

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

Paper No. 82

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AMERICAN ACADEMY OF SCIENCE TECH CENTER

Appeal No. 2003-0349
Control No. 90/003,463¹

HEARD: MARCH 13, 2003

Before KRASS, JERRY SMITH and BARRETT, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-17 and 20-43, which constitute all the claims now pending in this application for reexamination. An amendment after final rejection was filed on February 13, 2002 but was denied entry by the examiner.

¹ Reexamination of U.S. Patent No. 4,714,989, issued December 22, 1987, based on Application 06/921,219, filed October 20, 1986.

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The disclosed invention pertains to a method and apparatus for networking computers using a functionally structured distribution. Each of the computers connected to the network is designated as either a user computer or a data center computer. Each data center computer stores information to be shared by a plurality of users. The user computers provide an interface to the data center computers, execute application software for the user, and request information over the network from data center computers.

The distributed network of the invention operates as a data base management system. All data base management tasks are handled by the data center computers so that the user computers can be dedicated to other functions. Requests for data base management tasks at the user computers are sent to the data center computers as if the data were being stored locally on each user computer.

Representative claims 1 and 27 are reproduced as follows:

1. A method of operating a distributed data processing system including a plurality of independent, not necessarily uniform, general purpose user computers to run respective user application programs to process user data and a data center computer to store, retrieve, and update user data, said user computers being selectively interconnected with said data center computer by respective data communication hardware over data communication network means, said method comprising the steps of:

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(a) managing in a data center computer by means of a data base manager program a user data base of user data items to perform data operations of storing, updating, and retrieving said user data items in response to data base calls for such operations from a user computer;

(b) running a user application program in a general purpose user computer to process user data, said user application program indirectly issuing data base calls for data operations regarding user data items in response to requirements for said data operations by said user application program;

(c) in response to a data base call regarding a user data item from a user application program, initiating by said user computer only a data communication link with said data center computer over data communication network means;

(d) communicating said data base call from said user computer to said data center computer;

(e) performing by said data center computer said data operation regarding said user data item defined by said data base call; and

(f) communicating an appropriate response to said data base call from said data center computer to said user computer.

27. A method of operating a distributed data processing system including a plurality of independent, not necessarily uniform, general purpose user computers to run respective user application programs to process user data and a data center computer to store, retrieve, and update user data, said user computers being selectively interconnected with said data center computer by respective data communication hardware over data communication network means, wherein a user computer means a personal computer dedicated to servicing a single user at a time and not a mainframe computer or a minicomputer and executes user-selected programs, said method comprising the steps of:

(a) managing in a data center computer by means of a data base manager program a user data base of user data items to perform data operations of storing, updating, and retrieving said

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user data items in response to data base calls for such operations from a user computer;

(b) running a user application program in a general purpose user computer to process user data, said user application program indirectly issuing data base calls for data operations regarding user data items in response to requirements for said data operations by said user application program;

(c) in response to a data base call regarding a user data item from a user application program, initiating by said user computer only a data communication link with said data center computer over data communication network means.

(d) communicating said data base call from said user computer to said data center computer;

(e) performing by said data center computer said data operation regarding said user data item defined by said data base call; and

communicating an appropriate response to said data base call from said data center computer to said user computer.

The examiner relies on the following references:

R. H. Canaday et al. (Canaday), "A Back-end Computer for Data Base Management," Communications of the ACM, Vol. 17, No. 10, October 1974, pages 575-582 [exhibit #3 of reexamination request].

E. Lowenthal, "Data Base Processors: What Can They Do?", June 1979, pages In Depth/1-12 [exhibit #8 of reexamination request].

J. J. Passafiume, "Providing Network Data Services Using a Backend Data Base Machine," February 1980, pages 251-262 [exhibit #10 of reexamination request].

D. K. Hsiao et al. (Hsiao), "Database Machine Architecture In The Context Of Information Technology Evolution," October 1977, pages 63-84 [exhibit #7 of reexamination request].

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A review of the facts pertinent to this appeal is helpful. This application was previously on appeal before us with rejections of claims 1-17 and 20-26 alternatively made under Sections 102 and 103 on a plurality of individual references. In order to decide these issues, it was necessary to consider the scope of the claims on appeal before us. We noted that appellant had proposed specific definitions for the following terms: "distributed data processing system," "user computer," "user application program indirectly issuing data base calls" and "data base simulator program." None of these proposed definitions appeared in the disclosure of the patent. The examiner accepted the proposed definitions for "distributed data processing system" and "user computer." The examiner contested the definitions of the other two terms proposed by appellant. We held that the examiner should not have accepted any of the proposed definitions because the proposed definitions were clearly narrower than the broadest reasonable interpretation of these terms and the narrower definitions did not appear in the disclosure so as to alert everyone to the proposed narrower definitions.

