3-6.

The discussion of this prior-art embedding technique in the '701 patent does not identify the type of computer apparatus used. Although it is evident from the steps described in that discussion that they are performed using a single computer, the discussion does not indicate whether the single computer is a stand-alone computer or a network computer or can be either type of computer.

The Background's discussion of using prior-art linking techniques to create a compound document likewise is silent regarding the type of computer equipment used to practice that technique:

> Some prior systems store links to the data to be included in the compound document rather than actually embedding the data. When a word processing program pastes the data from a clipboard into a compound document, a link is stored in the compound document. The link points to the data (typically residing in a file) to be included. These prior systems typically provide links to data in a format that the word processing program recognizes or treats as a presentation format. For example, when the word processing program 206 is directed by the user to paste the scheduling data and budgeting data into the compound document by linking, rather than embedding, the names of files in which the scheduling data and budgeting data reside in presentation format are inserted into the document. Several compound documents can contain links to the same data to allow one copy of the data to be shared by several compound documents.

Col. 2, ll. 27-43. As with the discussion of the embedding technique, although it is evident that the steps of the linking technique are performed using a single computer, the discussion fails to explain whether the computer is a stand-alone

computer or a network computer or can be either type of computer. *A fortiori*, the discussion also fails to indicate that the linked files can reside elsewhere on a network.

For the foregoing reasons, we do not agree with the Examiner's finding conclusion that the Background discussion in the '701 patent specifically discloses a stand-alone computer environment.

The description of Appellants' own invention in the '701 patent similarly fails to explain (1) whether their invention is to be implemented by a stand-alone computer or a network computer or either type of computer and (2) whether, if performed on a network computer, the linked data files can reside elsewhere on the network. Appellants argue that these capabilities nevertheless are inherently satisfied by the disclosed invention because

> the specification describes an object-oriented implementation of OLE within a windowing environment such as the Windows 3.1 operating system. A person skilled in the technical field of OLE would have immediately appreciated that the object-oriented description of the invention contemplates a network environment. After all, it is beyond dispute that Windows 3.1 was famously network enabled, and that OLE technology was equally well-known for its network compatibility.

Req. Reh'g 8. As noted by Appellants, the discussion of OLE in the '701 patent is extensive, running from column 15, line 1, through column 66, line 41. The use of Windows 3.1 is discussed, for example, at column 12, lines 23-30; column 37, lines 12-27; and column 49, lines 24-29.

As evidence of OLE's networking capability, Appellants (Br. 38) rely on Chapter 9 ("Object Linking and Embedding") in *Windows Interface* and more particularly on the following discussion of the OLE concept of "Linking":

> When the user links information from a source document into a container document, the information appears inside the container as if it had been physically copied there. . . . Links provide an effective way for documents on a local drive or documents distributed over machines on a *network* to share information. . . . The user can link the summary lines (omitting the raw data) into an end-of-month document for the manager and link all the data over a *network* into a database at corporate headquarters.

Windows Interface at 169 (emphasis added.) In addition, Appellants quote the following passages from Paul Klemond, *Taking the Bull by the Horns: Investigating Object Linking and Embedding, Part I*, 7 Microsoft Systems Journal 19, 21 (Mar./Apr. 1992) (Br. Ex. I):

> • ***"Linking is particularly valuable when the linked-to document is shared on a network file server."***
>
> • "OLE's linked objects work with LAN-stored files transparently and seamlessly. This is ***because files on network drives are indistinguishable from files stored on local disk drives to the operating system."***
>
> • "In the linked object scenario described above, you created a linked object in the word processor document using schedule data from a spreadsheet. This is ***particularly powerful when the spreadsheet is stored on a file server*** and accessible to everyone ***across the network*** working on the project."

Br. 38 (Appellants' emphasis).

As evidence that Windows 3.1 was known to have a networking capability, Appellants rely on the definition of the Windows 3.1 "OpenFile" command from pages 731-33 of *Programmer's Reference*, which Appellants reproduce in part as follows:

> **OpenFile**
> . . . .
> Parameters *lpszFileName*
> Points to a null-terminated string that names the file to be opened. The string must consist of characters from the Windows character set and cannot contain wild cards.
> . . . .
> If the *lpszFileName* parameter specifies a filename and extension only (or if the OF SEARCH flag is specified), the **OpenFile** function searches for a matching file in the following directories (in this order):
> 1. The current directory.
> . . . .
> 6. *The list of directories mapped in a network.*

Req. Reh'g 10.

