

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte DANIEL E. TSAI

Appeal No. 2004-1890
Application No. 09/225,974

ON BRIEF

Before BARRETT, RUGGIERO, and DIXON, Administrative Patent Judges.
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-19 and 58-97, which are all of the claims pending in the present application. Claims 20-57 have been canceled. At pages 12 and 13 of the Answer, the Examiner indicates that the rejection of claims 4, 19, 76-78, and 87-94 has been withdrawn, and states that claims 19, 76-78, and 87-94 are allowed while claim 4 is allowable subject matter to being rewritten in independent form. Accordingly, only the Examiner's rejection of claims 1-3, 5-18, 58-75, 79-86, and 95-97 is before us on appeal.

The claimed invention relates to a computer system and method of searching for information to construct an information object in which a resource having information stored as bindable data elements is queried. The bindable data elements, which are structures that can be bound to each other in an additive manner, have binding rules which are specified in the bindable data elements. According to Appellant's specification (page 2, lines 7-30), bindable data elements are defined as including primitives, fragments (two or more primitives bound together), and information objects (multiple primitives and fragments bound together), the binding being provided according to binding rules specified in the primitives and fragments.

Claim 1 is illustrative of the invention and reads as follows:

1. A method of searching for information to construct an information object comprises:

querying a resource having information stored as bindable data elements with bindable data elements being structures that can be bound to each other in an additive manner, with binding being according to a binding specification that is implemented by binding rules that are specified in the bindable data element; and

returning as a result of querying the resource bindable data elements that can be combined together to construct the information object according to the binding rules.

The Examiner relies on the following prior art:

Suver	6,016,497	Jan. 18, 2000 (filed Dec. 24, 1997)
Carey et al. (Carey)	6,134,540	Oct. 17, 2000 (filed May 09, 1997)

Claims 1, 11, and 18 stand finally rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention.¹ Claims 58-62 stand finally rejected under 35 U.S.C. § 102(e) as being anticipated by Carey. Claims 1-3, 5-18, 63-75, 79-86 and 95-97 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Carey in view of Suver. In a separate rejection under 35 U.S.C. § 103(a), claims 95-97 stand finally rejected as being unpatentable over Carey alone.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Briefs² and Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, the arguments in support of the rejections and the evidence of anticipation and obviousness relied upon by the Examiner as support for the prior art rejections. We have, likewise, reviewed and taken into consideration, in reaching our

¹ Although the Examiner has characterized the stated position with regard to the language of claims 1, 11, and 18 as an “objection,” we agree with Appellant (Brief, pages 9, 12, and 13; Reply Brief, page 4) that the Examiner’s position is properly characterized as a “rejection.” The Examiner’s comments (Answer, page 15) regarding an alleged “lack of antecedent basis” in the language of claims 1, 11, and 18 verifies that the asserted inadequacies of the claim language are a matter of substance, not mere formalities. The alleged indefiniteness of claim language is properly characterized as a “rejection” which is reviewable by the Board. See MPEP § 706.01.

² The Appeal Brief was filed August 18, 2003 (Paper No. 28). In response to the Examiner’s Answer dated October 16, 2003 (Paper No. 29), a Reply Brief (corrected) was filed December 23, 2003 (Paper No. 31), which was acknowledged and entered by the Examiner as indicated in the communication dated April 1, 2004 (Paper No. 33).

decision, Appellant's arguments set forth in the Briefs along with the Examiner's rationale in support of the rejections and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the claims particularly point out the invention in a manner which complies with 35 U.S.C. § 112, second paragraph. We are also of the view that the Carey reference does not fully meet the invention as set forth in claims 58-62. We are further of the opinion 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 recited in claims 1-3, 5-18, 63-75, 79-86, and 95-97. Accordingly, we reverse.

We consider first the Examiner's 35 U.S.C. § 112, second paragraph, rejection of claims 1, 11, and 18 as failing to particularly point out and distinctly claim the invention. We note that the general rule is that a claim must set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the disclosure as it would be by the artisan. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed in light of the specification. Seattle Box Co. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984).

With respect to claim 1, we find no ambiguity or lack of clarity in the existing claim language which, in reference to the claimed binding rules, recites that such binding rules

are “specified in the binding data elements.” While the claims are perhaps broader without the inclusion of the Examiner’s suggested language (Answer, page 3) “specified for each bindable data element” or “specified within each bindable data element,” no uncertainty or lack of specificity exists as asserted by the Examiner. The breadth of a claim is not to be equated with indefiniteness. In re Miller, 441 F.2d 689, 692, 169 USPQ 597, 600 (CCPA 1971).

