

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* HIROYUKI SEKITANI

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Appeal 2006-3294  
Application 09/880,036  
Technology Center 3600

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Decided: November 30, 2007

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Before HUBERT C. LORIN, ANTON W. FETTING, and DAVID B. WALKER,  
*Administrative Patent Judges.*

FETTING, *Administrative Patent Judge.*

DECISION ON APPEAL

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STATEMENT OF CASE

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Hiroyuki Sekitani (Appellant) seeks review under 35 U.S.C. § 134 of a Final  
4 rejection of claims 1-3, the only claims pending in the application on appeal.

5

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

1 We REVERSE and ENTER A NEW GROUND OF REJECTION UNDER  
2 37 C.F.R. § 41.50(b).

3 The Appellant invented a part retrieving system for production machines  
4 utilizing a network, the system allowing a user to easily obtain part identifying  
5 information such as part numbers when, for example, replacing defective or  
6 consumed parts with new ones for production machines such as punch presses or  
7 lathes (Specification 1:First ¶)).

8 An understanding of the invention can be derived from a reading of exemplary  
9 claim 1, which is reproduced in the Analysis section below.

10 This appeal arises from the Examiner's Final Rejection, mailed September 15,  
11 2005. The Appellant filed an Appeal Brief in support of the appeal on March 3,  
12 2006. An Examiner's Answer to the Appeal Brief was mailed on May 1, 2006. A  
13 Reply Brief was filed on May 24, 2006. The Appellant presented oral arguments  
14 at a hearing on November 15, 2007.

15 PRIOR ART

16 The Examiner relies upon the following prior art:

Calloway 5,146,404 Sep. 8, 1992

17 We also discuss the following prior art:

Shiiba 6,629,008 B2 Sep. 30, 2003

18 Alex Berson, Client/Server Architecture, 1992, pp. 48-49

19 REJECTION

20 Claims 1-3 stand rejected under 35 U.S.C. § 102(b) as anticipated by Calloway.

ISSUES

The issue pertinent to this appeal is

- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1-3 under 35 U.S.C. § 102(b) as anticipated by Calloway.

The pertinent issue turns on whether Calloway's terminal transmits part information to a database bidirectionally with a network.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

*Calloway*

01. Calloway is directed to an electronic maintenance support (EMS) work station with one screen for displaying text information related to, and another screen for displaying graphic illustrations of, various assemblies, subassemblies and parts of a product serviced by the station. The EMS work station stores text files containing static data associated with a product assembly, subassembly or part at a particular level of a hierarchical organization of the product structure. Each text file is linked with a corresponding graphic. User selections are made relative to the text screen or the graphic screen. The work station detects calls for text or graphics and retrieves and displays the called text files or graphics and its linked counterpart. The work station display sequences through the product hierarchy as part selections are made from the graphic

1 screen, enabling the product structure to be searched for an assembly,  
2 subassembly or part needed for maintenance purposes. The work station  
3 identifies a text field item selection and graphically indicates on the  
4 graphic screen the assembly, subassembly or part corresponding to the  
5 identified text field item (Calloway 2:7-38).

6 02. As shown in FIG. 1B, the work station operation is controlled by one  
7 or more digital computers 24. The computer 24 is programmed to  
8 perform various functions shown in FIG. 1 and to interface with other  
9 hardware in controlling the operation of the EMS work station. The  
10 computer 24 accordingly interfaces with operator controls including an  
11 alphanumeric input device such as a keyboard 20 or a bar code reader  
12 (not shown), the graphics screen 14 through video/graphics hardware 22,  
13 the text screen through the video display interface hardware 22 which in  
14 some cases may be conventional or in other cases may be modified as  
15 indicated in the patent application identified below, a central computer  
16 26 (FIG. 1A) for communications, order entry, and the order entry  
17 functions described below, and input selector devices such as interfacing  
18 employed for screen pad selectors, interfacing for a mouse selector, etc.  
19 according to the particular selector scheme employed in the work station  
20 (Calloway 3:49-67).

21 03. If direct entry is chosen as indicated by block 52, the keyboard 20  
22 (FIG. 1A) is used to enter the supplier's part number or customer's stock  
23 number as indicated by blocks 54 and 56. A routine in the  
24 graphics/keyboard monitor program 32 (FIG. 1A) then searches the part  
25 files 37 for the entered part number as indicated by block 58. If a

1 customer stock number has been entered, cross indexing is first used to  
2 identify the part number (Calloway 4:42-49).

