The opinion in support of the decision being
entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TANYA COUCH and DEBRA L. MAYHEW

Appeal 2007-0559
Application 10/037,659[1]
Technology Center 2164

Decided: April 30, 2007

Before JAMESON LEE, RICHARD TORCZON and JAMES T. MOORE, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

DECISION ON APPEAL

A. Statement of the Case

This is a decision on appeal by an applicant under 35 U.S.C. § 134(a) from a rejection of claims 1-90 of Application 10/037,659. We have jurisdiction under 35 U.S.C. § 6(b).

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[1] Filed January 2, 2002. The real party in interest is International Business Machines Corp.

REFERENCE RELIED ON BY THE EXAMINER

Demers	US 5,870,761	Feb. 9, 1999
Drexler	US Pub. App. 2002/0046248 A1	Apr. 18, 2002
Poskanzer	US 6,658,426 B1	Dec. 2, 2003
Huth	US 6,704,742 B1	Mar. 9, 2004

THE REJECTION ON APPEAL

The Examiner rejected claims 1-5, 10-12, 14-17, 22-24, 26-31, 36-38, 40-43, 48-50, 52-58, 64-65, and 67-90 under 35 U.S.C. § 102 as anticipated by Drexler.

The Examiner rejected claims 6-9, 32-35, and 59-63 under 35 U.S.C. § 103 as unpatentable over the combined teachings of Drexler and Demers.

The Examiner rejected claims 13 and 39 under 35 U.S.C. § 103 as unpatentable over the combined teachings of Drexler and Huth.

The Examiner rejected claims 18-21, 25, 44-47, 51, and 66 under 35 U.S.C. § 103 as unpatentable over Drexler and Poskanzer.

B. Issues

Has the applicant shown error in the anticipation rejection of claims 1-5, 10-12, 14-17, 22-24, 26-31, 36-38, 40-43, 48-50, 52-58, 64-65, and 67-90 under 35 U.S.C. § 102 as anticipated by Drexler?

Has the applicant shown error in the obviousness rejection of claims 6-9, 32-35, and 59-63 under 35 U.S.C. § 103 as unpatentable over the combined teachings of Drexler and Demers?

Has the applicant shown error in the obviousness rejection of claims 13 and 39 under 35 U.S.C. § 103 as unpatentable over the combined teachings of Drexler and Huth?

Has the applicant shown error in the obviousness rejection of claims 18-21, 25, 44-47, 51, and 66 under 35 U.S.C. § 103 as unpatentable over the combined teachings of Drexler and Poskanzer?

C. Summary of the Decision

The applicant has shown error in the rejection of all claims 1-90.

D Findings of Fact (Referenced as FF. ¶ No.)

1. The independent claims are claims 1, 27, 53, 67, 75, and 83.

2. Claim 1 recites a method for converting messaging data into a relational table format in a database system, including a step for utilizing a plurality of table formatting specifications to automatically build and store a table function in the database system.

3. Claim 27 recites a computer readable medium containing programming instructions for converting messaging data into a relational table format in a database system, and specifies a series of functions performed by the programming instructions, including utilizing a plurality of table formatting specifications to automatically build and store a table function in the database system.

4. Claim 53 recites a system for converting messaging data into a relational table format in a database system, comprising several components including a table function building application to automatically build and store a table function in the database system.

5. Each of claims 1, 27, and 53 further recites the requirement of invoking the stored table function from within the database system to access messaging data within a messaging system.

6. Claim 67 recites a system for generating a customized invocation system including a software module for building an invocation system and storing the invocation system in a database.

7. Claim 75 recites a method for generating a customized invocation mechanism including the step of building an invocation system and storing the invocation system in a database.

8. Claim 83 recites a program containing executable instructions which embody a method including the step of building an invocation mechanism and storing the invocation mechanism in a database.

9. Each of claims 67, 75, and 83 further recites the requirement of the stored invocation mechanism being invocable by the database for accessing data external to the database.

10. All of the independent claims 1, 27, 53, 67, 75, and 83 have been rejected as anticipated by Drexler.

11. In the Background portion of the specification (at 4: 2-7), it is described that of particular interest in today's computing environment are relational database applications and it is stated:

> Relational Database Management System (RDBMS) software using a Structured Query Language (SQL) interface is well known in the art. The SQL interface has evolved into a standard language for RDBMS software and has been adopted as such by both the American Nationals Standard Organization (ANSI) and the International Standards Organization (ISO).