In considering the rejections under 35 U.S.C. § 102, we refused to consider appellant's proposed definitions, and instead, we applied the usual rule that claims are to be given

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their broadest reasonable interpretation during the course of a reexamination proceeding. This claim interpretation led us to affirm the examiner's rejections of the claims under 35 U.S.C. § 102 based on the disclosures of Canaday, Lowenthal, Maryanski, Passafiume and Hsiao. Since we had affirmed the rejections of the claims under 35 U.S.C. § 102, we basically affirmed the rejections of the claims under 35 U.S.C. § 103 on the basis that anticipation is the epitome of obviousness [see Decision in Appeal No. 98-1483 mailed August 24, 1998].

Appellant requested rehearing of this decision and argued that the affirmance of the rejection under 35 U.S.C. § 102 should have been designated a new ground of rejection based on the different claim interpretation used by the Board. We granted this request and designated the rejections under 35 U.S.C. § 102 as a new ground of rejection [decision on rehearing dated March 9, 1999]. In that same decision, we also indicated that our blanket affirmance under 35 U.S.C. § 103 was incomplete and that we should have considered the rejections under 35 U.S.C. § 103 separately on the merits. We then affirmed the rejections of the claims under 35 U.S.C. § 103 on the merits based on the claim limitations and the teachings of the applied prior art [id.].

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Appellant requested rehearing of our Decision on Rehearing and asked that we designate the affirmance of the rejections under 35 U.S.C. § 103 based on the merits as new grounds of rejection. We granted this request and designated the rejections under 35 U.S.C. § 103 as a new ground of rejection [decision on rehearing dated February 15, 2000].

In response to our original decision and the decisions on the requests for rehearing, appellant filed an amendment of the application and declarations by Dr. Maryanski and Mr. Billings. The amendment added new claims 27-43 to the claims which were already present in the application. The examiner considered the amendment and the declarations and rejected all the claims. This second appeal of this application resulted from this rejection by the examiner.

Newly submitted claims 27-43 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Claims 1-17 and 20-43 each stand alternatively rejected under 35 U.S.C. § 102 or § 103 on Canaday, Lowenthal, Passafiume or Hsiao each applied individually.

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Rather than repeat the arguments of appellant or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the prior art rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the examiner's rejection of the newly added claims based on a lack of written description is proper with respect to claims 27-32 but is not proper with respect to claims 33-43. We are also of the view that the rejections of the claims under 35 U.S.C. § 102 based on Canaday, Lowenthal or Passafiume are proper with respect to claims 1-17, 20-26 and 35-43, but are not proper with respect to claims 27-34. The rejection of claims 1-17 and

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20-43, under 35 U.S.C. § 102 based on Hsiao is proper with respect to all the appealed claims. Finally, we are of the view that the alternative rejections of the claims under 35 U.S.C. § 103 based on Canaday, Lowenthal, Passafiume or Hsiao are proper with respect to all the claims on appeal. Accordingly, the decision of the examiner is affirmed.

We consider first the rejection of claims 27-43 under the first paragraph of 35 U.S.C. § 112. The examiner's rejection is based on the written description requirement. Specifically, the examiner notes that these claims have incorporated specific definitions of "user computer," "distributed data processing system," "user application program indirectly issuing database calls," and/or "database simulator program." The examiner asserts that such definitions are not supported by the original application disclosure [final rejection, pages 5-6, incorporated into answer at page 3].

With respect to the phrase "user computer," appellant argues that the definition of user computers as being personal computers (PCs) and not mainframe computers or minicomputers is supported by the specification even though the definition does not appear therein. Appellant also argues that some of the rejected claims only recite user computers having components

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which are clearly recited in the specification. With respect to the phrase "distributed data processing system," appellant argues that the entire patent relates to distributed data processing systems. With respect to the phrase "user application program indirectly issuing database calls," appellant argues that the claim language is taken directly from the specification. With respect to the phrase "database simulator program," appellant argues that this phrase is fully supported by the patent [brief, pages 25-27].

The examiner responds that the definitions now incorporated into claims 27-43 were cancelled from the specification by appellants when the definitions were objected to by the examiner as being new matter. The examiner asserts that since appellant cancelled these proposed definitions from the specification, there is no support in the specification for these definitions. The examiner also points out that the Board indicated that these definitions did not appear in the original specification in the earlier decision. The examiner notes that the narrow definitions proposed by appellant exceed the scope of the originally filed disclosure. Finally, the examiner asserts that Dr. Maryanski's declarations provide no evidence in support of the proposed definitions [answer, pages 6-8].

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With respect to the definition of "user computer," we agree with the examiner that the proposed definition that the phrase means "a personal computer dedicated to servicing a single user at a time and not a mainframe or a minicomputer and executes user-selected programs" is not supported by the original disclosure. Specifically, the original disclosure does not support the recitation of a personal computer. In Dr. Maryanski's declaration of November 13, 1995, he stated that the artisan would understand the term user computer to mean "a computer, typically a microcomputer, now more commonly called a personal computer or PC." Thus, even Dr. Maryanski does not indicate that a user computer was defined as a personal computer at the time this application was filed, but that it would now be recognized as a personal computer. Although we agree that a personal computer falls within the scope of the term user computer, we do not agree with appellant that the term user computer meant a PC at the time this application was filed. There is no evidence that appellant envisioned what is now called a personal computer as part of the invention when this application was filed. Since this definition appears in claims 27, 29, 30 and 32, these claims are not supported by the original disclosure.

