

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 YOSHITO FUJINO, TERUJI NAKAMURA,
KEIKO TAKEUCHI, and RYOHICHI YOSHIMURA

Appeal No. 2006-1698
Application No. 09/669,598

ON BRIEF

Before JERRY SMITH, BARRY, and SAADAT, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-7, 9-18, and 20-24. Pending claims 8, 19, and 25 have been indicated by the examiner to contain allowable subject matter.

The disclosed invention is directed to providing a predetermined proxy user with a privilege for a delegated application processing without providing the proxy user with an application requester's log-in password.

Representative claim 1 is reproduced as follows:

1. An electronic form acquiring method employed for an electronic form system that certifies a user, said method comprising the steps of:

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(a) registering form condition data that identifies a form of requesting a delegated application and delegation term condition data that identifies a term of requesting said delegated application beforehand so as to be related to application requester specification data that specifies an application requester and proxy applicant specification data that specifies a proxy applicant who is requested for said delegated application respectively;

(b) receiving an input for specifying said application requester specification data and accessing a first electronic form by said proxy applicant;

(c) inspecting whether or not a current date adapts to said delegation term condition data registered so as to be related to said application requester specification data and said proxy applicant specification data;

(d) inspecting whether or not said first electronic form coincides with said form condition data registered so as to be related to said application requester specification data and said proxy applicant specification data; and

(e) enabling said first electronic form to be acquired if results of said inspections performed in (c) and (d) are acceptable.

The examiner relies on the following references:

Atlas et al. (Atlas)	6,208,339 ¹	Mar. 27, 2001 (filed June 19, 1998)
Broomhall et al. (Broomhall)	6,292,904	Sep. 18, 2001 (filed Dec. 16, 1998)

Using Paradox 5 For Windows, Special Edition, QUE (1994) (Paradox).

Claim 20 stands rejected under 35 U.S.C. § 102(e) as being anticipated by the disclosure of Broomhall. Claims 1-7, 9-18, and 21-24 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Broomhall in view of Paradox with respect to claims 1-3, 5-7, 9-14, 16-18, and 22-24, and Atlas is added to this combination with respect to claims 4, 15, and 21.

¹ Both the examiner and appellants refer to U. S. Patent number 5,848,413 in referring to Atlas et al. We note that this patent number was not issued to Atlas et al. Based on the references cited form for this application, the only patent issued to Atlas et al. was U. S. Patent number 6,208,339. It appears that this is the reference cited against the claims.

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Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' 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 evidence relied upon by the examiner does not support the examiner's rejection of independent claims 1, 2, 9, 10, 12, 13, and 20 and the claims which depend therefrom. We reach the opposite conclusion with respect to independent claims 3, 4, 11, 14, and 15 and the claims which depend therefrom. Accordingly, we affirm-in-part.

We consider first the rejection of claim 20 as being anticipated by Broomhall. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983).

The examiner has indicated how the invention of claim 20 is deemed to be fully met by the disclosure of Broomhall [answer, pages 3-4]. Appellants essentially argue that based on definitions set forth in their specification for a "proxy applicant," "form condition data," and "a delegated application," Broomhall fails to fully meet the claimed invention [brief, pages 4-5]. The examiner responds that the external users in Broomhall are proxy applicants, that the

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Lotus applications are delegated applications, and the features of “form condition data” argued by appellants do not appear in the claims [answer, pages 12-13]. Appellants respond that requesting a user’s ID and password is not equivalent to registering form condition data that identifies a form of requesting a delegated application as disclosed and claimed. Appellants essentially reiterate their arguments from the brief that Broomhall does not meet the claimed invention when terms of the claim are properly interpreted in light of the specification [reply brief, pages 2-4].

We will not sustain the examiner’s rejection of claim 20 as being anticipated by Broomhall. We agree with the examiner that an external user in Broomhall can be considered a proxy applicant because the external user is sponsored by an internal user. We can find no specific definition in appellants’ specification which would preclude this interpretation. We also agree with the examiner that the Lotus applications in Broomhall can be considered delegated applications as they are the only applications accessible to the external user. Again, we can find no specific definition in appellants’ specification which would preclude this interpretation. We do not agree, however, with the examiner’s position on the interpretation of “form condition data.” The examiner asserts that the features related to this term as argued by appellants do not appear in the claim. Appellants’ specification, however, specifically states the following:

In the Claims included in the specification of this application, the “form condition data” is a concept that includes form ID for identifying a specific form uniquely and data for identifying such a predetermined form group as a form class, as well as data for identifying such a predetermined form as a conditional expression in which “XXX” is set as the first three digits and a number of 22 or under is set in the lower two digits of the form ID [paragraph bridging pages 4 and 5 of specification].

Thus, the specification provides a specific definition as to how the term “form condition data” is to be interpreted in the claims. This portion of the specification is sufficient to require that the term “form condition data” in the claims be interpreted consistent with the features set forth in appellants’ definition. Since the examiner has failed to address the term

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“form condition data” in a manner consistent with its definition in the specification, the examiner has failed to establish a prima facie case of anticipation.

