

Commissioner's Decision No. 1435
Décision du commissaire n° 1435

TOPIC: O-00 Obviousness

SUJET: O-00 Évidence

Application No. 2 446 455
Demande n° 2 446 455

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 2 446 455, having been rejected under subsection 30(3) of the *Patent Rules*, has subsequently been reviewed in accordance with paragraph 30(6)(c) of the *Patent Rules*. The recommendation of the Patent Appeal Board and the decision of the Commissioner are to refuse the application.

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INTRODUCTION

- [1] This recommendation concerns the review of rejected patent application number 2 446 455, which is entitled “Carrier and package delivery desktop tools”. The patent application is owned by United Parcel Service of America, Inc. The issue is whether the subject-matter defined by the claims on file would not have been obvious, as required by paragraph 28.3(b) of the *Patent Act*. The Patent Appeal Board (the Board) has reviewed the rejected application pursuant to paragraph 30(6)(c) of the *Patent Rules*. As explained below, our recommendation is to refuse the application.

BACKGROUND

The application

- [2] Patent application 2 446 455 was filed in Canada on May 8, 2002 and published November 14, 2002.
- [3] The invention relates to desktop tools for reducing the manual steps involved in the retrieval of parcel shipping data via the Web and its insertion into a document. A user selects a text string in the document (or the text string is automatically recognized) and the user selects an action to be performed. Depending on the selected action, a message based on the selected text string is automatically generated and sent to the carrier’s server, where a shipping database is accessed and a return message is generated and sent to the user’s computer. The user’s computer receives and parses the message, and displays the parsed result or inserts it into the document.

Prosecution history

- [4] On December 12, 2014, a Final Action (FA) was written pursuant to subsection 30(4) of the *Patent Rules*. The FA stated that the application is defective by way of the claims on file (i.e. claims 1 to 15) not complying with section 28.3 of the *Patent Act*.
- [5] In a June 10, 2015 response to the FA (R-FA), the Applicant submitted arguments for allowance. In particular, the Applicant contended that the claims on file are not obvious in view of the references cited in the FA.
- [6] As the Examiner considered the application not to comply with the *Patent Act*, the application was forwarded to the Board for review on November 4, 2015, pursuant to subsection 30(6) of the *Patent Rules*, along with a Summary of Reasons (SOR) maintaining the rejection of the application based on the defects indicated by the FA.

- [7] With a letter dated November 9, 2015, the Board forwarded the Applicant a copy of the SOR and offered the Applicant the opportunities to make further written submissions and to attend an oral hearing. In its letter dated January 29, 2016, the Applicant responded with a further submission regarding obviousness and declined the opportunity for a hearing, requesting the review to proceed based on the current written record.
- [8] This Panel was formed to review the application under paragraph 30(6)(c) of the *Patent Rules* and make a recommendation to the Commissioner as to its disposition. In a letter dated May 19, 2017 (the Panel Letter), we set out our preliminary analysis and rationale as to why, based on the record before us, the subject-matter of the claims on file does not comply with paragraph 28.3(b) of the *Patent Act*.
- [9] On June 19, 2017, the Applicant acknowledged receipt of the Panel Letter but stated that it was not filing any further submissions.

ISSUE

- [10] The issue to be resolved by this review is whether the claims on file define subject-matter that would not have been obvious, thus complying with paragraph 28.3(b) of the *Patent Act*.

LEGAL PRINCIPLES AND OFFICE PRACTICE

Obviousness

- [11] Section 28.3 of the *Patent Act* requires that claimed subject-matter not be obvious:

The subject-matter defined by a claim in an application for a patent in Canada must be subject-matter that would not have been obvious on the claim date to a person skilled in the art or science to which it pertains, having regard to

- (a) information disclosed more than one year before the filing date by the applicant, or by a person who obtained knowledge, directly or indirectly, from the applicant in such a manner that the information became available to the public in Canada or elsewhere; and
- (b) information disclosed before the claim date by a person not mentioned in paragraph (a) in such a manner that the information became available to the public in Canada or elsewhere.