With respect to claims 11 and 18, we also find no ambiguity or lack of clarity in the language of these claims despite the fact that “fragment base” and “fragment database” are used in different portions of the claims. If the scope of a claim, when read in light of the specification, would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. The failure to provide explicit antecedent basis for terms does not always render a claim indefinite. Ex parte Porter, 25 USPQ2d 1144, 1145 (Bd. Pat. App. & Inter. 1992).

It is our view that the skilled artisan, having considered the specification in its entirety, would have no difficulty ascertaining the scope of the invention recited in claims 1, 11, and 18. Therefore, the rejection of claims 1, 11, and 18 under the second paragraph of 35 U.S.C. § 112 is not sustained.³

³ In view of our decision in this case, the Examiner should reconsider the refusal to enter the amendment after final filed April 30, 2003.

We consider next the Examiner's 35 U.S.C. § 103(a) rejection of claims 1-3, 5-18, 63-75, 79-86, and 95-97 based on the combination of Carey and Suver. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention.

With respect to each of the independent claims 1, 11, and 81, Appellant's response to the Examiner's 35 U.S.C. § 103(a) rejection asserts that the Examiner has failed to establish a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by any of the applied prior art references. After careful review of the applied prior art references, in light of the arguments of record, we are in general agreement with Appellant's position as stated in the Briefs.

Initially, we agree with Appellant (Brief, page 14; Reply Brief, page 4) that, in contrast to the claimed invention, the Carey reference, relied on by the Examiner for an alleged teaching of the claimed bindable data element feature, has no disclosure directed to the specifying of binding rules. While the term "binding" does appear in the portions of Carey cited by the Examiner, i.e., column 6, line 14 and column 20, line 6, the Examiner

has not provided any explanation as to how Carey's reference to "binding" corresponds to the claimed specifying of binding rules, let alone binding rules that are defined in the bindable data elements themselves as claimed.

Similarly, we find no disclosure in Suver, applied by the Examiner as allegedly providing a teaching of the returning of bindable data elements as a result of a resource query, of any specification of binding rules. To whatever extent Suver may disclose bindable data elements, we simply find no teaching or suggestion of the specifying of binding rules that are defined in the binding elements themselves as claimed.⁴

In view of the above discussion, since the Examiner has not established a prima facie case of obviousness, the 35 U.S.C. § 103(a) rejection of independent claims 1, 11, and 81, as well as claims 2, 3, 5-10, 12-18, 63-75, 79, 80, 82-86, and 95-97 dependent thereon, based on the combination of Carey and Suver is not sustained.

Turning to a consideration of the Examiner's separate 35 U.S.C. § 103(a) rejection of claims 95-97 based on Carey alone we do not sustain this rejection as well. For the reasons discussed supra, the Examiner has not provided any indication as to where the claimed binding rule in the binding element specification feature is taught or suggested.

⁴ Contrary to the Examiner's assertion at page 16 of the Answer that the claims do not contain the "in the element" binding specification language, the appealed independent claims 1, 11, and 81, which are the claims submitted in the amendment dated November 13, 2002, do in fact contain the language "binding rules that are specified in the bindable data elements (claim 1), "binding rules specified in each of the fragments and/or primitives" (claim 11), and (claim 81) "binding rules specified for and stored in the bindable data elements."

Lastly, we also do not sustain the Examiner's 35 U.S.C. § 102(e) rejection based on Carey of independent claim 58, which is directed to a fragment transformation feature. As with the term "binding" with regard to the previously discussed claims, the term "transformation" does appear in certain portions of the Carey reference (e.g., column 4, line 66 through column 5, line 24). There is no explanation from the Examiner, however, as to how this discussion of transformation would correspond to the specifically claimed transformation of fragments as set forth in independent claim 58. We agree with Appellant (Brief, page 23) that Carey, at best, discloses transformation of queries and not fragments as claimed.

In summary, we have not sustained any of the Examiner's rejections of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-3, 5-18, 58-75, 79-86, and 95-97 is reversed.

REVERSED

LEE E. BARRETT)	
Administrative Patent Judge)	
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JOSEPH F. RUGGIERO)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS
)	AND
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