UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN E. McCALL

Appeal 2007-1912
Application 09/923,202
Technology Center 3600

Decided: August 8, 2008

Before HUBERT C. LORIN, LINDA E. HORNER, and
ANTON W. FETTING, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

John E. McCall (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1-13, 43-55, and 80-97. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.[1]

THE INVENTION

The invention relates to a network for communicating advisory information, in a plurality of data types, from a server to field service providers (e.g., field service technicians) having network devices. The claimed invention is characterized by the use of a "provider identification code" associated with a specific field service provider that authorizes the field service provider to access a specific data type of advisory information. When a field service provider sends a request for advisory information, the request is sent with a "provider identification code." If the server receives a "provider identification code" that authorizes the specific field service provider to access advisory information, the field service provider is given access to advisory information in the specific data type that the "provider identification code" authorizes the requesting field service provider to access. That specific data type of advisory information is then presented to the field service provider through the network device.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

> 1. In a computer network having a server computer communicating with field service providers through network devices, a method in the server computer for providing advisory information to the field service providers, the

[1] Our decision will make reference to the Appellant's Appeal Brief (" Br.," filed Jan. 13, 2006) and the Examiner's Answer ("Answer," mailed Mar. 27, 2006).

method comprising:

receiving a plurality of collected data related to a destination facility, each of the plurality of collected data being associated with one of a plurality of data types;

generating data conclusions based on an analysis between each of the plurality of collected data and an advisory rule corresponding to the data type of the collected data being analyzed;

mapping the data conclusions to advisory information;

storing the advisory information in a storage module for subsequent access by the field service providers, wherein the storage module comprises a plurality of data type records, the advisory information being categorized in the plurality of data type records based on the data type of the collected data from which the advisory information is derived;

receiving a request from a specific field service provider for presentation of advisory information, the request comprising a provider identification code associated with the specific field service provider and representative of a specific data type of advisory information that the specific field service provider is authorized to access;

in response to receipt of the request, retrieving advisory information from a specific data type record of the storage module based on the provider identification code; and

presenting the retrieved advisory information to the specific field service provider through the network device.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Koropitzer	US 5,694,323	Dec. 2, 1997
Wakefield	US 5,961,561	Oct. 5, 1999
Durston	US 4,707,848	Nov. 17, 1987
Garber	US 4,905,163	Feb. 27, 1990
Ziegra	US 5,619,183	Apr. 8, 1997

The following rejections are before us for review:

1. Claims 1-2, 6, 8-13, 43-44, 48, 50-55, and 80-97 are rejected under 35 U.S.C. §103(a) as being unpatentable over Koropitzer and Garber.

2. Claims 3, 45, and 47 are rejected under 35 U.S.C. §103(a) as being unpatentable over Koropitzer, Garber, and Wakefield.

3. Claims 4 and 46 are rejected under 35 U.S.C. §103(a) as being unpatentable over Koropitzer, Garber, Wakefield, and Durston.

4. Claims 5 and 49 are rejected under 35 U.S.C. §103(a) as being unpatentable over Koropitzer, Garber, Wakefield, Durston, and Ziegra.

5. Claims 7 and 45 are rejected under 35 U.S.C. §103(a) as being unpatentable over Koropitzer, Garber, and Ziegra.

ISSUES

The issues before us are whether the Appellant has shown that the Examiner erred in rejecting claims 1-2, 6, 8-13, 43-44, 48, 50-55, and 80-97 as unpatentable over Koropitzer and Garber; claims 3, 45, and 47 as unpatentable over Koropitzer, Garber, and Wakefield; claims 4 and 46 as unpatentable over Koropitzer, Garber, Wakefield, and Durston; claims 5 and

49 as unpatentable over Koropitzer, Garber, Wakefield, Durston, and Ziegra; and, claims 7 and 45 as unpatentable over Koropitzer, Garber, and Ziegra.

These issues turn on whether Koropitzer and Garber describe, or would have led one having ordinary skill in the art to, a method in a server computer for providing advisory information to a field service provider comprising receiving a request from a field service provider for presentation of advisory information,

> the request comprising *a provider identification code associated with the specific field service provider and representative of a specific data type of advisory information that the specific field service provider is authorized to access*; and
>
> in response to receipt of the request, *retrieving advisory information from a specific data type record of the storage module based on the provider identification code*; and
>
> presenting the retrieved advisory information to the specific field service provider through the network device.