3 04. Once the part record is found for the entered part number, i.e., file, a  
4 frame number for a corresponding graphic is obtained from the part  
5 record and the part record data is displayed on the text screen 12 and the  
6 graphic is displayed on the graphics screen 14. The video disk drive and  
7 control 16 (FIG. 1A) is operated to find the identified disk frame on the  
8 laser video disk 15 and retrieve the graphic for display on the graphics  
9 screen 14 through the interface hardware 22 and graphics display 23.  
10 Part record data is displayed on the text screen 12 through display text  
11 block 33 (Calloway 4:50-60).

12 05. When a standard search has been selected by the user as indicated by  
13 block 64 in FIG. 2A, the system generally operates under user control to  
14 scroll through the hierarchical data structure for the various assemblies,  
15 subassemblies and parts until the number for the needed part(s) is  
16 identified by the user. Generally, scrolling through the hierarchical data  
17 results in assembly explosion or breakdown as the search is narrowed to  
18 the particular subassembly or part that is needed (Calloway 4:66-5:6).

19 06. Hierarchical branching is achieved by pointing at the graphic screen  
20 14 with the select device 30 to select an area of a displayed graphic to be  
21 enlarged, i.e., exploded as successively indicated in FIGS. 3D to 3F,  
22 through call-up of the next lower level graphic for that area. Operation of  
23 the select device 30 results in generation of an interrupt as indicated by  
24 block 66 and the monitor program 32 (FIG. 1A), including its graphics

1 screen sequence 70, is executed in response to this input (Calloway 5:7-  
2 15).

3 07. If the text screen 12 is activated by the selector 39, an interrupt is  
4 generated and a text screen sequence 68 of programmed steps is  
5 executed to highlight the activated text and to identify the highlighted  
6 text item on the graphics screen 14 (Calloway 5:16-20).

7 08. As shown in corresponding parts of the functional block diagram of  
8 FIG. 1A, a text screen line detector 40 responds to the line selector  
9 signals to call for line highlighting by block 41 and for graphics  
10 targeting through target program 42. The text files 18 are checked by the  
11 target program 42 to identify the target coordinates in box 43. An  
12 overlay is defined by the coordinates to enclose and thereby identify the  
13 selected item on the graphics screen 14. Video interface hardware 22 and  
14 a conventional overlay display software package 25 operate to produce  
15 the target indicator at the defined location on the graphics screen 14  
16 (Calloway 5:30-46).

17 09. Generally, enough coordinate points are identified to enable an  
18 identifier or overlay, and preferably an identifier overlay enclosure line,  
19 to be displayed around the item on the graphic display. In this case, two  
20 coordinate points are stored in the text file 18 for each line item, and for  
21 each unit of the line item in the graphic, in correspondence to the  
22 location(s) of the item in the graphic. The two points define opposite  
23 corners of a rectangle so that a rectangular overlay enclosure is specified  
24 in size and location to form a target enclosure about the text screen  
25 selected item on the graphics screen 14 (Calloway 5:47-58).



1 must be done with reasonable clarity, deliberateness, and precision; where an  
2 inventor chooses to give terms uncommon meanings, the inventor must set out any  
3 uncommon definition in some manner within the patent disclosure so as to give  
4 one of ordinary skill in the art notice of the change).

5 *Anticipation*

6 "A claim is anticipated only if each and every element as set forth in the claim  
7 is found, either expressly or inherently described, in a single prior art reference."  
8 *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir.  
9 1987). "When a claim covers several structures or compositions, either generically  
10 or as alternatives, the claim is deemed anticipated if any of the structures or  
11 compositions within the scope of the claim is known in the prior art." *Brown v.*  
12 *3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001). "The identical invention must be  
13 shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki*  
14 *Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). The elements must be arranged  
15 as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of  
16 terminology is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

17 ANALYSIS

18 *Claims 1-3 rejected under 35 U.S.C. § 102(b) as anticipated by Calloway.*

19 The Appellant argue these claims as a group.

20 Accordingly, we select claim 1 as representative of the group.

21 37 C.F.R. § 41.37(c)(1)(vii) (2006).

