

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte Susan Day, Juan De Pena, Steven H. Scheerhorn,
Marleen Pizzuti, Gail Baker, Elaine Tumavitch, and
Michael Sobczak

Appeal No. 2005-2452
Application No. 09/707,111

ON BRIEF

Before RUGGIERO, DIXON, and NAPPI, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-18, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

Appellants' invention relates to a method for resolving issues within a team environment. A copy of the representative claim 1 under appeal is set forth below.

1. A computer-implemented method for resolving issues within a team environment, the team environment including a virtual team room providing computer access to the team environment by first members of a first organization and by second members of a second organization, organizationally disparate from the first members, the method comprising the steps of:

electronically receiving from one member of the first members and the second members an issue document;

providing to the one member a list identifying potential reviewers for the issue;

receiving from the one member a selection of a reviewer for the issue;

restricting dissemination of the issue document to the selected reviewer;

automatically notifying the one member that the issue document has become dated after a first specified amount of time; and

automatically archiving or deleting the issue document a second specified amount of time after the one member was notified that the issue document has become dated.

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

Diamant et al. (Diamant)	5,530,861	Jun. 25, 1996
Mora et al.	6,161,113	Dec. 12, 2000
Srinivasan Appellants' Admitted Prior Art (AAPA)	5,548,506	Aug. 20, 1996

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Claims 1, 2, and 4-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mora in view of AAPA and Diamant. Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Mora in view of AAPA and Diamant further in view of Srinivasan.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the answer (mailed Dec. 10, 2004) for the examiner's reasoning in support of the rejections, and to the brief (filed Nov. 3, 2004) 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.

Only those arguments actually made by appellants have been considered in this decision. Arguments that appellants could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by appellants [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

35 U.S.C. § 103

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. **See In re Rijckaert**, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See In re Lintner**, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. **See In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed

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invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. American Maize-Prods. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, “the [E]xaminer can satisfy the burden of showing obviousness of the combination ‘only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.’” **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing **In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’” **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). “Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact.” **Dembiczak**, 175 F.3d at 999-1000, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. “[T]he name of the game is the claim.” **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations as recited in independent claim 1. We find that independent claim 1 sets forth “automatically notifying the one member that the issue document has become

dated after a first specified amount of time; and automatically archiving or deleting the issue document a second specified amount of time after the one member was notified that the issue document has become dated.” The examiner admits that Mora and the AAPA do not teach these limitations, at page 5 of the answer, and maintains that Diamant teaches these limitations at columns 6 and 9. (Answer at page 5 and additionally cites columns 4, 5 6, 9, 10, 17, and 22 of Diamant at page 10 of the answer.) The examiner additionally points out that the claim language only requires deletion OR archiving by the use of alternative language in independent claim 1.

We agree with the examiner that only one of the two functions is needed to be taught or suggested in the prior art, but from our review of the teachings of Diamant (and Mora for “notifications”), we find no express teaching with respect to the automatic archive and/or deletion functions for tasks of Diamant that would have fairly suggested the implementation of these functions in the system of Mora for the processing of documents as recited in the instant claims. We find no express teaching or fair suggestion of “automatically notifying the one member that the issue document has become dated after a first specified amount of time” and use thereof in the automatic archiving and deleting. While the generic functionality may be taught or suggested by Diamant, we find no suggestion as to why and the examiner has not provided a convincing line of reasoning as to why it would have been obvious to one of ordinary skill in the art to have implemented either of these functions to an issued document that

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has become dated and has provided a notification thereof to a user. Therefore, we find no persuasive reasoning or support thereof for the examiner's proposed combination of teachings. Furthermore, even if combined, we do not agree with the examiner that the additional miscellaneous documents/forms of Mora at columns 21 et seq. teach or suggest the claimed notification of a document becoming dated. Therefore, we cannot sustain the rejection of independent claim 1 and its dependent claims and 4-18.

With respect to dependent claim 3, we do not find that Srinivasan remedies the deficiencies in the base combination. Therefore, we cannot sustain the rejection of dependent claim 3.

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CONCLUSION

To summarize, the decision of the examiner to reject claims 1-18 under 35
U.S.C. § 103(a) is REVERSED.

REVERSED

JOSEPH F. RUGGIERO
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

ROBERT E. NAPPI
Administrative Patent Judge

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