

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TED G. LAUTZENHEISER, THOMAS K. AUSTIN,
and THOMAS R. PETERS

Appeal No. 2001-1007
Application No. 08/937,025

ON BRIEF

Before HAIRSTON, DIXON, and SAADAT, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 7, 24, 31, 39, and 45. Claims 2-6, 8-14, 25-30, 40-44 and 46 and have been objected to by the examiner as being allowable if rewritten in independent form. Claims 15-23 and 32-38 have been indicated by the examiner as allowable.

We REVERSE.

BACKGROUND

Appellants' invention relates to a method and apparatus for warning a user of potential limitations of a database request and/or the results provided thereby. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method for analyzing a survey database having a number of data elements using a predetermined algorithm, the method comprising the steps of:
 - a. analyzing the survey database using the predetermined algorithm including accessing selected data elements;
 - b. providing a result; and
 - c. providing an indication of confidence in the result in one or more result caveats.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Amado	5,701,400	Dec. 23, 1997 (Filed Mar. 8, 1995)
Peters	5,893,098	Apr. 6, 1999 (Filed Dec. 20, 1996)

Claims 1, 7, 24, and 39 stand rejected under 35 U.S.C. § 102 as being unpatentable over Peters. Claims 31 and 45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Peters in view of Amado.

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Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 10, mailed Apr. 21, 2000) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 9, filed Feb, 24, 2000) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

35 USC § 102

"Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention." **RCA Corp. v. Applied Digital Data Systems. Inc.**, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

It is well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office (PTO). **See In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). After the PTO establishes a *prima facie* case of anticipation based on inherency, the burden shifts to the appellant to prove that the subject matter shown to be in the prior art does not possess the

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characteristics of the claimed invention. **See In re Thorpe**, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985); **In re King**, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986). Hence, appellants' burden before the PTO is to prove that the applied prior art reference does not perform the functions defined in the claims. Compare **In re Best**, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977); **In re Ludtke**, 441 F.2d 660, 664, 169 USPQ 563, 566-67 (CCPA 1971). Here, we find that appellants have met this burden, and we will not sustain the rejection of claim 1.

Appellants argue that the claimed invention is directed to accessing an existing database and Peters is concerned with building a database. (See brief at page 13.) We agree with appellants' argument at pages 15-16 of the brief that the cited passages in Peters do not remotely correspond to the language of independent claim 1. While the examiner maintains that the cited portions teach the claimed invention at pages 4-5 and 6-7 of the answer, the examiner never addresses the distinction between forming a database in Peters from the email responses for later use and accessing and the language of independent claim 1 which clearly accesses an already existing database and provides an indication of confidence in the result in one or more result caveats from the accessing. Since the examiner has not provided a reasoned analysis of the disclosure of Peters that at least facially addressed the limitations of independent claim 1, we will not sustain the rejection of independent claim 1.

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With respect to independent claims 7, 24 and 39, we note that the limitations are similar to those addressed above, and we will not sustain the rejection thereof. Additionally, we note that the language of independent claim 7 is very similar to that of dependent claim 3 which the examiner has objected to and indicated would be allowable if rewritten in independent form.

35 USC § 103

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). See also **In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. **Oetiker**, 977 F.2d at 1445, 24 USPQ at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and arguments." **In re Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the

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requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). With these principles in mind, we commence review of the pertinent evidence and arguments of Appellants and Examiner.

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references'". **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), **citing In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence." **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617. "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." **Dembiczak**, 175 F.3d at 999, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) .

Here again the examiner relies on the teachings of Peters to teach accessing a database, but again the portions of Peters relied upon by the examiner merely teach the formation of a questionnaire, distribution thereof, obtaining individual responses and

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forming a database therefrom. Again, we find no clear reasoned analysis of these teachings to teach or fairly suggest accessing an existing database and determination of an indication of confidence in the results as recited in the language of independent claim 31. Similarly, we do not find that the teachings of Amado remedy the deficiencies in Peters and the examiner has not relied upon Amado beyond the use of plural data elements. Therefore, we find that the examiner has not established a *prima facie* case of obviousness, and we will not sustain the rejection of independent claims 31 and 45.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 7, 24, 31, 39, and 45 under 35 U.S.C. §§ 102 and 103(a) is reversed.

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REVERSED

KENNETH W. HAIRSTON
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

MAHSHID D. SAADAT
Administrative Patent Judge

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