

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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TUSHAR DEEPAK CHANDRA and DANIEL CHARLES STURMAN

Appeal No. 2003-1873
Application 09/281,420

ON BRIEF

Before FLEMING, DIXON, and MACDONALD, **Administrative Patent Judges.**

MACDONALD, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-3, 6-8, 10-15, 17-21, 24-29, 32-34, 36-41, 43-47, and 50-52. Claims 4-5, 9, 16, 22-23, 30-31, 35, 42, and 48-49 have been canceled.

Invention

Appellants' invention relates to information retrieval across a distributed network environment. More particularly, the invention relates to a data structure, method, system, and program product for gathering responses in a distributed network environment. The invention also comprises a technique for recovering from failure at a node of the distributed network environment. Appellants' specification at page 1, lines 4-10.

Claims 24 and 26 are representative of the claimed invention and are reproduced as follows:

24. A request structure for communicating a query across a distributed network environment, said request structure comprising:

a query description comprising said query; and

a merge function code for use by said distributed network environment in merging responses to said query for return back to a root node originating said query.

26. The request structure of claim 24, wherein said query is application specific and wherein said request structure further comprises a response type, said response type being dependent upon said application specific query.

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References

The references relied on by the Examiner are as follows:

Bishop et al. (Bishop)	4,958,284	Sept. 18, 1990
McMillen et al. (McMillen)	5,321,813	Jun. 14, 1994
Schoolcraft	5,729,751	Mar. 17, 1998

Rejections At Issue

Claims 1-3, 6-8, 10-15, 17-18, 24-25, 27-29, 32-34, 36-41, 43-44, and 50-51 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Bishop and Schoolcraft.

Claims 19-21, 26, 45-47, and 52 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Bishop and Schoolcraft and McMillen.

Throughout our opinion, we make references to the Appellants' briefs, and to the Examiner's Answer for the respective details thereof.¹

¹Appellants filed an appeal brief on December 16, 2002. Appellants filed a reply brief on April 30, 2003. The Examiner mailed out an Examiner's Answer on February 26, 2003.

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated **infra**, we affirm the Examiner's rejection of claims 1-2, 8, 10, 19-21, 24-28, 34, 36, 45-47, 50 and 52 under 35 U.S.C. § 103 and we reverse the Examiner's rejection of claims 3, 6-7, 11-15, 17-18, 29, 32-33, 37-41, 43-44, and 51 under 35 U.S.C. § 103.

Appellants have indicated that for purposes of this appeal the claims stand or fall together in three groupings:

Claims 1-2, 8, 10, 24-25, 27-28, 34, 36 and 50 as Group I;

Claims 3, 6-7, 11-15, 17-18, 29, 32-33, 37-41, 43-44, and 51 as Group II; and

Claims 19-21, 26, 45-47 and 52 as Group III.

See page 6 of the brief. Furthermore, Appellants argue each group of claims separately and explain why the claims of each group are believed to be separately patentable. See pages 6-13 of the brief and pages 2-4 of the reply brief. Appellants have fully met the requirements of 37 CFR § 1.192 (c)(7) (July 1,

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2002) as amended at 62 Fed. Reg. 53169 (October 10, 1997), which was controlling at the time of Appellants' filing of the brief.

37 CFR § 1.192 (c)(7) states:

Grouping of claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

We will, thereby, consider Appellants' claims as standing or falling together in the XXX groups noted above, and we will treat:

Claim 24 as a representative claim of Group I;

Claim 3 as a representative claim of Group II; and

Claim 26 as a representative claim of Group III.

If the brief fails to meet either requirement, the Board is free to select a single claim from each group and to decide the appeal of that rejection based solely on the selected representative

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claim. **In re McDaniel**, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). **See also In re Watts**, 354 F.3d 1362, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004).

I. Whether the Rejection of Claims 1-2, 8, 10, 24-25, 27-28, 34, 36 and 50 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-2, 8, 10, 24-25, 27-28, 34, 36 and 50. Accordingly, we affirm.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming

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forward with evidence or argument shift to the Appellants.

