

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 TAKASHI MIYAMOTO and ARITO ASAII

Appeal No. 2006-2742
Application No. 10/115,138

ON BRIEF¹

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

SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. ' 134(a) from the Examiner=s final rejection of claims 1-10. The Examiner=s designation of claims 2 and 3 as objected to for being dependent upon a rejected base claim, but otherwise allowable if rewritten

¹ An October 17, 2006 oral hearing was deemed moot in view of the decision of this panel not to sustain the rejections under appeal. Appellants= representative was informed via a telephonic communication on October 12, 2006.

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in independent form including all of the limitations of the base claim and any intervening claims (answer, page 12), leaves only claims 1 and 4-10 before us on appeal.

We reverse.

BACKGROUND

Appellants= invention relates to a data registration system wherein user identification data from the user device is received in a server for determining whether the user is an authorized user. According to Appellants, a unique user identification is transmitted in a file along with a data file to the e-mail address included in the file. Upon receiving the data, the mail server registers the data and the unique identification data in association form so that tampering by an unauthorized party having an address not associated with the user identification may be prevented (specification, pages 4-6).

Representative independent claim 1 is reproduced below:

1. A data registration system comprising a portable electronic device, a database server and a mail server that are capable of communicating with one another, wherein user identification data for identifying a user of said portable electronic device is transmitted from said portable electronic device to said database server, said database server comprising:

a user identification data receiving unit for receiving user identification data transmitted from said portable electronic device;

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a determination unit for determining whether the user is an authorized user based upon the user identification data that has been received by said user identification data receiving unit;

a unique ID generating unit for generating a unique ID in response to a determination by said determination unit to the effect that the user is an authorized user;

a file generating unit for generating a file including an e-mail address, which includes the unique ID generated by said unique ID generating unit; and

a file transmitting unit for transmitting the file generated by said file generating unit, to said portable electronic device;

said portable electronic device comprises:

a file receiving unit for receiving the file transmitted from said file transmitting unit of said database server; and

a first registration-target data transmitting unit for transmitting data, which is to be registered in said database server, by e-mail to an e-mail address included in the file received by said file receiving unit; and

said mail server comprises a registration-target data receiving unit for receiving data transmitted by e-mail from said first registration-target data transmitting unit of said portable electronic device.

The Examiner relies on the following references in rejecting the claims:

U.S. Patents

Talati et al. (Talati)	5,903,878	May 11, 1999
Speicher	5,996,006	Nov. 30, 1999
Herman et al. (Herman)	6,341,353	Jan. 22, 2002 (filed Dec. 10, 1999)

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Published U.S. Patent Application

Thompson US 2002/0116381 A1 Aug. 22, 2002
(filed Feb. 22, 2001)

Claims 7 and 10 stand rejected under the second paragraph of 35 U.S.C. ' 112 as being indefinite.

Claims 1 and 5-8 stand rejected under 35 U.S.C. ' 102(b) as being anticipated by Talati.

Claim 4 stands rejected under 35 U.S.C. ' 103(a) as being unpatentable over Talati and Speicher.

Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Talati and Herman.

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Talati and Thompson.

Rather than reiterate the opposing arguments, reference is made to the briefs and answer for the respective positions of Appellants and the Examiner.

OPINION

With respect to the rejection of the claims under the second paragraph of 35 U.S.C. ' 112, the Examiner questions the clarity of claim 7 reciting the term A generating a file including an e-mail address, which has the generated unique@ and assumes that it should refer to A the generated unique ID@ (answer, page 3).

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Regarding claim 10, the Examiner asserts that it cannot be determined what constitutes the response of erasing the unique ID in the step of erasing the unique ID (answer, page 4).

Appellants argue that the clause Awhich has the generated unique ID@ clarifies Ae-mail address@ and therefore does not make claim 7 indefinite (brief, page 7). Appellants further argue that claim 10 is definite since the recited erasing device clearly erases in response to the memorization taking place at the user identification/registration-target data memory device (brief, pages 7-8; reply brief, pages 3-4).