12. In the Background portion of the specification (at 4: 8-14), it is further described:

> In RDBMS software, all data is externally structured into tables. The SQL interface allows users to formulate relational operations on the tables either interactively, in batch files, or embedded in host languages such as C, COBOL, etc. Operators are provided in SQL that allow the user to manipulate the data, wherein each operator operates on either one or two tables and produces a new table as a result. The power of SQL lies on its ability to link information from multiple tables or views together to perform complex sets of procedures with a single statement.

13. In the Background portion of the specification (at 4: 15-22), reference is made to application 09/731,088, the disclosure of which is incorporated by reference into the appellants' specification, and it is described that in the system disclosed therein message queuing functions are integrated with database operations to combine message queuing communications and database access and that the messaging functions are invoked by SQL statements.

14. In the Background portion of the specification (at 5: 1-11), it is described that in the system disclosed in application 09/731,088, the messaging data returned to a client is in the same format as it is in the messaging system and therefore the client must perform several operations on the message string to put it in a format usable by the database system. It is stated that a user would have to write a conversion code within an application program or create additional user defined functions to perform the conversion within an SQL statement.

15. Based on earlier description in the Background portion of the specification, the Background portion ends with the following paragraph (Specification 5: 13-18):

> Accordingly, **a need exists** for accessing messaging data and **automatically converting** that data into relational table format. The method and system also should allow the client to perform database operations on the messaging data in a single SQL statement. **The present invention addresses such a need**. (Emphasis added)

16. In the Summary portion of the specification, it is stated (at 6: 10-13): "The user is no longer required to perform conversion steps because the conversion is automatically performed by the table function."

17. Drexler discloses a system in which data from an e-mail message is transferred to locations such as records, tables, and/or fields of a database. (Drexler, 1, ¶ 5)

18. In Drexler's system, as is illustrated in its Figure 1, a utility program called "email to database import utility program" 40 is provided which has access to an association 60 and a database 80. (Drexler, 2, ¶ 25)

19. In Drexler on page 2, Paragraph No. 28 reads as follows:

> The email to database import utility program 40 preferably receives the email message 10 as shown at 20. The utility program 40 uses an association 60 to associate and save certain data from the email message 10 to appropriate records, tables or fields in the database 80. The utility program 40 preferably determines whether data from the email message 10 should be saved to the database 80, and the association 60 identifies which data from the email message 10 is to be saved, and which fields the data is to be saved in the database 80. These determinations by the utility program 40 and/or the association 60 are further explained below.

20. In Drexler on page 2, it is described in Paragraph No. 28 that database 80 may be a commercially available or privately created program.

21. In Drexler's disclosure, neither the email to database utility program 40 nor the association 60 is described as being any constituent part of the database program 80.

E. Principles of law

To establish anticipation under 35 U.S.C. § 102, each and every element in a claim, arranged as is recited in the claim, must be found in a single prior art reference. *Karsten Manufacturing Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001). Anticipation can be found when a claim limitation is inherent or otherwise implicit in the relevant reference. *Standard Havens Products, Inc. v. Gencor Industries, Inc.*, 953 F.2d 1360, 1369, 21 USPQ2d 1321, 1328 (Fed. Cir. 1991). But for establishing inherency, that which is missing in the express description must necessarily be present and would be so recognized by one with ordinary skill in the art. *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

F. Analysis

The Anticipation rejection of Claims 1-5, 10-12, 14-17, 22-24, 26-31, 36-38, 40-43, 48-50, 52-58, 64-65, and 67-90 over Drexler

The claim limitations central to this appeal are the one in independent claims 1, 27, and 53, specifying storing of a table function in the database system, and the one in independent claims 67, 75, and 83, specifying storing of the built invocation mechanism in the database. In other words, the table function of claims 1, 27, and 53 is stored in the underlying database system, and the invocation mechanism of claims 67, 75, and 83 is stored in the underlying database. According to the appellant, such a feature is important because it permits the table function and the

invocation mechanism to be accessed or invoked by a "standard query language statement" understood by the database or database system; and thus a separate application program is not necessary to use the table function and invocation mechanism. Each of claims 1, 27, and 53 requires "invoking the table function from within the database system to access the messaging data," and each of claims 67, 75, and 83 requires "wherein the invocation mechanism is invocable by the database for accessing data external to the database."

