

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LEE EVAN NAKAMURA and STEWART EUGENE TATE

Appeal No. 2004-2245
Application No. 10/145,544

HEARD: March 10, 2005

Before KRASS, BARRY and SAADAT, Administrative Patent Judges.
KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 52-60 and 76-81.

The invention is directed to the retrieval of data from an in-memory database table stored in a computer. In particular, stored descriptors, which reference an in-memory database table, are stored in a high-speed index. The stored descriptors are mapped to location information in a header area of the in-memory database table, and the location information is then used to access data stored in a data area of the in-memory database table.

Appeal No. 2004-2245
Application No. 10/145,544

Representative independent claim 52 is reproduced as follows:

52. A method for retrieving data from an in-memory database table stored at a computer, comprising:

retrieving stored descriptors corresponding to search terms in a search request;

mapping the stored descriptors to location information in a header area of an in-memory database table; and

using the location information to retrieve data.

The examiner relies on the following references:

Hull et al. (Hull)	5,465,353	Nov. 7, 1995
Shaughnessy	5,555,388	Sep. 10, 1996
Farrell	5,664,153	Sep. 2, 1997
Pereira	6,122,640	Sep. 19, 2000 (filed Sep. 22, 1998)
Judd et al. (Judd)	6,360,215	Mar. 19, 2002 (filed Nov. 3, 1998)
Dugan et al. (Dugan)	6,363,411	Mar. 26, 2002 (filed Oct. 19, 1999) ¹
Pohlmann et al. (Pohlmann)	6,366,926	Apr. 2, 1002 (filed Dec. 31, 1998)
Carper et al. (Carper)	6,390,374	May 21, 2002 (eff. filing date Jan. 15, 1999)

¹The Dugan reference relates to a continuation-in-part (C-I-P) parent application, filed Aug. 5, 1999, as well as a provisional application filed on the same day. Being a C-I-P, it is difficult to ascertain just how much of the subject matter of the Dugan patent is entitled to this earlier date, but the filing date of the Dugan patent itself, i.e., Oct. 19, 1999, would preclude the Dugan patent from being a viable reference against the instant claims if appellants are, in fact, entitled to the benefit of Aug. 12, 1999 which they claim.

Appeal No. 2004-2245
Application No. 10/145,544

Claims 52-60, and 76-81 stand rejected under 35 U.S.C.

§ 103. As evidence of obviousness, the examiner offers Hull, Judd, Shaughnessy, and Pereira with regard to claims 52, 53, 55, 56, 58, and 59, adding Pohlmann with regard to claims 54, 57, and 60. With regard to claims 76, 78, and 80, the examiner offers Hull, Judd, Shaughnessy, and Pereira, Carper, and Dugan, adding Farrell with regard to claims 77, 79, and 81.

Reference is made to the briefs² and answer for the respective positions of appellants and the examiner.

OPINION

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

²We refer to the revised brief, of December 30, 2003, Paper No. 16, as the "principal brief" and the reply brief of May 20, 2004, Paper No. 18, as the "reply brief."

Appeal No. 2004-2245
Application No. 10/145,544

invention. Such reason must stem from some teachings, suggestions or implications in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make

in the brief have not been considered and are deemed to be waived.

With regard to independent claims 52, 55, and 58, the examiner contends that Hull discloses retrieving stored descriptors (at column 10, lines 16-19), mapping the stored descriptors (at column 10, lines 15-20, and 25-27), and that the mapping is to retrieve data (at column 7, lines 21-23).

The examiner recognizes that Hull does not teach the use of search requests, the use of search terms, the use of location information, the use of file headers, and the use of in-memory database tables. The examiner turns to Judd for the use of search requests and search terms, specifically pointing to column 3, lines 21-31, of Judd. The examiner concludes that it would have been obvious to combine Hull and Judd "since both Hull and Judd teach the use of databases with tables, the use of indexes, the use of queries, and the retrieving of data" (answer-page 5). The examiner recognizes that this combination is still lacking the use of location information, the use of file headers, and the use of in-memory database tables.