- [12] In *Apotex v. Sanofi-Synthelabo Canada*, 2008 SCC 61 at paragraph 67 [*Sanofi*], the Supreme Court of Canada stated that it is useful in an obviousness inquiry to follow the following four-step approach:

- (1)(a) Identify the notional “person skilled in the art”;

- (b) Identify the relevant common general knowledge of that person;
- (2) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;
- (3) Identify what, if any, differences exist between the matter cited as forming part of the “state of the art” and the inventive concept of the claim or the claim as construed;
- (4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

ANALYSIS

Obviousness

(1)(a) and (b) Identify the notional person skilled in the art and the relevant common general knowledge

[13] In the Panel Letter, we identified the notional person skilled in the art as a team comprising one or more business professionals from fields related to parcel delivery and tracking services, as well as programmers experienced with developing and maintaining the tools and infrastructure for such professionals.

[14] The FA identified the following references as relevant prior art:

- D1: US 6 220 509 April 24, 2001 Byford
- D3: “Microsoft announces Smart Tag Software Development Kit (SDK) for Office XP”, *Press Release from Microsoft* (Redmond: Microsoft, February 21, 2001), online: Microsoft Announces Smart Tag Software Development Kit (SDK) For Office XP - News Center
<<https://news.microsoft.com/2001/02/21/microsoft-announces-smart-tag-software-development-kit-sdk-for-office-xp/#iPjiWkXLboziECPF.97>>.
- D4: “Microsoft” (Microsoft, April 9, 2001), archived online: Welcome to Microsoft's Homepage <<https://web-beta.archive.org/web/20010410152307/http://www.microsoft.com:80/>>.

[15] Based on these references, the identification of the common general knowledge (CGK) in the FA and the application’s description of conventional systems and commercially available software tools, we identified the following concepts as CGK in the Panel Letter:

- The procedures and tools typically involved in parcel delivery and tracking services;
- Conventional software tools for managing and using shipping parcel data;

- General-purpose computing devices and appropriate programming techniques;
- Use of Microsoft smart tags;
- Use of user identification, passwords and other security data to access secured data via a network;
- The fact that advantages can be seized by using computers, software, modern communications infrastructure, etc., to automate or facilitate steps in administrative procedures; and
- The automatic extraction of information from particular databases in response to an input operation.

[16] As mentioned above, the Applicant did not make any submission in response to the Panel Letter regarding this analysis. Accordingly, we adopt the above identification of the skilled person and CGK here.

(2) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it

[17] For convenience, claim 1 is provided below as a representative of the claims:

1. A system for obtaining shipping information associated with a parcel, comprising:
 - a computer in communication with a remote server and comprising a software application configured to:
 - recognize one or more predefined text strings that relate to shipping information for which one or more predefined actions can be invoked, including assessing at least certain of the shipping information at the server associated with the one or more recognized text strings, wherein the predefined text strings are located in an electronic file or document containing a plurality of text strings, and at least some of the text strings in the file or document are unrelated to shipping information for a parcel; and
 - in response to a user invoking one of the one or more predefined actions:
 - analyze text in the file or document;
 - identify from the text in the file or document the predefined text strings that relate to the shipping information associated with the user invoked one of the one or more predefined actions, the identification being based at least in part upon a parsing of the predefined text

strings that relate to the shipping information from the at least some of the text strings in the file or document that are unrelated to shipping information;

generate a request for shipping information associated with the parcel, said request being based on the identified text strings to be sent to the server in accordance with the invoked action, such that the shipping information associated with the parcel and based on the identified text strings can be retrieved from the remote server;

transmit the request, including each of the identified text strings, to the remote server;

receive from the remote server the shipping information associated with the parcel and based on the identified text strings;

parse the shipping information based on the invoked action; and

insert the parsed shipping information into the file or document.