We agree with Appellants that a person having ordinary skill in the art relevant to the claimed invention is presumed to have been aware of the information contained in *Windows Interface* and *Programmer's Reference*. We also agree that the artisan in September 1996, the filing date of the application that matured into the '701 patent, therefore would have recognized that OLE and Windows 3.1 offered networking capabilities, including the use of a network computer to create documents linked to objects residing elsewhere on the network. In light of these

known networking capabilities and in the absence of evidence to the contrary, we further agree with Appellants that their application's silence regarding the type of computer to be used and the location of the linked files would have been understood to mean that Appellants did not view their invention as restricted to either stand-alone or network computers and contemplated (1) using either type of computer to practice their invention and (2) linking to files residing locally or elsewhere on a network.

D. Conclusion

The '701 patent, disregarding the material allegedly incorporated by reference, provides inherent written description support for the "network" limitations in Claim 40.

Issue 2 -- Does the '701 patent, including the material incorporated by reference therein, provide express written description support for the "network" limitations?

Our determination that the "network" limitations in Claim 40 have inherent written description support when the allegedly incorporated material is disregarded makes it unnecessary to decide whether those limitations alternatively have express written description support in the allegedly incorporated material.

Issue 3 -- Does the language "at least one client workstation coupled to said [computer] environment" in Claim 50 imply the presence of a network and thus stand or fall with the "network" language on the written description question?

The term "client" appears in the '701 patent; "workstation" does not. Appellants contend that the term "client workstation" in Claim 50 is broad enough to read on a stand-alone computer, whereas the Examiner has construed it as implying a network computer. *See* Final Action 7 "(The limitation 'client workstation,' defined as a computer that access[es] shared network resources provided by another computer (Microsoft Dictionary), is not supported by the original specification)." In addition, the Examiner has construed the phrase "at least one client workstation coupled to said [computer] environment" in Claim 50 as implying the presence of a network.

In view of our holding that the '701 patent provides inherent written description support for the "network" limitations, it is not necessary to decide whether the Examiner was correct to construe either of these phrases as limited to a network computer. The '701 patent supports these limitations whether or not they are construed as implying a network. For this reason, we are dismissing the appeal to the extent the new matter rejection of Claim 50 is based on the phrase "at least one client workstation coupled to said [computer] environment."

Attachment C to the Brief is a proposed amendment filed pursuant to 37 C.F.R. § 1.196(c)[15] to (1) amend claim 50 by changing "computer environment"

[15] 37 C.F.R. § 1.196(c) (2003), in effect when the Brief was filed, read as
(Continued on next page.)

to "Windows 3.1 operating system environment," changing "client workstation" to "computer," and changing "client workstation coupled to said environment" to "computer supporting said environment" and (2) adding new dependent claims 51-57 "in the event that the Board agrees with the examiner that the specification excludes a network environment **and** Claim 50 requires such an environment." Br. 41. Since at least the first of these contingencies has not

---

follows:

> (c) Should the decision of the Board of Patent Appeals and Interferences include an explicit statement that a claim may be allowed in amended form, appellant shall have the right to amend in conformity with such statement which shall be binding on the examiner in the absence of new references or grounds of rejection.

Effective September 13, 2004, this provision was replaced by 37 C.F.R. § 41.50(c), which currently reads:

> (c) The opinion of the Board may include an explicit statement of how a claim on appeal may be amended to overcome a specific rejection. When the opinion of the Board includes such a statement, appellant has the right to amend in conformity therewith. An amendment in conformity with such statement will overcome the specific rejection. An examiner may reject a claim so-amended, provided that the rejection constitutes a new ground of rejection.

Rules of Practice Before the Board of Patent Appeals and Interferences; Final Rule, 69 Fed. Reg. 49,960, 50,008 (Aug. 12, 2004), *reprinted in* 1286 Off. Gaz. Pat. & Trademark Office 21, 61 (Sept. 7, 2004).

occurred, we will not consider Appellants' invitation to state that the proposed new and amended claims would be allowable.

Issue 4 -- Do the terms "computer environment" and "hypermedia environment" in Claim 50, which are broad enough to encompass a stand-alone computer or a network computer, lack written description support to the extent they encompass a network computer?

The Examiner and Appellants appear to agree that the terms "computer environment" and "hypermedia environment" in claim 50 are broad enough to encompass a network computer or a stand-alone computer. The Examiner, citing *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1479-80, 45 USPQ2d 1498, 1503 (Fed. Cir. 1998), held that the '701 patent fails to provide written description support for these broad terms because it discloses only a stand-alone computer. Final Action 7-8; Answer 10-11. Because we do not agree that the '701 patent is limited to a stand-alone computer, which is the underlying premise of this rejection, we are reversing the new matter rejection of Claim 50 to the extent it is based on the "computer environment" and "hypermedia environment" limitations.

Issue 5 -- Does the '701 patent provide written description support for the phrase "a browser application" in Claims 40 and 50?