Turning to Shaughnessy, the examiner contends that this reference teaches the use of location information (at column 5, lines 34-37; column 3, lines 66-67; and column 4, line 1) and the

Appeal No. 2004-2245
Application No. 10/145,544

use of file headers (column 5, lines 34-37), and concludes that it would have been obvious to combine Shaughnessy with the Hull/Judd combination, since they all "teach the use of databases with tables, the use of indexes, the use of queries, and the retrieving of data" (answer-page 5).

The examiner recognizes that the Hull/Judd/Shaugnessy combination does not teach the use of in-memory database tables, but turns to Pereira for such a teaching at column 9, lines 60-66, and concludes that it would have been obvious to make the combination with the other references since they all "teach the use of databases with tables, the use of indexes, and the retrieving of data" (answer-page 6).

We have reviewed the evidence before us, including, inter alia, the arguments of appellants and the examiner, and we conclude therefrom that the examiner has not presented a prima facie case of obviousness with regard to the instant claimed subject matter.

Accordingly, we will not sustain the rejection of claims 52-60, and 76-81 under 35 U.S.C. § 103.

While the number of references applied in a rejection may, theoretically, be infinite, if applied in a proper manner, the examiner's use of four references in the instant rejection of the

Appeal No. 2004-2245
Application No. 10/145,544

independent claims which comprise, at most, three method steps or two elements of an apparatus, is suspect. When reviewing the examiner's rationale, holding that Hull discloses retrieving stored descriptors, mapping the stored descriptors, and mapping to retrieve data; Judd teaches the use of search requests and search terms; Shaughnessy teaches the use of location information and the use of file headers; and Pereira teaches the use of in-memory database tables, and that, therefore, it would have been obvious to combine these references since they all "teach the use of databases with tables, the use of indexes, the use of queries, and the retrieving of data" (answer-page 5), it is apparent to us that the examiner has employed impermissible hindsight, using the instant claims as a blueprint and then picking and choosing only so much of those elements of each reference as will support a given position to the exclusion of other parts necessary for the full appreciation of what the references fairly suggest to one of ordinary skill in the art. This, of course, is impermissible under 35 U.S.C. § 103. In re Wesslau, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965); In re Kamm, 452 F.2d 1052, 1057, 172 USPQ 298, 301-02 (CCPA 1972).

Appeal No. 2004-2245
Application No. 10/145,544

The examiner chooses various elements of each reference and combines them with elements of the other references merely because they all "teach the use of databases with tables, the use of indexes, the use of queries, and the retrieving of data" (answer-page 5). This is not a convincing reason which would have led the artisan to make the combination. We agree with appellants when they state, at page 17 of the principal brief, that this analysis "relating to the degree of commonality of elements among the references is irrelevant, as it fails to apply the proper standard as set forth in the MPEP."

The MPEP § 2143.01 suggests possible reasons for leading the artisan to make a particular combination. They include the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. They do not include, as a reason for combining references, a mere, possibly coincidental, commonality of elements. The examiner would need to show specifically what it is about this commonality of elements that would have led the artisan to make the proposed combination, without using appellants' claims as a guide to making the combination.

Appeal No. 2004-2245
Application No. 10/145,544

The examiner's response includes the claim that the references are classified in similar classes/subclasses in the classification system of the United States Patent and Trademark Office (see pages 16-17 of the answer). Again, this goes to the "commonality of elements" theory of combining references and such, per se, is not enough to establish a proper motivation for making the combination within the meaning of 35 U.S.C. § 103.

While we have doubts as to the showing, by the applied references, of "descriptors corresponding to search terms in a search request," and "mapping the stored descriptors to location information in a header area of an in-memory database table," as claimed, even if we assumed, arguendo, that the references do, in fact, separately disclose all of the claimed steps/elements, since the examiner has failed to articulate any convincing rationale for combining the various steps/elements of the applied references, we will not sustain the rejection of claims 52, 53, 55, 56, 58, and 59 under 35 U.S.C. § 103. Moreover, since the additional references to Pohlmann, Carper, Dugan and Farrell do not remedy the deficiencies of the examiner's rationale, we also

Appeal No. 2004-2245
Application No. 10/145,544

will not sustain the rejection of claims 54, 57, 60, and 76-81
under 35 U.S.C. § 103.

The examiner's decision is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
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LANCE LEONARD BARRY)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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MAHSHID D. SAADAT)	
Administrative Patent Judge)	

EAK:clm

Appeal No. 2004-2245
Application No. 10/145,544

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