

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte RUSSELL FREDERICK GLOOR, KATHLEEN MOORE KURLANSKI and MYLA STEELMAN MILLER

Appeal No. 2003-1654
Application No. 09/439,310

ON BRIEF

Before FRANKFORT, STAAB and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2 and 4, which are all of the claims pending in this application.

We REVERSE and REMAND.

BACKGROUND

The appellants' invention relates to business methods for assuring quality services (specification, page 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The examiner relied upon the following prior art reference in rejecting the appealed claims:

Eisner, Essentials of Project and Systems Engineering Management, pp. 46-53, 58-60 and 147-176 (John Wiley & Sons, Inc. 1997).

The following rejections are before us for review.

Claim 4 stands rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claim 4 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellants regard as their invention.

Claims 1, 2 and 4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Eisner.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 12) for the examiner's complete reasoning in support of the rejections and to

the brief and reply brief (Paper Nos. 11 and 15) for the appellants' arguments thereagainst.

OPINION

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

The indefiniteness rejection

The basis of the examiner's rejection of claim 4 as being indefinite, as explained on page 4 of the answer, is that

dependent claim 4 does not disclose what one would expect to gain or gather once establishment or non-establishment of said written reports was confirmed. Consequently, the result of such a meeting does [sic] is vague and indefinite.

Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976). Just because a claim is broad does not mean that it is indefinite. See In re Johnson, 558 F.2d 1008, 1016 n.17, 194 USPQ 187, 194 n.17 (CCPA 1977); In re Miller, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971); In re

Gardner, 427 F.2d 786, 788, 166 USPQ 138, 140 (CCPA 1970) and Ex parte Scherberich, 201 USPQ 397, 398 (Bd. App. 1977).

It is not apparent to us why claim 4 must indicate what one would expect to gain or gather as a result of the confirmation of establishment or non-establishment of reports in order to meet the definiteness requirement. From our perspective, the failure to recite what is done with that information is simply a matter of breadth, not indefiniteness. Accordingly, we cannot sustain the examiner's rejection of claim 4 under the second paragraph of 35 U.S.C. § 112.

The anticipation rejection

We also shall not sustain the rejection of claims 1, 2 and 4 as being anticipated by Eisner. Simply stated, we find in the portions of Eisner cited by the examiner no teaching of establishing baselines for the "profit case"¹ as called for in claim 1. While Eisner discusses life-cycle costing on page 163, including consideration of research, development, test and evaluation costs, acquisition and procurement costs and operations and maintenance costs, Eisner makes absolutely no mention in this discussion of costs of any consideration of or establishment of a baseline for profit, either of the services provider or of the customer. The examiner's apparent attempt on

¹ We note that neither claims 1, 2 and 4 nor appellants' underlying disclosure indicates whose profit case (the service provider or the customer) baseline is established. Thus, this claim limitation would be met by the establishment of a baseline for the profit case of either party.

page 11 of the answer to equate profitability with budget constraints is unsound. While Eisner clearly recognizes the importance of cost considerations, thereby implying the consideration of budgetary constraints, in the discussion of life-cycle costing, this does not inherently require any consideration of profitability. A project may simply be constrained by a particular dollar figure, without regard to profitability, thereby requiring a project manager or services provider to account only for costs and not profit and loss.

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). Inasmuch as we have determined that the portions of Eisner relied upon by the examiner do not disclose, either expressly or under the principles of inherency, the limitation in claim 1 of establishing a baseline for the profit case, we cannot sustain the rejection of claim 1 or claims 2 and 4 which depend from claim 1 as being anticipated by Eisner.

The rejection under 35 U.S.C. § 101

The examiner's basis for rejecting claim 4, which depends from claim 1, as being directed to non-statutory subject matter, as stated on page 3 of the answer, is that

[d]ependent claim 4 cites limitations regarding a readiness review that is performed by conducting a meeting. Although the claimed subject matter may at times produce a useful and tangible result, it does not produce a concrete result. That is, the subject matter contained within the claims merely relates an intention to produce result i.e. tangible written reports or to verify the existence of said reports, but the results are not concrete because the outcome of the meeting is not predictable or repeatable. That is, the results of each meeting would most likely change from meeting to meeting. As affirmed above, the subject matter contained within the claims merely relates a thought process and not a physical device such as a computer or computer software that would produce or organize such written reports or establish whether the reports exist at all. Consequently, the claim language as written does not meet the requirements for statutory subject matter.

It is well established that, in assessing whether a claim is directed to patentable subject matter under 35 U.S.C. § 101, the dispositive issue is whether the claim as a whole is directed to patentable subject matter; it is irrelevant that a claim may contain, as part of the whole, subject matter which would not be patentable by itself. See, e.g., State Street Bank & Trust Co. v. Signature Financial Group, Inc., 149 F.3d 1368, 1374 n. 6, 47 USPQ2d 1596, 1601 n. 6 (Fed. Cir. 1998), cert. denied, 119 S. Ct. 851 (1999). In this case, the examiner's rejection focuses merely on one step of the claimed method

and does not assess whether the claim as a whole, including the subject matter recited in claim 1 from which claim 4 depends, is directed to patentable subject matter. We note that the examiner has not rejected claim 1, from which claim 4 depends, as being directed to non-statutory subject matter, thereby seemingly indicating that the examiner was of the opinion that claim 1 is directed to patentable subject matter under 35 U.S.C. § 101. This being the case, it is not apparent to us how the further limitation in dependent claim 4 to the first readiness review step recited in claim 1 can render the seemingly otherwise patentable subject matter of claim 1 non-statutory² and the examiner's explanation sheds no light on this apparent inconsistency. We thus cannot sustain the examiner's rejection of claim 4 under 35 U.S.C. § 101 on the basis of the explanation offered by the examiner.

As discussed above, the examiner's rationale in rejecting dependent claim 4 and not claim 1 from which claim 4 depends under 35 U.S.C. § 101 as being directed to non-statutory subject matter is not clear to us. We remand the application to the examiner under 37 CFR § 1.196(a) to consider and evaluate the claimed subject matter as a whole, including the subject matter of independent claim 1, as well as the subject matter of dependent claims 2 and 4, to determine if the claims are directed to

² We note that appellants' specification discloses (page 5) that the first assurance review and all subsequent reviews are defined to mean "conducting a meeting to inspect, view, examine, or the like, written materials." Thus, all of the review performing steps recited in claim 1 comprise such meetings.

patentable subject matter under 35 U.S.C. § 101 and, consequently, whether a rejection of claims 1, 2 and 4 under 35 U.S.C. § 101 is appropriate. If, after such consideration, the examiner determines that claim 1 is directed to patentable subject matter and either dependent claim 2 or dependent claim 4 is not directed to patentable subject matter, the examiner should explain in the rejection why this is the case so as to resolve the apparent inconsistency discussed above.

CONCLUSION

To summarize, the decision of the examiner to reject claim 4 under 35 U.S.C. §§ 101 and 112, second paragraph, and claims 1, 2 and 4 under 35 U.S.C. § 102(b) is reversed and the application is remanded to the examiner to address the above-mentioned issue.

REVERSED AND REMANDED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JENNIFER D. BAHR)	
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