22 The Examiner found that Calloway anticipates claim 1, which is reproduced  
23 below [bracketed matter and some paragraphing added] as follows:

1 1. A part retrieving system for production machines utilizing a  
2 network, the system being characterized in that the system comprises:

3 [1] a part database (Calloway, Fig. 1A:37) and

4 [2] a terminal (Calloway, Fig. 1B)

5 connected to the part database via a communication network for  
6 bidirectional communications with the part database (Calloway,  
7 Fig. 1B),

8 said part database has information on parts accumulated therein  
9 (Calloway, Fig. 2B),

10 the parts constituting each of production machines having  
11 different specifications (Calloway, Fig. 3A), and

12 said terminal comprises:

13 [a] part information requesting means for requesting said  
14 part database to transmit the part information (Calloway,  
15 Fig. 2A),

16 [b] storage means for storing the part information  
17 transmitted in response to said transmission request  
18 (Calloway, Fig. 1B),

19 [c] retrieval means for retrieving parts from the stored  
20 part information depending on retrieval conditions  
21 (Calloway, Fig. 2A), and

22 [d] ordering means for creating order information  
23 depending on the result of the retrieval by said retrieval  
24 means (Calloway, Fig. 2C).

25 Answer 3-4.

26 The Appellant contends that Calloway does not disclose "a terminal connected  
27 to the part database via a connection network for bidirectional communication with  
28 the part database," as required by claim 1 (Appeal Br. 9:Second full ¶). Based on  
29 the disclosure of Calloway, the Appellant argues that the elements within Fig. 1B's  
30 dotted line (text screen 12, video/graphics screen 14, video/graphics interface  
31 hardware 22, audio, local database, work station computer 24, video disk 15 and

1 modem) are hardware components of the EMS workstation 10. Work station  
2 computer 24 "interfaces with" the text screen 12, video/graphics screen 14, and  
3 video display interface hardware 22 (Appeal Br. 7:Bottom ¶ - 8:Top ¶).

4 The Examiner found that in reference to Fig. 1B of Calloway, the Local  
5 Database is clearly detached from the workstation computer. Since the database is  
6 detached the Examiner found that a connection such as a hard wire is required to  
7 connect the two devices. The Examiner found that a network is defined as a group  
8 of computers and associated devices that are connected by communications  
9 facilities. The Examiner further found that there are at least two computers in  
10 Calloway and the database is a device connected over the network that is the  
11 database, work station and central computer (Answer 5:¶ numbered 3).

12 The Appellant argues that the elements within the dotted line in Figure 1B are  
13 hardware components of the EMS workstation 10, connected by a bus. The  
14 Appellant contends that, while these components may or may not be connected  
15 using hardwires, such a connection would not be a network. The Appellant argues  
16 that the components within the dotted line of Calloway, Fig. 1B are simply  
17 peripherals which one having ordinary skill in the art would understand as being  
18 connected by a bus, not a network. Taking the definition proffered by the  
19 Examiner, that a network is "a group of computers and associated devices that are  
20 connected by communications facilities," the Appellant contends that in Calloway  
21 Fig. 1B, the components of an EMS workstation (contained within the dotted line),  
22 are linked via a bus, not a network (Reply Br. 3-4).

23 We find that all of the claim 1 limitations other than that of the terminal being  
24 connected to the database by a bidirectional network are met by Calloway as found  
25 by the Examiner (FF 01 - 10). This finding is uncontested by the Appellant.

1 We find that the Appellant is correct that the database in Calloway's Fig. 1B is  
2 a component of the EMS work station. For example, the components also include  
3 a keyboard and display (FF 02). Such components would indeed be connected by  
4 a bus. Therefore, we find that the database shown in Calloway, Fig. 1B, is on a  
5 memory that is similarly connected by a bus to the CPU within the work station.  
6 Thus, the database is not connected by a bidirectional network to Hallway's  
7 work station computer, which is where part information is entered, as required by  
8 claim 1.

9 The Appellant has sustained its burden of showing that the Examiner erred in  
10 rejecting claims 1-3 under 35 U.S.C. § 102(b) as anticipated by Calloway.