Claim 1.

ANALYSIS

Rejection of claims 1-2, 6, 8-13, 43-44, 48, 50-55, and 80-97 as being unpatentable over Koropitzer and Garber.

According to the Examiner, Koropitzer discloses a method comprising all the claimed limitations but for (a) a plurality of data types and (b) the use of a "provider identification code" representative of a specific data type of advisory information that a specific field service provider is authorized to access. "Koropitzer et al ('323) does not specifically disclose a plurality of data types and retrieving an identification code representative of a specific data type of advisory information that the field service provider is authorized

to access and retrieving advisory information from a specific data type record based on the provider identification code." Answer 4-5.

(a) *a plurality of data types*

The Specification defines "data types" as follows: "[t]he data type is generally defined by the form or subject matter (i.e., device, business, census, etc.) of the data and more specifically defined by the sources from where the data originates" (Specification 10:26-28). In light of the Specification, the claimed "plurality of data types" is construed to refer to more than one piece of data. The distinction between pieces of data based on subject matter (i.e., device, business, census, etc.) is not patentably consequential because it is a distinction grounded on nonfunctional descriptive material. *See In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004). *Cf. In re Gulack*, 703 F.2d 1381, 1385 (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

The Examiner argues that "Garber et al (4,905,163) teaches a plurality of data types (definitions) for providing advisory information based on provider identification code, see column 33, lines 30-43 for the benefit of providing appropriate access to data." Answer 5.

Garber, col. 33, lines 30-43 is reproduced below:

> Summary of Selection Process **392**
>
> The purpose of preferred similarity selection process **392** is to allow a user or a system to select a similarity definition **398** from among definitions of similarity **390**. In many cases, a user may well wish to select a definition of similarity **390**. In these cases, generally the Nearest Neighbor system may simply

> provide a list of available definitions and request a selection. In other cases, a separate system may be running when the Nearest Neighbor system is called. In these cases the calling system may wish to make the definition selection. For example, there may be several similarity definitions **390** for a patient records subject of interest **713**. Perhaps one definition is appropriate for a physician, a second for a nurse and a third for a medical records technician.

Garber is directed to organizing and presenting information ("[t]he present invention is a computerized information presentation system for dynamically organizing information," col. 8, ll. 3-5). The Garber passage reproduced above describes a particular way of organizing information that involves the use of similarity definitions to organize information according to related concepts. Garber explains that a user may select a similarity definition from among definitions of similarity provided, for example, in a list, and the user can thereby retrieve information corresponding to the selected similarity definition. Given that Garber presents to the user a list of similarity definitions and that each definition corresponds to a specific type of data defined by similarity, we agree with the Examiner that Garber describes a "plurality of data types."

We do not agree, however, that the Garber, col. 33, lines 30-43, passage that the Examiner relied upon, "teaches a plurality of data types (definitions) for providing advisory information *based on provider identification code*." Answer 5. We are unable to find a "provider identification code" of any kind. We agree with the Appellant that "[Garber] stops short of any further explanation and fails altogether to teach the manner in which the user is determined to be of a certain type (e.g., nurse,

doctor or medical technician). Indeed, [Garber] does not teach the use of an identification code specific to the type of user in order to indicate which definition to retrieve." Br. 12-13.

(b) *provider identification code*

Given that the Examiner has conceded that Koropitzer does not describe the claimed provider identification code and our determination that the Examiner has not shown the claimed provider identification code is described in Garber, to meet the Office's initial burden of establishing a prima face case of obviousness, it is necessary to show "'some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.'" *KSR* at 1741 (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

The Examiner determined that "it would have been obvious to one of ordinary skill in the art, at the time the invention was made to store data in a plurality of data types and provide access based on a provider identification code for the benefit of providing appropriate levels of access of data." Answer 5. To reach that determination, the Examiner made two contentions.

First, the Examiner contended that col. 12, ll. 34-36 and col. 10, ll. 4-7, of Koropitzer would suggest the claimed provider identification code. Answer 4.

