

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SAKAE WASA

Appeal 2007-3858
Application 09/960,917
Technology Center 3600

Decided: January 22, 2008

Before MURRIEL E. CRAWFORD, DAVID B. WALKER, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant seeks our review under 35 U.S.C. § 134 of the Final Rejection of claims 1-20. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We AFFIRM¹.

¹ Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to

THE INVENTION

The Appellant's claimed invention is directed to a company diagnosis system and method for displaying a questionnaire via a network, receiving a reply to the questionnaire via the network, processing the reply using databases to produce reply data, and then having the processed data displayed (Specification 4: 9-17). Claim 1, reproduced below is representative of the subject matter of appeal.

1. A company diagnosis system comprising:

a server having a connection to an external network and to a first database and a second database; and

a storage device connected to said server and containing instructions that are executed by said server, said instructions including

instructions for receiving a company profile for a given company from a user and for setting up a user ID,

instructions for storing said company profile in a first database,

instructions for receiving a request for diagnosis for the given company, said request including a choice of either a first diagnosis or a second diagnosis, wherein said second diagnosis provides greater detail than said first diagnosis,

make in the Briefs have not been considered and are deemed to be waived.
See 37 C.F.R. § 41.37(c)(1)(vii) (2007).

instructions for sending a first questionnaire to the user, said first questionnaire corresponding to a questionnaire for said first diagnosis or a questionnaire for said second diagnosis in dependence on said choice, wherein said questionnaire for a first diagnosis is a part of said questionnaire for a second diagnosis,

instructions for receiving a reply to said first questionnaire via said network, instructions for processing said reply to said first questionnaire into corresponding numeric data and for processing said corresponding numeric data using data stored in said first database and said second database to produce processed reply data, instructions for sending a display of said processed reply data to the user, and

instructions for storing said processed reply data in said second database together with said user ID.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Royall, Jr.	US 2002/0032600 A1	March 14, 2002
Parker	US 2002/0052774 A1	May 2, 2002

The following rejections are before us for review:

1. Claims 1-20 are rejected under 35 U.S.C. § 103(a) as unpatentable over Parker in view of Royall.

THE ISSUE

The issue is whether the Appellant has shown that the Examiner erred in rejecting the claims 1-20 under 35 U.S.C. § 103(a) under Parker in view of Royall.

This issue first turns on whether Parker and Royall disclose a single user receiving both the questionnaire and the processed reply data.

This issue second turns on whether the Parker and Royall disclose that the questionnaire reply is processed into “corresponding numeric data”.

This issue third turns on whether Parker and Royall disclose that the numeric data is processed to “produce processed reply data”.

FINDINGS OF FACT

We find the following enumerated findings of fact are supported at least by a preponderance of the evidence²:

1. *Webster’s New World Dictionary, Third College Edition* (1988), lists the definition of “numeric” as: a numeral, or digit.
2. *Webster’s New World Dictionary, Third College Edition* (1988), lists the definition of “data” as: things known or assumed; facts or figures to be processed; evidence, records, and statistics from which conclusions can be inferred; information.
3. Parker discloses that a reply is processed into corresponding numeric data (Fig. 4, 100). Numerical ratings (numerals) are shown for satisfaction levels for various companies.

² See *Ethicon, Inc. v. Quigg*, F.2d 1422, 1427 (Fed. Cir. 1988) explaining the general evidentiary standard for proceedings before the Patent Office.

4. Royall discloses that the institution can quantify or rank the importance of each factor based on the survey questions (0035-0036).
5. Royall discloses that students are e-mailed back a specific web page link based on their reply to the questionnaire (Fig. 4).
6. Royall discloses that a web page link sent to the students can be customized to the particular student. Students expressing interest in a particular academic program may be directed to a web page for that particular program (0033).

PRINCIPLES OF LAW

Principles of Law Relating to Obviousness

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S.Ct. at 1739 (citing *Graham*, 383 U.S. at 12 (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” The Court also stated “[i]f a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *Id.* at 1740. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Court noted that “[t]o facilitate review, this analysis should be made explicit.” *Id.* at 1741 (citing *In re Kahn*, 441 F.3d 977, 988, (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

ANALYSIS

The Appellant argues (Br. 10:29-30) that Parker and Royall do not show that a single user is receiving both the questionnaire and the reply data. We disagree. Royall shows that students are e-mailed a specific web page link based on their reply to the questionnaire (FF 5&6). Royall's web page link sent to the students can be customized to each particular student. Students for example expressing interest in particular academic program may be directed to a web page for that particular program (FF 6). The web page link serves as "reply data" since it is e-mailed back to the user (student) and contains information that has been processed for that particular user.

The Appellant also argues (Reply Br. 3:29-33) that Royall does not disclose "processing said reply to said first questionnaire into corresponding numeric data". We disagree. Royall discloses the results may be "quantified or ranked" (FF 2) which clearly implies that the results are numerically based. Regardless, the rejection of record does not assert that Royall "processed said reply.....into corresponding numerical data", but asserted that this was shown by Parker (Ans. 4). Parker has clearly disclosed that data is processed into corresponding numeric data (FF 3). Parker discloses that numerical ratings are used for the satisfaction levels for various companies (Fig. 4, 100) meeting the limitation for processed "numerical data" in the claims.

The Appellant also argues (Reply Br. 3:29-33) that the combination does not show the numeric data is processed to "produce processed reply

data”. We disagree. Royall clearly shows that the user (student) is sent a letter with a web link to data based on the user’s response (FF 5&6). This web link is “processed reply data” and is produced for a particular student based on the reply to the questionnaire (FF 5). Since the student is sent particular information on things such as academic programs the student has been deemed to be interested in, this meets the definition of “processed reply data” in the claims. The Specification does not provide a definition of “data” that is inconsistent with our definition and we decline to read a specific embodiment of data from the detailed description into the rejected claims.

CONCLUSIONS OF LAW

We conclude that Appellant has failed to show that the Examiner erred in rejecting claims 1-20 under 35 U.S.C. § 103(a) under Parker in view of Royall.

DECISION

The decision of the Examiner to reject claims 1-20 is AFFIRMED.

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)(2006).

AFFIRMED

vsh

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