#### 11 NEW GROUND OF REJECTION

12 The following new ground of rejection is entered pursuant to  
13 37 C.F.R. § 41.50(b). Claims 1-3 are rejected under 35 U.S.C. § 103(a) as  
14 unpatentable over Calloway, Shiiba and Berson.

15 We find the following additional facts (FF) related to Shiiba and Berson.

#### 16 *Shiiba*

17 11. Shiiba is directed to a production control system capable of preventing  
18 the stock of products from increasing or lacking when actual sales results  
19 are against demand by producing products with the specifications  
20 required by the client met in the ordered number, directly reflecting  
21 information of customers' orders on production, and sharing necessary  
22 information among a customer, a factory and a parts manufacturer  
23 (Shiiba 2:33-44).



1 combination of familiar elements according to known methods is likely to be  
2 obvious when it does no more than yield predictable results.” *KSR*, at 1739.

3 “When a work is available in one field of endeavor, design incentives and  
4 other market forces can prompt variations of it, either in the same field or in a  
5 different one. If a person of ordinary skill in the art can implement a predictable  
6 variation, § 103 likely bars its patentability.” *Id.* at 1740.

7 “For the same reason, if a technique has been used to improve one device,  
8 and a person of ordinary skill in the art would recognize that it would improve  
9 similar devices in the same way, using the technique is obvious unless its actual  
10 application is beyond his or her skill.” *Id.*

11 “Under the correct analysis, any need or problem known in the field of  
12 endeavor at the time of invention and addressed by the patent can provide a reason  
13 for combining the elements in the manner claimed.” *Id.* at 1742.

#### 14 ADDITIONAL ANALYSIS

15 The only issue under contention as to whether Calloway alone anticipates  
16 claims 1 – 3 is whether Calloway’s terminal communicates bidirectionally with its  
17 database. We found, *supra*, that it does not. However the use of a database server  
18 controlled by a separate computer, bidirectionally communicating with the  
19 application process, to administer a database as in Calloway is notoriously well  
20 known. As an example, Shiiba uses a database server for various kinds of master  
21 data access (FF 12) in a manufacturing environment analogous to that of Calloway  
22 (FF 11). Berson is a treatise on servers, such as database servers, and describes  
23 considerations that would lead one of ordinary skill to use a database server such  
24 as in the manufacturing environments of both Shiiba and Calloway. Such

1 considerations were to share the computer workload and data among multiple  
2 computers and improve data integrity, both of which would be important to  
3 maintaining data integrity and availability in the manufacturing environments of  
4 both Shiiba and Calloway. Since servers respond to requests for service, the  
5 servers are connected by bidirectional network paths (FF 13).

6 Thus, it would have been obvious to a person of ordinary skill in the art to have  
7 attached Calloway's database to Calloway's workstation by using a database server  
8 as in Shiiba for the purposes related by Berson of maintaining data integrity and  
9 availability. Since none of the Examiner's findings regarding claims 2 and 3 are  
10 contested, we adopt the Examiner's findings in support of the rejection of those  
11 claims.

#### 12 CONCLUSIONS OF LAW

13 The Appellant has sustained its burden of showing that the Examiner erred in  
14 rejecting claims 1-3 under 35 U.S.C. § 102(b) as anticipated by the prior art.

15 We enter a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) of claims  
16 1-3 under 35 U.S.C. § 103(a) as being unpatentable over Calloway, Shiiba and  
17 Berson.

#### 18 DECISION

19 To summarize, our decision is as follows:

- 20 • The rejection of claims 1-3 under 35 U.S.C. § 102(b) as anticipated by  
21 Calloway is not sustained.
- 22 • The following new ground of rejection is entered pursuant to 37 C.F.R.  
23 § 41.50(b).

- Claims 1-3 are rejected under 35 U.S.C. § 103(a) as unpatentable over Calloway, Shiiba and Berson.

### CONCLUSION

This decision contains new grounds of rejection pursuant to 37 CFR § 41.50(b). 37 CFR § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 CFR § 41.50 (b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner . . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record . . . .

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

REVERSED  
37 C.F.R. § 41.50(b)

vsh

Appeal 2006-3294  
Application 09/880,036

1 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP  
2 1250 CONNECTICUT AVENUE, NW  
3 SUITE 700  
4 WASHINGTON DC 20036