We do not agree with this contention. The former passage describes a site controller unit (SCU) receiving "an appropriate password (i.e., a password that matches one of the passwords stored in [memory])" from a main controller unit (MCU) such that the SCU may communicate with the

MCU and thereby obtain information from the MCU. In citing this disclosure, the Examiner would appear to be equating the claimed "provider identification code" with a password. The normal function of a password is to allow access. However, the claimed "provider identification code" is claimed as having functions more complicated that simply allowing access to information. The claimed "provider identification code" must be (1) "associated with the specific field service provider" and (2) "representative of a specific data type of advisory information that the specific field service *provider is authorized to access*", such that, "in response to receipt of the request, [the field service provider] retriev[es] advisory information from a specific data type record of the storage module based on the provider identification code." Claim 1. We are unable to discern how Koropitzer's disclosure to the common use of a password to gain access to information would lead one of ordinary skill in the art to incorporate a code with the functions claimed. The col. 10, ll. 4-7 disclosure of Koropitzer explains that "smart machines" may be able to report identifying information. Again, we are unable to discern, and the Examiner does not explain, how this disclosure, alone, or in combination with the disclosed use of a password, would lead one of ordinary skill in the art to incorporate a code with the functions claimed

Second, the Examiner contended that one of ordinary skill in the art would be led to the claimed provider identification code given Koropitzer's disclosure of identifying information (see discussion above) and Garber's disclosure of providing records of interest to a doctor, nurse or medical technician according to a selected similarity definition. See Garber, col. 33,

lines 30-43, reproduced above. "Since Koropitzer [ ] teaches identifying information, it is clear that the doctor, nurse or medical technician of Garber [ ] would also be identified by an identification code specific to the user." Answer 11.

We do not agree with this contention. It is *not* clear that "the doctor, nurse or medical technician of Garber [ ] would also be identified by an identification code specific to the user" (Answer 11). There is nothing in Garber about identification codes. The bare mention of people with different occupations would not lead one of ordinary skill in the art to incorporate a code specific to a particular piece of data with the functions claimed, whether or not it is associated with information corresponding to a particular occupation. Nor does the combination of Garber's bare mention of people with different occupations and Koropitzer's suggestion that "smart machines" may be able to report identifying information lead to an identification code for a particular piece of data, let alone the claimed "provider identification code."

Because we are not persuaded by either of the Examiner's contentions in support of the Examiner's determination that the claimed provider identification code would have been obvious to one of ordinary skill in the art, we find that the Examiner has not established, in the first instance, a prima facie case of obviousness of claim 1, or its dependent claims 2, 6, 8-13, and 80-88. Independent claim 43 contains limitations similar to claim 1. For the same reasons as provided for claim, we find that the Examiner has not established a prima facie case of obviousness of claim 43 or its dependent claims 44, 48, 50-55, and 89-97.

For the foregoing reasons, we will not sustain the rejection.

The rejection of claims 3, 45, and 47 as being unpatentable over Koropitzer, Garber, and Wakefield.

The rejection of claims 4 and 46 as being unpatentable over Koropitzer, Garber, Wakefield, and Durston.

The rejection of claims 5 and 49 as being unpatentable over Koropitzer, Garber, Wakefield, Durston, and Ziegra.

The rejection of claims 7 and 45 as being unpatentable over Koropitzer, Garber, and Ziegra.

These rejections are directed to claims dependent on claims 1 and 43, whose rejection we have reversed above. For the same reasons, we will not sustain the rejections of claims 3-5, 7, 45-47, and 49 over the cited prior art. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) ("[D]ependent claims are nonobvious if the independent claims from which they depend are nonobvious.").

CONCLUSIONS OF LAW

We conclude the Appellant has shown that the Examiner erred in rejecting claims 1-2, 6, 8-13, 43-44, 48, 50-55, and 80-97 as unpatentable over Koropitzer and Garber; claims 3, 45, and 47 as unpatentable over Koropitzer, Garber, and Wakefield; claims 4 and 46 as unpatentable over Koropitzer, Garber, Wakefield, and Durston; claims 5 and 49 as unpatentable over Koropitzer, Garber, Wakefield, Durston, and Ziegra; and, claims 7 and 45 as unpatentable over Koropitzer, Garber, and Ziegra.

DECISION

The decision of the Examiner to reject claims 1-13, 43-55, and 80-97 is reversed.

REVERSED

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