[18] In the Panel Letter, we identified all 15 claims as sharing the same inventive concept, which is as follows:

A method for obtaining information from a remote source, comprising:

- recognizing, in an electronic file or document, a predefined or user-selected text string for which one or more predefined actions can be invoked, including accessing information associated with the text string at a remote server; and
- in response to a user invoking one of the one or more predefined actions:
 - generating a request to access the information from the server, said request being based on the text string;
 - transmitting the request, including the text string, to the server;
 - receiving from the server the information based on the text string;
 - parsing the information based on the invoked action; and
 - inserting the parsed information into the file or document.

[19] As explained in the Panel Letter, where the wording of this definition of the inventive concept varies from the wording of the above claim, it does so to simplify the definition and to more clearly align it with the invention disclosed by the description and drawings. For example, the above claim specifies the meaning of the information in the predefined or user-selected text strings (i.e. whether or not it

relates to shipping information) but the above definition of the inventive concept does not. The meaning of this information may have significance to the user working on the file or document, but has no material effect on the functioning of the computerized method recognizing the text strings and taking certain actions in response. Therefore, our view is that this detail is not part of the inventive concept.

- [20] The Applicant did not specifically dispute this identification of the inventive concept in its response to the Panel Letter, but some of its earlier arguments regarding the differences between the state of the art and the inventive concept suggest a different view. These are addressed below.

(3) Identify what, if any, differences exist between the matter cited as forming part of the “state of the art” and the inventive concept

- [21] As stated in the Panel Letter, D3 appears to be the most relevant cited reference.

- [22] D3 discloses the use of Microsoft’s “smart tag” software which, when implemented, will recognize a predefined text string in an electronic file or document and offer relevant options to the user by providing a menu of predefined actions. Two examples mentioned in D3 of such possible predefined actions are, upon recognition of an invoice number and subsequent invocation of the action by the user, to check the invoice status or visit the supplier website. Both of these actions involve the generation of a request to access information at a remote server. They can both be said to be based on the text string, as it is the recognition of the text string that prompted the presentation of selectable actions. Furthermore, checking the status of the invoice would require use of the text string representing the invoice number. Both actions also involve the return of the obtained information to the user, parsing it first for his or her perusal. D3 does not explicitly disclose the insertion of the parsed information into the file or document.

- [23] The R-FA had contended there is an additional difference:

Applicant wishes to further emphasize and highlight for the Examiner the way in which the invention as claimed identifies text strings associated with shipping information, namely, by parsing them from all text strings within the file, including those unrelated to shipping information. The cited references do not do this and the archived link further relied upon by the Examiner provides no additional details in this regard.

- [24] The SOR responded to this contention:

[T]he description as originally filed does not explicitly recite parsing text strings associated with shipping information from text within the file, including text strings unrelated to shipping information. More specifically, the description as

originally filed does not appear to address any text being unrelated to shipping information. This feature was added to the description on 10 December 2010. This feature was not considered to represent new matter, as it was considered that it would have been obvious to a person skilled in the art that the Microsoft Excel, Word or Outlook document (description – page 5, lines 5 to 7) could include any text in addition to the shipping information, and the method would still function in the same manner.

In order to parse the information, the present description specifies that one or more predefined or user-selected text strings that relate to shipping information are “recognized” (page 2, lines 13 to 19; see also page 5, lines 5 to 15) using Microsoft™ smart tags. Any additional or superfluous information that is present in the document is irrelevant, as it would not be “recognized” by the smart tags. [Emphasis in original.]

- [25] The Applicant repeated its arguments in its letter of January 29, 2016.
- [26] As we explained in the Panel Letter, the details referenced in the R-FA—an analysis of the file or document, after the user has invoked an action, to distinguish text related to shipping information from text unrelated to shipping information—cannot distinguish the inventive concept from the state of the art. These details are not part of the inventive concept identified above. According to the inventive concept—and to the description and drawings—the smart tag software is used to automatically recognize specific types of text strings in the file and present the user with specific options; when the user selects one of these options, the corresponding action is taken. As noted in the SOR, any additional information in the document beyond these specific types of text strings cannot be recognized by the smart tag software, and is thus irrelevant.
- [27] Accordingly, we consider the difference between the inventive concept and the use of the smart tag software disclosed by D3 to be the automatic insertion of the retrieved and parsed information into the file or document.