Claim 40 recites "a browser application, that parses a first distributed hypermedia document to identify text formats included in said distributed hypermedia document and for responding to predetermined text formats to initiate processing specified by said text formats." Claim 50 recites the same language minus the term "distributed." The Examiner has treated the question of whether there is support for the term "a browser application" as separate from the question

of whether there is support for the functions attributed to the browser application by the claims. Appellants do not disagree with the Examiner on this point. That is, they do not argue that the term "browser application" is defined by the functions attributed to it by the claims.

The Examiner found that the term "a browser application" would have been understood to be "a client application that enables the user to view HTML document[s] on the WWW [World Wide Web] or another network (Microsoft Press)." Final Action at 7; Answer at 10. We presume this reference to "Microsoft Press" is to *1997 Microsoft Dictionary*, on which the April 26, 2001, Office action relies for definitions of "network," "network sever," and "server." That dictionary at page 64 (copy enclosed) defines "browser" as "*See* Web browser" and at page 505 defines "Web browser" as follows:

> **Web browser** . . . *n.* A client application that enables a user to view HTML documents on the World Wide Web, another network, or the user's computer; follow the hyperlinks among them; and transfer files. . . .

1997 Microsoft Dictionary at 505 (copy enclosed). The publication date of this edition of the dictionary is unclear. An August 15, 1997, product announcement from Microsoft indicates that the dictionary "is available now in bookstores." *See* http://www.microsoft.com/presspass/press/1997/aug97/dctnrypr.mspx (accessed April 12, 2007) (copy enclosed). In our view, this date is not sufficiently contemporary with the September 4, 1996, filing date of the '701 patent to prima facie establish that "browser" would have been understood at that time to be limited to a Web browser.

Likewise, Appellants are incorrect to rely on *Computer Desktop Encyclopedia* (The Computer Language Co., Inc., Point Pleasant, Pennsylvania ©1981-2000), which they assert defines "Browser" as "A program whose functions include looking through sets of data. See Web browser, microbrowser, class browser and browse." Br. 28 n.14.

As noted by Appellants, *1994 Microsoft Dictionary* contains no definition of "browser" but defines "browse" as follows:

> **browse** To scan a database or a list of files, either for a particular item or for anything that seems to be of interest; generally, an activity that implies observing, rather than changing, information.
>
> In unauthorized computer hacking, browsing is a (presumably) nondestructive means of finding out about an unknown computer after illegally gaining entry.

1994 Microsoft Dictionary at 54. In the absence of evidence that "browser" had a narrower meaning in September 1996, we agree with Appellants that a person having ordinary skill in the art at that time would have understood the term "browser application" to be broad enough to read on an application capable of performing any of the functions recited in the definition of "browse." Appellants, noting that Figures 3 and 4 of the '701 patent identify Word as the application that supports the compound document, contend that Word in 1994 was understood to provide a browsing function that satisfies the above definition of "browse." Br. 29. The Examiner does not appear to contend otherwise.

The new matter rejection is therefore reversed to the extent it is based on the phrase "a browser application" in Claims 40 and 50.

Issue 6 – Does the '701 patent disclose the "embed text format" recited in Claims 40 and 50?

Claims 40 and 50 require that the hypermedia document include "an embed text format, located at a first location in said first distributed hypermedia document, that specifies the location of at least a portion of an object external to the first distributed hypermedia document."

The term "embed text format" does not appear in the '701 patent and has not been shown (or even asserted) to have a special meaning in the art. As a result, we are construing the language at issue to be broad enough to read on any embedded information which performs the recited function. It would appear that when the compound document disclosed in the '701 patent includes a link to an object (e.g., an Excel object), the document necessarily contains embedded information that identifies the location of the object. Appellants (Br. 32) specifically read the claimed embed text format on handle 604 in data structure 601 (Figure 6), which presumably is embedded in the compound document. Data structure 601 contains "a class identifier 603, handle 604 to the storage for the object, and data 605 for tracking the state of the object." Col. 9, l. 58 to col. 10, l. 3. The Examiner held:

> A careful review of the specification fails to reveal any teaching related to the claimed limitation "an embedded [sic] text format". The data structure 601 of pointers, class ID, and handles is certainly not an embedded text format as argued by the appellants. More certainly, [it] is not an "embedded text format" which [is] "located at a first location in said first distributed hypermedia document," and which "specifies the location of at least a portion of an object external to the first distributed hypermedia environment" embodied in a "network environment" of claim 40 or similar recitation in claim 50 ([illegible] client workstation coupled to a computer environment, the client

> workstation executes [illegible] browser application that parses a hypermedia document to identify text format, etc...).

