

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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID JOSEPH MISHESKI and CLIFTON MALCOLM NOCK

Appeal No. 2002-0592
Application No. 09/107,090

ON BRIEF

Before THOMAS, DIXON, and BLANKENSHIP, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3-21, and 23-27, which are all of the claims pending in this application. Claims 2 and 22 have been canceled.

We REVERSE.

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Appellants' invention relates to a object oriented framework mechanism for data transfer between a data source and a data target. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. An apparatus comprising:

at least one processor;

a memory coupled to the at least one processor; and

an object-oriented framework mechanism residing in the memory and executed by the at least one processor, the framework mechanism providing a user-extensible data transfer mechanism that transfers data from a data source to a data target according to portions of the framework mechanism that are extended by a user, wherein the framework mechanism comprises a user-extensible place class, the place class defining:

at least one place object corresponding to the data source;

at least one place object corresponding to the data target; and

a first set of object methods to transfer the data from the data source to the data target, at least one of the first set of object methods being extensible by a user.

The prior art of record relied upon by the examiner in rejecting the appealed claims are as follows:

Chow et al. (Chow)

5,642,511

Jun. 24, 1997

Jordan et al. (Jordan), citation from website

.java.sun.com/research/forest/COM.Sun.Labs.Forest.doc.cootx_95.paper_pdf.pdf, last updated 9 Sep 1996

Diwanji et al. (Diwanji), citation from website

.java.sun.com/javaone/javaone96/pres/NetApps.pdf, last updated 28 May 1996

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Claims 1, 3-21, and 23-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chow in view of Jordan and Diwanji.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's final rejection (Paper No. 10, mailed Nov. 1, 2000) and the examiner's answer (Paper No. 13, mailed Jul. 2, 2001) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 12, filed Apr. 5, 2001) and reply brief (Paper No. 14, filed Aug. 27, 2001) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Appellants argue that the examiner has not established a *prima facie* case of obviousness and that none of the prior art references applied against the claims teaches or fairly suggests a framework mechanism providing a user extensible data transfer mechanism that transfers data from a data source to a data target. The framework mechanism comprising a user extensible place class, the place class defining at least one place class object corresponding to the data source; at least one

place object corresponding to the data target; and a first set of object methods to transfer the data from the data source to the data target, at least one of the first set of object methods being extensible by a user, as recited in independent claim 1. (See brief at pages 3-6.) Additionally, appellants question the examiner's statement of the rejection in the final rejection with respect to what "mechanism for such an object oriented framework" the examiner refers to and appellants request clarification. (See brief at pages 4-5.) We agree with appellants that the examiner's statement of the rejection in the final rejection and incorporated into the answer, is unclear as to what "mechanism" the examiner refers to. From our review of the answer, we find that the examiner merely incorporates the statement of the rejection and proceeds to ramble on about the word "defining" and NEVER addresses the request for clarification of the statement of the rejection and NEVER addresses appellants' arguments directly.

It is an essential prerequisite that the claimed subject matter be fully understood. Analysis of whether a claim is patentable over the prior art under 35 U.S.C. §§ 102 and 103 begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the language of the claim itself. **See Smithkline Diagnostics, Inc. v. Helena Laboratories Corp.**, 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988). Accordingly, we will initially direct our attention to appellants' claim to derive an understanding of the scope and content thereof.

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Before turning to the proper construction of the claims, it is important to review some basic principles of claim construction. First, and most important, the language of the claim defines the scope of the protected invention. **Yale Lock Mfg. Co. v. Greenleaf**, 117 U.S. 554, 559 (1886) ("The scope of letters patent must be limited to the invention covered by the claim, and while the claim may be illustrated it cannot be enlarged by language used in other parts of the specification."); **Autogiro Co. of Am. v. United States**, 384 F.2d 391, 396, 155 USPQ 697, 701 (Ct. Cl. 1967) ("Courts can neither broaden nor narrow the claims to give the patentee something different than what he has set forth [in the claim]."). **See also Continental Paper Bag Co. v. Eastern Paper Bag Co.**, 210 U.S. 405, 419 (1908); **Cimiotti Unhairing Co. v. American Fur Ref. Co.**, 198 U.S. 399, 410 (1905). Accordingly, "resort must be had in the first instance to the words of the claim" and words "will be given their ordinary and accustomed meaning, unless it appears that the inventor used them differently." **Envirotech Corp. v. Al George, Inc.**, 730 F.2d 753, 759, 221 USPQ 473, 477 (Fed. Cir. 1984). Second, it is equally "fundamental that claims are to be construed in the light of the specification and both are to be read with a view to ascertaining the invention." **United States v. Adams**, 383 U.S. 39, 49, 148 USPQ 479, 482 (1966).

Furthermore, the general claim construction principle that limitations found only in the specification of a patent or patent application should not be imported or read into a claim must be followed. **See In re Priest**, 582 F.2d 33, 37, 199 USPQ 11, 15 (CCPA

1978). One must be careful not to confuse impermissible imputing of limitations from the specification into a claim with the proper reference to the specification to determine the meaning of a particular word or phrase recited in a claim. **See E.I. Du Pont de Nemours & Co. v. Phillips Petroleum Co.**, 849 F.2d 1430, 1433, 7 USPQ2d 1129, 1131 (Fed. Cir.), cert. denied, 488 U.S. 986 (1988). What we are dealing with in this case is the construction of the limitations recited in the appealed claims.

The examiner merely maintains that the difference between the claimed invention and Jordan is in the data source and the data target which is taught by Diwanji and that the issue distills down to does the prior art teach a class defining such methods to transfer data from a data source to a data target. (See answer at page 5.) The examiner maintains that a class defines a method to transfer the data from a data source to a data target if that class defines the data source and the data target. (See answer at pages 5-6.) We disagree with the examiner and find that the indication of a source and a target would encompass every method to transfer data from the source to the target. The examiner maintains that this is a reasonable interpretation. (See answer at page 6.) We cannot agree with the examiner's interpretation. Appellants have recited in each independent claim the user extensible data transfer mechanism and a user extensible place class and specific objects and object methods in the place class. We find it unreasonable for the examiner to disregard all these express limitations and distill the claimed invention down to a mere designation of a data source

and a data target. The examiner continues and evaluates the claimed invention in light of an exemplary disclosure in appellants' specification that the invention may be implemented in C++ programming. (See answer at page 6.) The examiner then indicates that the phrase "defining an method" must be different than what appellants' intend. (See answer at pages 6-7.) Here again, the examiner takes an unreasonable and inaccurate interpretation of the language of independent claim 1. Since we disagree with the examiner's simplified interpretation of the actual language of the independent claims and from our general agreement with appellants' arguments in the brief and reply brief, we find that the examiner has not established a *prima facie* case of obviousness of the invention as recited in the language of the independent claims, and we cannot sustain the rejection of independent claims 1, 16, 19, 24, and 25 and their respective dependent claims.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 3-21, and 23-27 under 35 U.S.C. § 103(a) is reversed.

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REVERSED

JAMES D. THOMAS
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

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