For illustrative purposes, claims 1 and 67 are reproduced below:

> 1. A method for converting messaging data into a relational table format in a database system, wherein the messaging data is within a messaging system, the method comprising the steps of:
>
> (a) providing a plurality of table formatting specifications;
>
> (b) utilizing the plurality of table formatting specifications to automatically build and store a table function in the database system;
>
> (c) invoking the table function from within the database system to access the messaging data; and
>
> (d) converting the messaging data by the table function into specific data types according to the plurality of table formatting specifications, wherein the messaging data is transformed into the relational table format.
>
> 67. A system for generating a customized invocation mechanism, comprising:
>
> an interface for receiving customizations; and
>
> a software module coupled to the interface for building an invocation mechanism based on the customization specifications and storing the invocation mechanism in a database, wherein the

> invocation mechanism is invokable by the database for accessing data external to the database.

We agree with the gist, not the entirety, of the appellants' assertion. Nothing in any of the claims on appeal requires the database to support a "standard" structured query language (SQL) statement. Although for relational database systems structured query language (SQL) may have evolved into a "standard" interface recognized by the American Nationals Standard Organization (ANSI) and the International Standards Organization (ISO) as the appellants represent, that does not mean a relational database must use structured query language statements for accessing stored information. Nonetheless, that distinction is without significance here. We agree with the appellants that both (1) storing a table function within the database and invoking it from within the database, and (2) storing an invocation mechanism in the database and invoking it from within the database mean that the query language of the database is operative to invoke the table function or the invocation mechanism, as the case may be, without need for reliance on an external program. In that regard, we note that the one problem described by the appellants as associated with acknowledged prior art database is that a user using the prior art database to access messaging data has to rely on an external program, or additional user defined functions, rather than the preexisting query language of the database (FF. 14).

The appellants argue that Drexler does not store a table function in the database system, as is recited in claims 1, 27, and 53, and also does not store the invocation mechanism in the database, as is recited in claims 67, 75, and 83. Specifically, the appellants state the following: (Substitute Appeal Br. at 11):

> In Drexler, FIG. 1 shows that the Email to Database Import Program 40, the database association 60, and database 80 are separate components (¶¶0025-0027). There is no teaching or suggestion that the association 60 is stored in the database/database system, as recited in claims 1, 27, 53, 67, 75 and 83. In fact, Drexler explicitly states that the associations 60 can be found in "memory files, such as those on a floppy diskette, on the computer's hard drive, or a network hard drive." (¶0041).

The table function of claims 1, 27 and 53, and the invocation mechanism of claims 67, 75, and 83 are implemented in Drexler, if at all, collectively by the Email to Database Import Utility Program 40 and the Association 60. Independent claims 1, 27 and 53 expressly require that the table function be stored within the database system and invoked from within the database system. Independent claims 67, 75, and 83 expressly require that the invocation mechanism be stored within the database and invoked from within the database. The burden is on the Examiner to establish at least a prima facie case that in Drexler the Email to Database Import Utility Program 40 and the Association 60 are stored within a database or database system and invoked from within the database or database system.[2]

We look to the Examiner's stated rationale. According to the Examiner, the entire computer system on which a database program is implemented can be reasonably called the database, including parts thereof which are not used or controlled by the database program. In other words, the database or database

[2] Although the term "database" is technically broad enough to mean solely a collection of data, and not necessarily the hardware and/or software that together maintain and manage the data, the appellants have used the term in their specification interchangeably with "database system" such that both terms mean "database system" and "database" is merely a short-hand for "database system" which includes the supporting hardware and/or software.

system is "the system that includes the *hardware* that performs the action of storing data; the instructions, software, or programs running on the hardware that cause it to perform the action of storing data; and the hardware that actually does the data storing" (Advisory Action, at 2) (Emphasis in original). Per the Examiner's view, if the Association 60 is stored on the same computer system as that on which the database program is implemented then it is by definition stored in the database, and invoked from within the database. The Examiner states (Answer, Section 10(c)): "Since the associations used by the program in Drexler reference can be found 'in memory files such as those on a floppy diskette, on the computers hard drive, or a network hard drive' (see Drexler paragraph 0041), these associations being part of the import program are part of the database and are stored in the database." The rationale is insensible, illogical, and plainly incorrect. It is wholly unreasonable to regard all parts of a computer system as the database, where the database is but merely one of many programs implemented on the computer. The Examiner's position not just blurs but eliminates all distinctions among separate programs implemented on one computer system or server.