Answer 17 (emphasis omitted). The Examiner's position is not persuasive. His assertion that "[t]he data structure 601 of pointers, class ID, and handles is certainly not an embedded text format as argued by the appellants" (emphasis omitted) is not supported by any definition of "embed text format" relied on by the examiner that would preclude Appellants' reliance on handle 604 in data structure 601. The fact that the '701 patent does not employ the term "embed text format" is insufficient to establish a lack of descriptive support. *See Cordis Corp. v. Medtronic AVE, Inc.*, 339 F.3d 1352, 1364, 67 USPQ2d 1876, 1885 (Fed. Cir. 2003) ("The disclosure as originally filed does not . . . have to provide *in haec verba* support for the claimed subject matter at issue.") (citing *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1570, 39 USPQ2d 1895, 1904 (Fed. Cir. 1996)). To the extent the Examiner's position is based on the conclusion that the '701 patent fails to disclose using data structure 601 in a network environment, that conclusion is incorrect for the reasons given above in the discussion of the "network" limitations.

The new matter rejection is therefore reversed to the extent it is based on the "embed text format" limitation in Claims 40 and 50.

Issue 7 – Does the '701 patent disclose the "type information" in Claims 40 and 50?

Claims 40 and 50 further specify that the "object has type information associated with it to identify and locate an executable application external to the . . . hypermedia document."

Appellants contend that this limitation reads on the class identifier (CLASS_ID) in data structure 601, noting that the '701 patent explains that the "[t]he class identifier (CLASS_ID) is used to access the appropriate server application for the object (col. 10, ll. 4-6)" and that in the example of a Word compound document illustrated in Figures 3 and 4, CLASS_ID identifies Excel as the appropriate "server" application. Br. 33. The Examiner did not hold that CLASS_ID fails to "identify and locate an executable application external to . . . the hypermedia document," as required by the claims. Rather, he held that the '701 patent fails to describe using CLASS_ID in a network context: "the Class ID as relied upon by the appellants do not teach the object type information for identifying and locating an executable application in a 'distributed' or 'network' environment [as required] when the claims are considered as a whole." Answer 17. This conclusion is incorrect for the reasons given above in the discussion of the "network" limitations.

Accordingly, the new matter rejection is reversed to the extent it is based on the "type information" limitation in Claims 40 and 50.

Issue 8 – Does the '701 patent disclose using the browser application to perform the functions required of the browser application by Claims 40 and 50?

As explained above, the Examiner does not appear to dispute that Word is a "browser application" if, as we have held, that term is properly construed as broad enough to read on an application that performs any of the functions recited in the definition of "browse" in *1994 Microsoft Dictionary*.

Claim 40 specifies that the browser application "parses a first distributed hypermedia document to identity text formats included in said distributed hypermedia document and for responding to predetermined text formats to initiate processing specified by said text formats" and also that the

> embed text format is parsed by said browser to automatically invoke said executable application to execute on said client workstation in order to display said object and enable interactive processing of said object within a display area created at said first location within the portion of said first distributed hypermedia document being displayed in said first browser-controlled window.

Claim 50 recites the same language minus the term "distributed."

The Examiner, after holding that "the specification shows that the embedded containee object is manually selected by the user (7:53-59; 8:15-18), and in response to user selection, the Word program determines which application is the server application for the containee and launches that application (7:55-59; 8:18-20)," Answer 16, provided the following discussion of the foregoing claim limitations, which is unclear because it addresses those claim limitations collectively rather than separately and also seems to rely on the "network" language and the other language (namely, "at least one client workstation coupled to said [computer] environment") the Examiner has construed as implying a network:

> Clearly, the portions of the specification the appellants relied upon do not teach a "browser application" (executed by a client workstation that [is] coupled to a computer environment) that "parses" a first hypermedia document "to identify text format[s]" included in the hypermedia document, and for "responding to predetermined text formats to initiate processing specified by said text format[s]," as recited in the claim. Figure 6, as described in col. 9, line 53 – col. 10,

> line 43, is a block diagram of a sample instance of a linked object. Figure 6 provides no teaching of a browser application (that [is] executed by a client workstation that [is] coupled to a computer environment) that "parses" a first hypermedia document "to identify text format[s]" included in the hypermedia document, and for "responding to predetermined text formats to initiate processing specified by said text format, utilizing said browser to display, on said client workstation, at least a portion of a first hypermedia document received over said network from said server (claim 40, lines 10-11) or "utilizing said browser to display, on said client workstation, at least a portion of a first hypermedia document" and "browser controlled window" (claim 50, lines 8-9, 11, 24) as recited.

Answer 16-17 (emphasis omitted). Because the Examiner has not sufficiently explained why he believes the functions required of the browser application lack written description support even if, as we have held, the "network" and "browser application" limitations do have such support, we are reversing the new matter rejection to the extent it is based on those functions.

As a result, the new matter rejection of Claims 40-50 is reversed in its entirety.