Analysis of 35 U.S.C. ' 112, second paragraph, should begin with the determination of whether claims set out and circumscribe the particular area with a reasonable degree of precision and particularity; it is here where definiteness of the language must be analyzed, not in a vacuum, but always in light of teachings of the disclosure as it would be interpreted by one possessing ordinary skill in the art. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977), citing In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (1971). ATThe legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. @ In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

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Upon a careful review of the claim language and the specification (page 14, lines 4-11; step 45 in Figure 5), we find that Athe generated unique ID,@ as recited in claim 7, clearly refers to the unique ID included in the e-mail address.² Regarding claim 10, we also agree with Appellants that erasing the unique ID in response to memorized data is definite since memorization of the user identification and registration-target data at the user identification/registration-target data memory device is clearly recited. In view of the above and in light of the specification as a whole, we find that the recited features in claims 7 and 10 are sufficiently defined and would reasonably apprise those skilled in the art of the scope of these limitations. Accordingly, we will not sustain the rejection of claims 7 and 10 under the second paragraph of 35 U.S.C. ' 112.

With respect to the 35 U.S.C. ' 102 rejection of claims 1 and 5-8, Appellants assert that Talati cannot teach all the claimed elements since element 331, as depicted in Figure 12,

² We observe that Appellants= amendment to the claim, filed July 7, 2005 after the final rejection and adding the term AID@ to the above-mentioned portion of claim 7 as later proposed by the Examiner (answer, page 3), overcame an earlier rejection under 35 U.S.C. ' 112.

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does not represent the unique ID included in an e-mail address (brief, pages 10-13). Appellants further argue that the rejection is apparently predicated upon interpreting the recited Afile including an e-mail address, which includes the unique ID generated@ as meaning that the file includes the unique ID and the file includes the e-mail address (brief, page 14). Appellants, however, point out that the correct interpretation of the claim based on proper rules of grammar requires the generated unique ID be included in the e-mail address, and not in the file that also includes the e-mail address, as suggested by the Examiner (brief, pages 14-15).

The Examiner responds by asserting that the claims do not require that the e-mail address include the unique ID generated by the unique ID generating unit (answer, page 15). Relying on Figure 12 of Talati, the Examiner concludes that the e-mail record of Talati is a file that also includes an e-mail address and a unique transaction identifier (id.).

A rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed

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in a single prior art reference. See *Atlas Powder Co. v. IRECO Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1946-47 (Fed. Cir. 1999); In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994). Here, we agree with Appellants that this requirement can be met only if the claims are interpreted in the way suggested by the Examiner. As discussed above with respect to the 35 U.S.C. ' 112 rejection of claim 7 and after a review of the claim language and the specification, we remain unconvinced by the Examiner=s position that the claims are limited to an e-mail address and a unique ID that are both included in a file. As argued by Appellants (brief, page 14; reply brief, page 5), the unique ID is clearly required to be included in the e-mail address, while the e-mail address, in turn, is included in the file generated by the file generating unit.

In view of our analysis above, we find that Talati cannot *prima facie* anticipate the claimed subject matter since the reference fails to teach all the limitations of claims 1 and 5-8. Accordingly, the 35 U.S.C. ' 102 rejection of claims 1 and 5-8 over Talati cannot be sustained.

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Turning now to the 35 U.S.C. ' 103 rejection of the remaining claims, we note that the Examiner further relies on Speicher, Herman and Thompson for rejecting claims 4, 9 and 10, respectively. We observe that claims 4 and 9 are dependent upon claim 1 while claim 10, similar to claim 1, requires detecting the unique ID from the e-mail address. Since the unique ID of Talati is not included in the e-mail address, as argued by Appellants (brief, page 37), and the Examiner has pointed to no additional teachings in these prior art references related to a unique ID included in an e-mail address that would have overcome the deficiencies of Talati as discussed above with respect to claims 1 and 5-8, the 35 U.S.C. ' 103 rejection of claim 4 over Talati and Speicher, of claim 9 over Talati and Herman and of claim 10 over Talati and Thompson cannot be sustained.

CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 7 and 10 under the second paragraph of 35 U.S.C. § 112, claims 1 and 5-8 under 35 U.S.C. ' 102 and claims 4, 9 and 10 under 35 U.S.C. ' 103 is reversed.

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REVERSED

JAMES D. THOMAS)
Administrative Patent Judge)
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) BOARD OF PATENT
JOSEPH F. RUGGIERO) APPEALS
Administrative Patent Judge) AND
) INTERFERENCES
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