In any event, we have determined that the claim limitations are such that the query language of the database must support direct access to the table function or the invocation mechanism, as the case may be. The Examiner has not demonstrated that that is the case with Drexler's system. The Examiner has shown no basis to regard Email to Database Import Utility Program 40 of Drexler, which makes use of Association 60, as sharing a query language with database 80. We have been shown no proper reason to regard database 80 as including the Email to

Database Import Utility Program 40. The appellants correctly state the following (Substitute Appeal Br. 14: 5-10):

> . . . while the database system can reside in the computer system, the computer system and the database system are not one and the same. Thus, using a utility application program in the computer system to invoke the association is not equivalent to invoking the association "from within the database system," as recited in claims 1, 27 and 53, and having an association that is invokable by the application program is not equivalent to an "invocation mechanism [that] is invokable by the database," as recited in claims 67, 75 and 83.

We reject the Examiner's position that because a typical database program is comprised of a collection of programs or program modules, it follows that the Email to Database Import Utility Program 40 can be regarded as a part of the database 80 in Drexler. The Examiner must articulate some rational basis for regarding utility program 40 as a program within database 80. That has not been done here. Utility program 40, as described by Drexler, appears to be independent of database 80 and operates on its own without control or influence from database 80. The Examiner has not demonstrated anything to the contrary. The question is not whether Email to Database Utility Program 40 of Drexler qualifies in some general manner as a database management program but whether it is in the same program as database 80 in Drexler.

For all of the foregoing reasons, the Examiner has not shown that Drexler discloses a system including each and every element of claim 1, claim 27, or claim 53, or claim 67, claim 75, or claim 83. Because each dependent claim includes all the features of the claim on which it depends, the Examiner also has not shown that Drexler discloses a system including each and every element of any of claims 1-5, 10-12, 14-17, 22-24, 26-31, 36-38, 40-43, 48-50, 52-58, 64-65, and 67-90.

The Obviousness Rejection of Claims 6-9, 32-35, and 59-63 over Drexler and Demers

Claims 6-9, 32-35, and 59-63 are each dependent claims. As applied by the Examiner, Demers has been relied upon to account for the additional limitations appearing in the dependent claims and does not make up for the above-noted deficiencies of Drexler with regard to independent claims 1, 27, and 53. Accordingly, the Examiner has not shown that claims 6-9, 32-35, and 59-63 are unpatentable under 35 U.S.C. § 103 over the combined teachings of Drexler and Demers.

The Obviousness Rejection of Claims 13 and 39 over Drexler and Huth

Claim 13 depends indirectly from independent claim 1. Claim 39 depends indirectly from independent claim 27. As applied by the Examiner, Huth has been relied upon to account for the additional limitations appearing in dependent claims 13 and 39 and does not make up for the above-noted deficiencies of Drexler with regard to independent claims 1 and 27. Accordingly, the Examiner has not shown that claims 13 and 39 are unpatentable under 35 U.S.C. § 103 over the combined teachings of Drexler and Huth.

The Obviousness of Claims 18-21, 25, 44-47, 51, and 66 over Drexler and Poskanzer

Claims 18-21, 25, 44-47, 51 and 66 are dependent claims. As applied by the Examiner, Poskanzer has been relied upon to account for the additional limitations appearing in the dependent claims and does not make up for the above-noted deficiencies of Drexler with regard to independent claims 1, 27, and 53. Accordingly, the Examiner has not shown that claims 18-21, 25, 44-47, 51 and 66

are unpatentable under 35 U.S.C. § 103 over the combined teachings of Drexler and Poskanzer.

CONCLUSION

The rejection of claims 1-5, 10-12, 14-17, 22-24, 26-31, 36-38, 40-43, 48-50, 52-58, 64-65, and 67-90 under 35 U.S.C. § 102 as anticipated by Drexler is reversed.

The rejection of claims 6-9, 32-35, and 59-63 under 35 U.S.C. § 103 as unpatentable over the combined teachings of Drexler and Demers is reversed.

The rejection of claims 13 and 39 under 35 U.S.C. § 103 as unpatentable over the combined teachings of Drexler and Huth is reversed.

The rejection of claims 18-21, 25, 44-47, 51, and 66 under 35 U.S.C. § 103 as unpatentable over Drexler and Poskanzer is reversed.

REVERSED

TORCZON, *Administrative Patent Judge*, concurring in result.

It is appropriate to observe that reversal of a rejection is not the same as holding the claims to be patentable. The key problem with the rejection stems from the examiner's choice to pursue an anticipation theory based on a strained reading of the reference. In obviousness law, it is commonplace that combination of two things typically used together into a single thing is obvious unless the applicant can show secondary considerations rebutting the apparent obviousness. See, e.g., *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969); *Richardson-Vicks Inc. v. Upjohn Co.*, 122 F.3d 1476, 44 USPQ2d 1181 (Fed. Cir. 1997).

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