Issue 9 -- Is the '701 patent disclosure non-enabling with respect to the limitations that allegedly lack written description support?

A specification is enabling if it teaches those skilled in the art how to make and use the full scope of the claimed invention without "undue experimentation." *In re Wright*, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). The initial burden on the issue of enablement rests on the Examiner:

> When rejecting a claim under the enablement requirement of section 112, the PTO bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of

> protection provided by that claim is not adequately enabled by the description of the invention provided in the specification of the application . . . . If the PTO meets this burden, the burden then shifts to the applicant to provide suitable proofs indicating that the specification is indeed enabling. [*In re*] *Marzocchi*, 439 F.2d [220,] 223-24, 169 USPQ [367,] 369-70 [(CCPA 1971)].

Wright, 999 F.2d at 1561-62, 27 USPQ2d at 1513. The Examiner explained the rationale for the rejection as follows:

> The applicants did not even disclose or suggest, explicitly or implicitly, any teaching related to [a] network environment, or distributed hypermedia, hyperlink, network server, or network browser for parsing of format text in a distributed hypermedia document. Thus even if one of skill in the art is fully aware of [illegible, the networking?] aspect and functionality of OLE as argued by the applicants, [the] lack[] of any teaching or suggestion related to network environment does not warrant the appellants' allegation of possession of the invention as claimed, and it would not enable one of ordinary skill in the art to make and use the applicants' teaching of in-place interaction with containee objects in a network environment as recited in claims 40-50 without an undue experimentation.

Answer 19. This rejection is being reversed because it is based solely on the Examiner's incorrect conclusion that the '701 patent fails to disclose a network environment. The Examiner has not explained why the claimed subject matter is not enabled even assuming the "network" limitations have written description support.

Issue 10 -- Do the amendments to the specification of the reissue application and the proposed new drawings 57-91 contain new matter?

In view of our holding that the '701 patent provides inherent written description support for the "network" and "browser application" limitations without regard to the subject matter allegedly incorporated by reference from *Windows Interface* and *Programmer's Reference*, we are also reversing the objections under 35 U.S.C. § 251 to the specification and proposed new drawings 57-91.

DECISION

The rejection of Claims 40-50 for failing to satisfy the written description requirement of 35 U.S.C. § 112, first paragraph, is reversed, as is the rejection of those claims for failing to satisfy the enablement requirement of § 112, first paragraph.

The Examiner's objections to the specification and proposed new drawing Figures 57-91 under 35 U.S.C. § 251 are reversed.

The appeal is dismissed with respect to the Examiner's objection to Claims 40-50 under 37 C.F.R. § 1.75(d).

Appellants are advised that the determinations made on the written description support issue in this *ex parte* proceeding will not be binding in a subsequent *inter partes* interference proceeding. *Holmes v. Kelly*, 586 F.2d 234, 236, 199 USPQ 778, 781 (CCPA 1978) (citing *Sze v. Bloch*, 458 F.2d 137, 173 USPQ 498 (CCPA 1972)).

REVERSED

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Enclosures:

(a) *Microsoft Press Computer Dictionary* 278 (2d ed. 1994).

(b) *Microsoft Press Computer Dictionary* 64, 505 (3d ed. 1997).

(c) http://www.microsoft.com/presspass/press/1997/aug97/dctnrypr.mspx (accessed on April 12, 2007).

563 PH Ex. 2

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UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Interference No. 105,563 McK
Technology Center 2100

MICHAEL D. **DOYLE,** DAVID C. MARTIN and CHEONG S. ANG,

Patent 5,838,906,
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v.

SRINIVASA R. **KOPPOLU**, C. DOUGLAS HODGES,
BARRY B. MacKICHAN, RICHARD McDANIEL,
RAO V. REMALA and ANTONY S. WILLIAMS,

Application 09/442,070,
Senior Party

DOYLE ANNOTATED COPY OF CLAIMS

Pursuant to Bd.R. 110(b) and SO ¶ 110, party Doyle submits the following annotated copy of its involved claims:

1. A method for running an application program **{ Fig. 5, item 210 }** in a computer network environment **{ Fig. 5, item 206 }**, comprising:

providing at least one client workstation **{ Fig. 5, item 200 }** and one network server **{ Fig. 5, item 204 }** coupled to said network environment **{ Fig. 5, item 206 }**, wherein said network environment **{ Fig. 5, item 206 }** is a distributed hypermedia environment **{ Fig. 2, item 100 }**;