(4) Do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention

- [28] As noted above, conventional software tools for managing and using shipping parcel data are part of the CGK. This includes the manual administrative procedure described in the application and indicated by the FA:

The present application (page 1, lines 18 to 32) describes a prior art manual process where a user working on a spreadsheet document or word processor document identifies within the document a tracking number associated with a parcel for which the user wishes to obtain shipping information. The user then

requests shipping information at a remote server by typing or copying and pasting the tracking number into an appropriate web page. The shipping information is then displayed at the web server and the user may copy or paste some or all of the shipping information into the spreadsheet or word processor document (note: this method is also shown by D1).

- [29] Also noted above is that the CGK includes the automatic extraction of information from particular databases in response to an input operation and the knowledge that there are advantages to using computers to automate or facilitate the steps of a manual administrative procedure. We thus consider that the automatic parsing and inserting of retrieved information into a document would have been obvious to the person skilled in the art. We are also reinforced in this view by the lack of detail in the application (e.g. page 9) concerning how the automatic parsing and insertion are achieved. Such a lack suggests the implementation of the invention is within the CGK of the person skilled in the art.
- [30] Accordingly, we do not see the difference between the inventive concept and the state of the art as requiring any degree of invention.
- [31] For the reasons given above, we do not view the inventive concept as distinguishable over the prior art by the relation of the predefined text strings to shipping information, notwithstanding the Applicant's contentions in the R-FA and its letter of January 29, 2016. The inventive concept does not involve any analysis of the content of the document beyond the initial recognition of the predefined text string, wherein that recognition prompts the presentation of predefined user-selectable actions. Even if the intellectual meaning of the text strings (i.e. their relation to shipping information) were considered to represent a difference between the inventive concept and the state of the art, smart tag software was apparently intended to be commercially distributed as widely as possible and to be useful over a broad range of business applications. In our view, it therefore would have been obvious to the person skilled in the art to employ it in the processing of shipping information. D3 even gives as an example the use of an invoice number to check invoice status.
- [32] As remarked above, our view is that all 15 claims share the same inventive concept. Although there are variations in wording among the claims, these variations are not considered to add to or refine the inventive concept.
- [33] Even if these wording variations were considered to reflect refinements to the inventive concept, however, they would not have required any degree of invention. For example, independent claims 7 and 13 simply recite the software and method corresponding to the system of independent claim 1. Regarding dependent claims 2 to 6, 8 to 11 and 15, the CGK includes conventional tools for managing and using

shipping parcel data and this encompasses obtaining, using and managing such parcel shipping data as recited in these claims. Regarding dependent claims 12 and 14, the CGK includes use of user identification data to access secured data via a network.

Conclusions

- [34] The subject-matter of claims 1 to 15 would have been obvious to the person skilled in the art in view of the state of the art (as represented by D3) and the relevant CGK. Therefore, these claims do not comply with paragraph 28.3(b) of the *Patent Act*.

RECOMMENDATION OF THE BOARD

- [35] In view of the above, the Panel recommends that the application be refused on the basis that claims 1 to 15 define subject-matter that would have been obvious and thus do not comply with paragraph 28.3(b) of the *Patent Act*.

Leigh Matheson
Member

Ed MacLaurin
Member

Andrew Strong
Member

DECISION

- [36] I concur with the findings of the Board and its recommendation to refuse the application. The claims on file do not comply with paragraph 28.3(b) of the *Patent Act*.
- [37] Accordingly, I refuse to grant a patent for this application. Under section 41 of the *Patent Act*, the Applicant has six months to appeal my decision to the Federal Court of Canada.

Johanne Bélisle
Commissioner of Patents
Dated at Gatineau, Quebec,
this 13th day of December, 2017