Oetiker, 977 F.2d at 1445, 24 USPQ2d at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to independent claim 24, Appellants argue the references do not describe "a distributed network environment, nor the existence of multiple clients within such an environment, nor the distribution of a query request from a root node to multiple clients within a distributed network environment, nor the receiving back or responses at a root node." (Appellants' brief at pages 8-10).

We have reviewed claim 24 and find that Appellants' arguments are not commensurate in scope with claim 24. Claim 24 contains none of the limitations argued by Appellants. Rather, we find that claim 24 is directed to a "request structure" (a data structure) that comprises "a query" and "a merge function code for use in merging responses to said query." The remainder of claim 24 recites intended uses of the request structure or its two components. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art data structure is capable of performing the intended use, then it meets the claim.

We note that the language of claim 24 places no limitation on how the "merge function code" is implemented in relation to the "query." While the claim requires that the query portion of the request structure be of a form that can be communicated in a distributed network environment, no such limitation is placed on the merge function code. Rather, the "merge function code" could be communicated with the query or the "request structure" could be such that the "merge function code" resides at a fixed

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location and does not get communicated. The only limitation on the "merge function code" is that it must merge responses to said query into a form that can be communicated in a distributed network environment.

We find that Bishop teaches a query at column 1, line 12, in the form of survey question data. We find that Bishop teaches merge function code for generating merged question data at column 2, lines 60-64, by merging responses collected in response to the survey. We also find that Bishop teaches that any data can be communicated over a network at column 3, lines 14-18. Therefore, since the survey and its merge responses are data, they are in a form that can be communicated in a distributed network environment.

Claim 24, is of very broad scope and we are of the opinion, upon an analysis of claim 24 and a review of the references, that the rejection is free of reversible error. It is well settled that limitations in claims drawn to structure reciting only the manner of operation or intended use of the claimed structure or parts thereof are not of patentable significance in the claims. The manner or method in which a machine is to be utilized is not

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germane to the issue of patentability of the machine itself. **In re Casey**, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967). A statement of intended use does not qualify or distinguish the structural apparatus claimed over the reference. **In re Sinex**, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962). This is equally applicable to "data structure" claims. Stripping claim 24 of such limitations we find that it defines a data structure, which is obvious in view of the references.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103.

II. Whether the Rejection of Claims 3, 6-7, 11-15, 17-18, 29, 32-33, 37-41, 43-44, and 51 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 3, 6-7, 11-15, 17-18, 29, 32-33, 37-41, 43-44, and 51. Accordingly, we reverse.

With respect to dependent claim 3, Appellants argue that the

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references fail to teach, "generating the merged response . . . at other than the at least some merged clients responding to the query request." (Brief at page 11) We agree. We have fully reviewed the references and find nothing that corresponds to the generating of merged responses recited in claim 3.

Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

III. Whether the Rejection of Claims 19-21, 26, 45-47 and 52 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 19-21, 26, 45-47 and 52. Accordingly, we affirm.

With respect to independent claim 26, Appellants repeat the arguments made with respect to claim 24. As discussed above with respect to claim 24, we do not find those arguments persuasive. Claim 26 only requires that the request structure include some unique identifier for use in a fault tolerant method. Bishop

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teaches adding a respondent ID to the responses at column 3, line 10-11. Clearly, such a unique identifier could be used to prevent erroneous submission of redundant responses from the same respondent. Thus, Bishop meets the claim limitations of claim 24 since the claim is silent as to the type of fault of which it is tolerant.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103.

Conclusion

In view of the foregoing discussion, we have sustained the rejection under 35 U.S.C. § 103 of claims 1-2, 8, 10, 19-21, 24-28, 34, 36, 45-47, 50 and 52 and we have not sustained the rejection under 35 U.S.C. § 103 of claims 3, 6-7, 11-15, 17-18, 29, 32-33, 37-41, 43-44, and 51.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

MICHAEL R. FLEMING)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
JOSEPH L. DIXON)	
Administrative Patent Judge)	APPEALS AND
)	
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