executing, at said client workstation **{ Fig. 5, item 200 }**, a browser application **{ Fig. 5, item 208 }**, that parses **{ Fig. 7A, step 256 }** a first distributed hypermedia document **{ Fig. 5, item 212 }** to identify text formats **{ Fig. 5, item 214 }** included in said distributed hypermedia document **{ Fig. 5, item 212 }** and for responding to predetermined text formats **{ Fig. 5, item 214 }** to initiate processing specified by said text formats **{ Fig. 5, item 214 }**; utilizing said browser **{ Fig. 5, item 208 }** to display, on said client workstation **{ Fig. 5, item 200 }**, at least a portion of a first hypermedia document **{ Fig. 5, item 212 }** received over said network **{ Fig. 5, item 206 }** from said server **{ Fig. 5, item 204 }**, wherein the portion of said first hypermedia document **{ Fig. 5, item 212 }** is displayed within a first browser-controlled window **{ Fig. 9, item 350 }** on said client workstation **{ Fig. 5, item 200 }**, wherein said first distributed hypermedia document **{ Fig. 5, item 212 }** includes an embed text format **{ Fig. 5, item 214 }**, located at a first location in said first distributed hypermedia document **{ Fig. 5, item 212 }**, that specifies the location of at least a portion of an object **{ Fig. 5, item 216 }** external to the first distributed hypermedia document **{ Fig. 5, item 212 }**, wherein said object **{ Fig. 5, item 216 }** has type information associated with it utilized by said browser **{ Fig. 5, item 208 }** to identify and locate an executable application **{ Fig. 5, item 210 }** external to the first distributed hypermedia document **{ Fig. 5, item 212 }**, and wherein said embed

text format **{ Fig. 5, item 214 }** is parsed **{ Fig. 7A, step 256 }** by said browser **{ Fig. 5, item 208 }** to automatically invoke **{ Fig. 8A, step 290}** said executable application **{ Fig. 5, item 210 }** to execute on said client workstation **{ Fig. 5, item 200 }** in order to display said object **{ Fig. 5, item 216 }** and enable interactive processing of said object **{ Fig. 5, item 216 }** within a display area created at said first location within the portion of said first distributed hypermedia document **{ Fig. 5, item 212 }** being displayed in said first browser-controlled window **{ Fig. 9, item 350 }**.

2. The method of claim 1, wherein said executable application **{ Fig. 5, item 210 }** is a controllable application **{ Fig. 5, item 210 }** and further comprising the step of:

interactively controlling said controllable application **{ Fig. 5, item 210 }** on said client workstation **{ Fig. 5, item 200 }** via inter-process communications **{ Fig. 5, arrow pointing to items 208 and 210 }** between said browser **{ Fig. 5, item 208 }** and said controllable application **{ Fig. 5, item 210 }**.

3. The method of claim 2, wherein the communications **{ Fig. 5, arrow pointing to items 208 and 210 }** to interactively control said controllable application **{ Fig. 5, item 210 }** continue to be exchanged between the controllable application **{ Fig. 5, item 210 }** and the browser **{ Fig. 5, item 208 }** even after the controllable application program **{ Fig. 5, item 210 }** has been launched.

4. The method of claim 3, wherein additional instructions for controlling said controllable application **{ Fig. 5, item 210 }** reside on said network server **{ Fig. 5, item 204 }**, wherein said step of interactively controlling said controllable application **{ Fig. 5, item 210 }** includes the following substeps:

issuing, from the client workstation **{ Fig. 5, item 200 }**, one or more commands to the network server **{ Fig. 5, item 204 }**;

executing, on the network server **{ Fig. 5, item 204 }**, one or more instructions in response to said commands;

sending information from said network server **{ Fig. 5, item 204 }** to said client workstation **{ Fig. 5, item 200 }** in response to said executed instructions; and processing said information at the client workstation **{ Fig. 5, item 200 }** to interactively control said controllable application **{ Fig. 5, item 210 }**.

5. The method of claim 4, wherein said additional instructions for controlling said controllable application **{ Fig. 5, item 210 }** reside on said client workstation **{ Fig. 5, item 200 }**.

6. A computer program product for use in a system having at least one client workstation **{ Fig. 5, item 200 }** and one network server **{ Fig. 5, item 204 }** coupled to said network environment **{ Fig. 5, item 206 }**, wherein said network environment **{ Fig. 5, item 206 }** is a distributed hypermedia environment **{ Fig. 2, item 100 }**, the computer program product comprising:

a computer usable medium **{ Fig. 3, items 181 and 186}** having computer readable program code physically embodied therein, said computer program product further comprising:

computer readable program code for causing said client workstation **{ Fig. 5, item 200 }** to execute a browser application **{ Fig. 5, item 208 }** to parse **{ Fig. 7A, step 256 }** a first distributed hypermedia document **{ Fig. 5, item 212 }** to identify text formats **{ Fig. 5, item 214 }** included in said distributed hypermedia document **{ Fig. 5, item 212 }** and to respond to predetermined text formats **{ Fig. 5, item 214 }** to initiate processes specified by said text formats **{ Fig. 5, item 214 }**;