We now consider the rejections of the claims under 35 U.S.C. § 103. 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). The examiner must articulate reasons for the examiner’s decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. at 1343, 61 USPQ2d at 1433-34. The examiner cannot simply reach conclusions based on the examiner’s own understanding or experience - or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner 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 examiner’s conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000)). See also In re Thrift, 298 F. 3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). 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.

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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 appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii) (2004)].

We consider first the rejection of claims 1-3, 5-7, 9-14, 16-18, and 22-24 based on Broomhall and Paradox. The examiner has indicated how the invention of these claims is deemed to be obvious over the teachings of the applied prior art [answer, pages 4-11]. As noted above, appellants essentially argue that based on definitions set forth in their specification for a “proxy applicant,” “form condition data,” and “a delegated application,” Broomhall fails to meet the invention of independent claims 1-3 and 9-14 [brief, pages 4-5].

As we noted above in our discussion of claim 20, we agree with the examiner that an external user in Broomhall can be considered a proxy applicant because the external user is sponsored by an internal user. We also agree with the examiner that the Lotus applications in Broomhall can be considered delegated applications as they are the only applications accessible to the external user. We do not agree, however, with the examiner’s position on the interpretation of “form condition data” for reasons discussed above. Since independent claims 1, 2, 9, 10, 12, and 13 all recite the use of “form condition data,” and since the examiner has not properly interpreted the meaning of this term for reasons discussed above, we do not sustain the examiner’s rejection of these independent claims or of any claims which depend therefrom. Independent claims 3, 11, and 14, however, do not claim the “form condition data.” Instead, they recite a “delegation term condition data” that relates to a term in which access is permitted by a proxy applicant. Although appellants argue that Broomhall

fails to teach this feature, we agree with the examiner that the teachings in the applied prior art of a password expiration date broadly meets the term “delegation term condition data.” We can find no definition in appellants’ specification which would preclude this interpretation. Therefore, we sustain the examiner’s rejection of independent claims 3, 11, and 14. Since appellants have not separately argued the rejection of dependent claims 4, 5, 15, and 16, the rejection of these claims that depend from claims 3 or 14 are also sustained.

With respect to dependent claims 6/5/4/3 and 17/16/14, appellants argue that the examiner admits that the applied prior art fails to teach the limitations of these claims, but the examiner finds obviousness anyway [brief, page 6]. The examiner responds that Paradox teaches displaying a list of forms, and it would have been obvious to the artisan to display the list of forms that a sponsor works for [answer, pages 13-14]. Appellants respond that these claims are not directed to displaying forms according to the organization that the sponsor works for. Appellants assert that the applied prior art actually teaches away from the claimed invention [reply brief, pages 4-5].

We will sustain the rejection of these claims. We agree with the examiner that the applications and forms made available to the proxy applicant would be determined by the application requester in Broomhall, and thereby, by the organization to which the application requester belongs.

With respect to dependent claims 7/5/4/3 and 18/16/14, appellants argue that a password is not equivalent to a flag and a password does not indicate that the user system access is enabled to the external user [brief, pages 6-7]. The examiner responds that the password of Broomhall is the id. or flag that tells the external user whether or not the corporate database application is enabled or could be accessed [answer, page 14]. Appellants respond that a password is not equivalent to a flag, and a password does not indicate that the user system access is enabled to the external user [reply brief, pages 5-6].

We will sustain the examiner’s rejection of these claims. The system of Broomhall must store the passwords of those proxy applicants who are allowed to access various applications and forms. The examiner’s position is that the acceptance or non-acceptance of

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an entered password serves to set a flag which allows entry or denies entry to the requested application or form. We agree with the examiner the invention of these claims is broad enough to be met by the teachings of the applied prior art.

We now consider the rejection of claims 4, 15, and 21 based on Broomhall, Paradox and Atlas. The examiner has indicated how the invention of these claims is deemed to be rendered obvious by the collective teachings of the applied prior art [answer, pages 11-12]. Appellants argue that Atlas does not qualify as prior art under 35 U.S.C. § 103(c) or overcome the deficiencies in the combination of Broomhall and Paradox [brief, page 8]. The examiner responds that Atlas qualifies as prior art because it has a publication date before appellants' filing date, and therefore, qualifies as prior art under 35 U.S.C. § 102(a) [answer, page 15].

As we noted above, the reference referred to as Atlas in the rejection has been improperly identified. The Atlas reference was issued on March 27, 2001, and therefore, does not qualify as prior art under 35 U.S.C. § 102(a). Therefore, the examiner's position that 35 U.S.C. § 103(c) is inapplicable for this reason is incorrect. Based on this record, we do not sustain the rejection of any claim that relies on Atlas (U. S. 6,208,339) as a prior art reference.

In summary, we have not sustained the examiner's rejection of independent claims 1, 2, 9, 10, 12, 13, and 20 or of any claims which depend therefrom. However, we have sustained the examiner's rejection of independent claims 3, 11, and 14 and of the claims which depend therefrom except for claims 4, 15, and 21. Therefore, the decision of the examiner rejecting claims 1-7, 9-18, and 20-24 is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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JERRY SMITH
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

MAHSHID D. SAADAT
Administrative Patent Judge

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KEVIN M. MASON
RYAN MASON & LEWIS LLP
90 FOREST AVENUE
LOCUST VALLEY, NY 11560