

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAULA D. SCHUYLER,
DAVID E. STONE,
and MARISA S. TARA

Appeal No. 2001-1461
Application 08/921,130¹

ON BRIEF

Before BARRETT, GROSS, and SAADAT, Administrative Patent Judges.
BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 1-9, 11, 12, and 14-25, all the claims pending in the application. Claims 10 and 13 have been canceled.

We reverse.

¹ Application for patent filed August 29, 1997, entitled "Method and System of Routing Requests for Authorized Approval."

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BACKGROUND

The invention relates to a method and system of routing requests for authorized approval.

Claim 1 is reproduced below.

1. An automated method for authorized approval processing, comprising the steps of:

receiving from a user a request for approval;

in response to receiving the request, automatically determining a type of the request;

automatically determining a designated number of approvals required for authorization of the request based on the type of the request;

automatically determining a valid agent to provide one of the designated number of approvals required for authorization of the request;

automatically routing the request to the valid agent for the approval; and

automatically determining if the designated number of approvals required for authorization of the request have been obtained.

The examiner relies on the following reference:

Gardner et al. (Gardner) 5,758,327 May 26, 1998

Claims 1-4, 6-9, 11, 12², and 14-25 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Gardner.

² Claim 12 is improperly included in the grouping of claims. Since claim 12 depends on claim 5, it cannot be rejected without rejecting claim 5. Accordingly, we put claim 12 in with the obviousness rejection of claim 5.

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Claims 5 and 12³ stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gardner.

We refer to the final rejection (Paper No. 7) (pages referred to as "FR__") and the examiner's answer (Paper No. 12) (pages referred to as "EA__") for a statement of the examiner's rejection, and to the brief (Paper No. 11) (pages referred to as "Br__") and reply brief (Paper No. 13) (pages referred to as "RBr__") for a statement of appellants' arguments thereagainst.

OPINION

"Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention." RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). Inherency requires that a characteristic or property necessarily be in the prior art reference. See In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) ("The mere fact that a certain thing may result from a given set of circumstances is not sufficient [to establish inherency])." The initial burden of establishing a prima facie case of inherency by evidence or persuasive reasoning is on the examiner. See In re Schreiber, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997).

³ See footnote 2.

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The relevant contents of Gardner are adequately summarized by appellants (Br6-7).

Appellants argue that Gardner discloses only a single type of request and therefore does not teach: (1) "automatically determining a type of the request" and then "automatically determining a designated number of approvals required for authorization of the request based on the type of the request" (emphasis added), as recited in claim 1 (Br7); (2) "automatically determining a type of the request" and then "automatically interrogating a set of rules based on the type of the request, to determine approval processing information for authorization of the request" (emphasis added), as recited in claim 16 (Br8); and (3) "the workflow engine further operable to determine a type of the request" and "a validation module operable to determine a designated number of approvals required for authorization of the request based on the type of the request" (emphasis added), as recited in claim 19 (Br8).

The examiner refers, without explanation, to column 6, lines 27-42, column 7, lines 53-57 (FR3; FR5; EA4; EA6), and column 7, lines 49-63 (FR6; EA7). In the Response to Arguments section of the examiner's answer, the examiner states (EA10):

Gardner clearly recites in col. 7, lines 12-43 of a purchase request to be approved by a company or a division. The company or division in Gardner is equivalent to the claimed "type of request" and that once the system determines the company or division then it applies the rules for that particular company or division.

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This is the first time the examiner explains why Gardner is thought to anticipate the "type of request" limitations.

Appellants respond that "the companies referred to in Gardner are vendors offering items for sale to a requestor" (RBr3) and "Appellant respectfully submits that the company or division of a company is not equivalent to determining the 'type of the request'" (RBr3).

Gardner states that "the rule base 60 determines variations based upon the requester" (col. 7, lines 63-64) which implies that system determines which of the companies 12, 14, and 16 in Fig. 1 is making the request. The examiner interprets the "type of the request" as equivalent to the identity of the requester company. However, we consider this an unreasonable claim interpretation because it does not give words their ordinary meaning. A "type of request" is not the same thing as the "identity of the requester." Gardner is directed toward a single type of request, a requisition for the procurement of goods and/or services (col. 1, lines 12-15), which may come from many different companies. Thus, Gardner does not disclose determining a "type of the request" or determining approval processing "based on the type of the request" and does not anticipate claims 1, 16, or 19. While appellant argues other differences, this difference is enough to establish lack of anticipation. The obviousness rejection of claims 5 and 12 does not cure the

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deficiencies with respect to claims 1, 16, and 19. The
rejections of claims 1-9, 11, 12, and 14-25 are reversed.

REVERSED

LEE E. BARRETT)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
ANITA PELLMAN GROSS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
MAHSHID D. SAADAT)	
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