computer readable program code for causing said client workstation **{ Fig. 5, item 200 }** to utilize said browser **{ Fig. 5, item 208 }** to display, on said client workstation **{ Fig. 5, item 200 }**, at least a portion of a first hypermedia document **{ Fig. 5, item 212 }** received over said network **{ Fig. 5, item 206 }** from said server **{ Fig. 5, item 204 }**, wherein the portion of said first

hypermedia document **{ Fig. 5, item 212 }** is displayed within a first browser-controlled window **{ Fig. 9, item 350 }** on said client workstation **{ Fig. 5, item 200 }**, wherein said first distributed hypermedia document **{ Fig. 5, item 212 }** includes an embed text format **{ Fig. 5, item 214 }**, located at a first location in said first distributed hypermedia document **{ Fig. 5, item 212 }**, that specifies the location of at least a portion of an object **{ Fig. 5, item 216 }** external to the first distributed hypermedia document **{ Fig. 5, item 212 }**, wherein said object **{ Fig. 5, item 216 }** has type information associated with it utilized by said browser **{ Fig. 5, item 208 }** to identify and locate an executable application **{ Fig. 5, item 210 }** external to the first distributed hypermedia document **{ Fig. 5, item 212 }**, and wherein said embed text format **{ Fig. 5, item 214 }** is parsed **{ Fig. 7A, step 256 }** by said browser **{ Fig. 5, item 208 }** to automatically invoke **{ Fig. 8A, step 290}** said executable application **{ Fig. 5, item 210 }** to execute on said client workstation **{ Fig. 5, item 200 }** in order to display said object **{ Fig. 5, item 216 }** and enable interactive processing of said object **{ Fig. 5, item 216 }** within a display area created at said first location within the portion of said first distributed hypermedia document **{ Fig. 5, item 212 }** being displayed in said first browser-controlled window **{ Fig. 9, item 350 }**.

7. The computer program product of claim 6, wherein said executable application **{ Fig. 5, item 210 }** is a controllable application **{ Fig. 5, item 210 }** and further comprising:

computer readable program code for causing said client workstation **{ Fig. 5, item 200 }** to interactively control said controllable application **{ Fig. 5, item 210 }** on said client workstation **{ Fig. 5, item 200 }** via inter-process communications **{ Fig. 5, arrow pointing to items 208 and 210 }** between said browser **{ Fig. 5, item 208 }** and said controllable application **{ Fig. 5, item 210 }**.

8. The computer program product of claim 7, wherein the communications **{ Fig. 5, arrow pointing to items 208 and 210 }** to interactively control said controllable application **{**

Fig. 5, item 210 } continue to be exchanged between the controllable application **{ Fig. 5, item 210 }** and the browser **{ Fig. 5, item 208 }** even after the controllable application program **{ Fig. 5, item 210 }** has been launched.

9. The computer program product of claim 8, wherein additional instructions for controlling said controllable application **{ Fig. 5, item 210 }** reside on said network server **{ Fig. 5, item 204 }**, wherein said step of interactively controlling said controllable application **{ Fig. 5, item 210 }** includes:

computer readable program code for causing said client workstation **{ Fig. 5, item 200 }** to issue, from the client workstation **{ Fig. 5, item 200 }**, one or more commands to the network server **{ Fig. 5, item 204 }**;

computer readable program code for causing said network server **{ Fig. 5, item 204 }** to execute one or more instructions in response to said commands;

computer readable program code for causing said network sever to send information to said client workstation **{ Fig. 5, item 200 }** in response to said executed instructions; and

computer readable program code for causing said client workstation **{ Fig. 5, item 200 }** to process said information at the client workstation **{ Fig. 5, item 200 }** to interactively control said controllable application **{ Fig. 5, item 210 }**.

10. The computer program product of claim 9, wherein said additional instructions for controlling said controllable application **{ Fig. 5, item 210 }** reside on said client workstation **{ Fig. 5, item 200 }**.

Dated: July 3, 2007

Respectfully submitted,

By: /s/ Barry E. Bretschneider___
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563 PH Ex. 3

Paper No. _____

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Date Filed: September __, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Interference No. 105,563 McK
Technology Center 2100

MICHAEL D. **DOYLE,** DAVID C. MARTIN and CHEONG S. ANG,

Patent 5,838,906,
Junior Party,

v.

