

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 WILLIAM RUSSELL BRISIEL,
ERIC GORDON COOPER,
and MARK EDWARD DAVIS

Appeal No. 2005-2456
Application 09/690,055¹

ON BRIEF

Before BARRETT, RUGGIERO, and SAADAT, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-10.

We reverse.

¹ Application for patent filed October 16, 2000, entitled "Electronic Stockroom and Catalog."

BACKGROUND

The invention relates to an intranet based electronic stockroom and catalog.

Claim 6 is reproduced below.

6. A system of storing, searching and purchasing a wide variety of items from an intranet based electronic stockroom and catalog (ESAC) comprising the steps of:

an ESAC program that is executed on a server that operates on a secure company intranet, wherein the ESAC can be accessed by authorized employees at one or more company terminals;

on-site inventory information and multiple vendor catalog information that is stored in ESAC wherein, the vendors are allowed to download their catalog information to ESAC, both for initial loading of their catalog and for updating of their catalog information;

search capabilities that allow for simultaneous searching of the multiple vendor catalogs and items that are available on-site; and

ESAC functions that provide integration of ESAC files with other company electronic files so that budgeting, accounting and authorization limitations are implemented with each purchase and tracking of purchases is possible.

THE REFERENCES

The examiner relies on the following references:

Barnes	5,970,475	October 19, 1999
Johnson et al. (Johnson)	6,023,683	February 8, 2000
Rosenberg et al. (Rosenberg)	6,418,416	July 9, 2002
		(filed January 3, 2000)

THE REJECTIONS

Claims 1, 2, 4-7, 9, and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Barnes and Rosenberg.

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Claims 3 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Barnes and Rosenberg, further in view of Johnson.

We refer to the final rejection (pages referred to as "FR__") and the examiner's answer (pages referred to as "EA__") for a statement of the examiner's rejection, and to the brief (pages referred to as "Br__") for a statement of appellants' arguments thereagainst.

DISCUSSION

The claims are argued to stand or fall together with independent system claim 6. We agree that claim 6 is representative because it is similar in scope to method claim 1.

The examiner finds that Barnes discloses the claimed invention except that "Barnes does not specifically disclose and teach a method and system for storing on-site inventory information in the ESAC" (FR4). The examiner asserts that Barnes teaches allowing multiple vendors to download their catalog information to the buyer's server, referring to Figs. 2-4 and 14, but then states that Barnes does not have the supplier downloading their catalogs, but refers to and incorporates by reference the teachings of King, Jr. et al. (King), U.S. Patent 5,319,542, mentioned at column 2, which discloses suppliers downloading their catalogs to the customer's private server (FR2-3). The examiner finds that Rosenberg teaches storing on-

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site inventory information and concludes that it would have been obvious to provide the system of Barnes with on-site inventory information in view of Rosenberg to provide for company approved buyers to quickly purchase required items (FR4-5).

Appellants argue that Barnes does not disclose any of the elements of system claim 6 because: Barnes requires the Internet to access and search a catalog in a server at a seller's location and is not an ESAC program executed on a company intranet; Barnes does not have any ability for the vendors to download their catalogs to the customer's server; Barnes cannot search local inventory and catalog information; and Barnes requires at least one other server to implement accounting, authorization limits, and to track purchases (Br4-6). As to the examiner's assertion that Barnes teaches allowing multiple vendors to download their catalog information to the buyer's server, and then that Barnes does not teach this feature, but this is taught by King, appellants note that King is not incorporated by reference, but is merely listed in the background section (Br6) and, even if King did teach this feature, since King is not incorporated by reference in Barnes, it cannot be said that Barnes teaches this feature (Br7). It is argued that neither Rosenberg nor Johnson teach the limitations of claim 6 (Br7-8).

We generally agree with appellants' arguments. Barnes clearly discloses a system wherein the buyer accesses a catalog

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in a server at the seller's location over the Internet (e.g., Fig. 2), which is not an ESAC on a company intranet, as claimed. The invention described in Barnes does not contemplate vendors downloading their catalogs to the buyer's server. The examiner attempts to rely on King, U.S. Patent 5,319,542, described at column 2, lines 44-58. It is possible that the best prior art is found in the background of the invention, but here the examiner is inconsistently relying on Barnes's Internet system and then somehow relying on King's private catalog system. If the examiner wants to rely on the private catalog system of King, then King would be the best reference. As noted by appellants, King is not incorporated by reference because incorporation by reference requires express words to that effect. Therefore, the only thing that can be relied upon is the description of King in Barnes. King sounds promising, but, as appellants argue (Br6; Br7), the description in Barnes does not teach at least that "the [multiple] vendors are allowed to download their catalog information to ESAC, both for initial loading of their catalog and for updating of their catalog information." Neither Rosenberg nor Johnson cures the deficiencies of Barnes.

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For the reasons stated above, we conclude that the examiner has failed to establish a prima facie case of obviousness. The rejections of claims 1-10 are reversed.

REVERSED

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

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