SRINIVASA R. **KOPPOLU**, C. DOUGLAS HODGES,
BARRY B. MacKICHAN, RICHARD McDANIEL,
RAO V. REMALA and ANTONY S. WILLIAMS,

Application 09/442,070,
Senior Party

SUBMISSION OF SETTLEMENT AGREEMENTS

Pursuant to Bd. R. 205(a) and SO 205, and in accordance with Paper No. 37, on behalf of the parties Doyle submits herewith copies of the agreements executed by the real parties in interest in this interference in connection with the termination of this interference. The undersigned certifies that he has served a copy of this submission electronically upon lead counsel for Koppolu, Mr. Huntington. Doyle submits the agreements in a separate sealed envelope.

Pursuant to Bd. R. 205(c) and (d) the parties request that these agreements be kept separate from the interference file and not be disclosed to any person or party other than a Government agency except upon petition and a showing of good cause.

In light of the foregoing, Doyle respectfully requests that these settlement agreements be accepted and remain separate from the file of this interference.

Should a petition for access be filed in accordance with Bd. R. 205(d), the parties respectfully requested that the following be contacted for inquiry and before a decision is made with respect to such petition:

For Microsoft Corporation:

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For The Regents of the University of California and Eolas Technologies Inc.:

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Dated: September 19, 2007

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563 PH Ex. 4

Paper No. ____

Filed on behalf of: Senior Party **KOPPOLU**

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UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Interference 105,563 McK
Technology Center 2100

MICHAEL D. **DOYLE**, DAVID C. MARTIN
and CHEONG S. ANG,

Patent 5,838,906,
Junior Party,

v.

SRINIVASA R. **KOPPOLU**, C. DOUGLAS HODGES,
BARRY B. MacKICHAN, RICHARD McDANIEL,
RAO V. REMALA and ANTONY S. WILLIAMS,

Application 09/442,070,
Senior Party,

KOPPOLU REQUEST FOR ADVERSE JUDGMENT

MAIL STOP INTERFERENCE
Board of Patent Appeals and Interferences
United States Patent and Trademark Office
600 Dulany Street, 9th Floor
Madison Building East
Alexandria, Virginia 22314

Your Honor:

Senior Party Koppolu, pursuant to 37 C.F.R. §§ 41.127(b) and 41.205(a), requests and agrees to entry of adverse judgment against Koppolu et al. with respect to Count 1 and Count 2 of this interference.

Respectfully submitted,

By: /William N. Hughet, Esq./
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William N. Hughet, Esq.
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563 PH Ex. 5

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Paper 41
Entered: 25 September 2007

UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Interference 105,563 McK
Technology Center 2100

MICHAEL D. **DOYLE**, DAVID C. MARTIN
and CHEONG S. ANG,

Patent 5,838,906,
Junior Party,

v.

SRINIVASA R. **KOPPOLU**, C. DOUGLAS HODGES,
BARRY B. MacKICHAN, RICHARD McDANIEL,
RAO V. REMALA and ANTONY S. WILLIAMS,

Application 09/442,070,
Senior Party.

Before: FRED E. McKELVEY, *Senior Administrative Patent Judge*, and RICHARD E. SCHAFER and JAMES T. MOORE, *Administrative Patent Judges*.

McKELVEY, *Senior Administrative Patent Judge*.

JUDGMENT

Upon consideration of KOPPOLU REQUEST FOR ADVERSE JUDGMENT (Paper 39), it is

ORDERDED that judgment on priority as to Counts 1 and 2 (the only counts in the interference; Paper 1, pages 9 and 13) is awarded

against Senior Party SRINIVASA R. KOPPOLU, C. DOUGLAS HODGES, BARRY B. MacKICHAN, RICHARD McDANIEL, RAO V. REMALA and ANTONY S. WILLIAMS.

FURTHER ORDERED that Senior Party SRINIVASA R. KOPPOLU, C. DOUGLAS HODGES, BARRY B. MacKICHAN, RICHARD McDANIEL, RAO V. REMALA and ANTONY S. WILLIAMS is not entitled to a patent containing claims 40-44 and 50 (corresponding to Count 1) or claims 45-49 (corresponding to Count 2) of:

application 09/442,070,
filed 16 November 1999
to reissue U.S. Patent 5,801,701,
issued 01 September 1998.

FURTHER ORDERED that KOPPULO MOTION 2 (for judgment based on alleged inequitable conduct on the part of Doyle) (Paper 35) is *dismissed* as moot.

FURTHER ORDERED that if there is any further settlement agreement in addition to the agreement already made of record, attention is directed to 35 U.S.C. § 135(c).

FURTHER ORDERED that a copy of this JUDGMENT shall be placed in the files of (1) Doyle U.S. Patent 5,838,906, (2) Koppulo U.S. Patent 5,801,701, and (3) Koppulo reissue application 09/442,070.

FURTHER ORDERED that the Clerk is directed to distribute the files upon entry of this JUDGMENT.

cc (via Electronic mail):

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(real party in interest
The Regents of the University of California):

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