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We agree with appellant that the original disclosure supports the broad use of a distributed data processing system. Claims 28, 29, 31 and 32, however, recite that the distributed data processing system means a plurality of personal computers. There is no support for the use of personal computers as discussed above.

With respect to claims 33-43, we agree with appellant that these claims do not recite any objectionable definitions and are supported by the disclosure as originally filed. Therefore, the rejection of claims 27-43 under the first paragraph of 35 U.S.C. § 112 is sustained with respect to claims 27-32 but is not sustained with respect to claims 33-43.

We now consider the alternative rejections of claims 1-17 and 20-43, under 35 U.S.C. §§ 102 and 103 on each of the four prior art references cited above. As we noted in our previous decision, before we can properly address the question of whether any of the references anticipates or renders obvious the claimed invention, we must again determine exactly to what invention the claims are directed. Appellant and the examiner disagree on the scope of the claimed invention which plays a major role in the disagreement over whether the prior art has been properly applied.

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In the previous decision we defined "user computer" as a computer capable of running application programs for a user. Appellant argues that the patent discloses that each of the user computers is dedicated to servicing a single user at a time. Thus, appellant argues that the term cannot be met by a multiple-function mainframe or minicomputer which simultaneously serves a plurality of users. Appellant also argues that Dr. Maryanski's declarations support the position that a user computer must execute application programs and interface with a single user at a time. Appellant also argues that in a related District Court proceeding involving the patent, the court concluded that user computer meant a general purpose computer serving one user at a time. Finally, appellant argues that using the examiner's interpretation of user computer, there is no difference between a computer and a user computer [brief, pages 11-22].

The examiner responds that the specification of the patent does not exclude multiple user computers. The examiner also asserts that the Maryanski declarations are devoid of any evidence of prior use of the term user computer to the skilled artisan at the time the application was filed. The examiner also

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asserts that his definition of user computer is reasonable despite the findings of the District Court. Finally, the examiner responds that the modifier "user" in the term "user computer" has been properly considered in the definition [answer, pages 3-6].

With respect to the term "user computer," we stand by the definition we gave it in the previous decision. We follow the general rule that in reexamination proceedings claims are given their broadest reasonable interpretation consistent with the specification, and limitations appearing in the specification are not read into the claims. In re Yamamoto, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984). Where an inventor chooses to be his own lexicographer and to give terms uncommon meanings, he must set out his uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change. Intellicall, Inc. v. Phonometrics, Inc., 952 F.2d 1384, 1388, 21 USPQ2d 1383, 1386 (Fed. Cir. 1992). In our view, appellant's arguments require a claim interpretation that is much narrower than is consistent with the broadest reasonable interpretation which is mandated by law.

With respect to appellant's first argument that user computer requires a computer that interfaces with a single user

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only, we do not agree. Although a single user computer is clearly within the scope of the term user computer, the term should not be so limited. Although the patent disclosure does refer to servicing a user in the singular, it also notes that the user could be a person, another device, or machine [column 2, lines 34-37]. We find that the patent disclosure does not preclude our interpretation that a user computer can include a mainframe or minicomputer. During prosecution appellant could have amended the claims to avoid this interpretation, but has elected not to amend some of the claims.

With respect to appellant's second argument that Dr. Maryanski's declarations support the definition proposed by appellant, we agree with the examiner that the declarations offer no evidence in support of appellant's definition. Instead, the declarations merely offer Dr. Maryanski's opinions as to what the artisan would have understood upon reading the patent disclosure. Claim interpretation is a matter of law and cannot be resolved on the mere opinions of alleged experts. As noted by the examiner, the declarations do not provide any evidence to support the opinions of Dr. Maryanski. Therefore, we go with the broadest reasonable interpretation of the claim terms themselves.

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With respect to appellant's third argument that our definition of user computer is not consistent with the findings of the District Court, we note that our finding is based on an entirely different record than the one used by the District Court and is based on a different type of proceeding. The Court made its finding in an infringement proceeding and based it on evidence and testimony which is not before us. The rules of claim construction are different in an infringement proceeding because the claims cannot be amended. As we noted above, appellant could have amended the claims in this proceeding to require the single user interface, but appellant has not amended some of the claims on appeal. The claim definition accepted by the Court is not consistent with the rule of broadest claim interpretation during prosecution.

Finally, with respect to appellant's fourth argument that our definition leaves no difference between computer and user computer, we do not agree. Our definition of user computer essentially allows a user computer to be any general purpose computer which can be programmed by one or more users to run application programs specifically for those users. This definition would disqualify those computers which are designed as special purpose computers for some use and are not intended to be

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reprogrammed by users for their own benefits. Such special purpose computers would include computers within an appliance, for example, which are not intended to interface with a user for application programming under any circumstances. Thus, appellant's argument that our definition ignores the modifier "user" in user computer is not persuasive.

In the previous decision we also defined indirectly issuing a database call as requiring only that a request from the host computer go through some other component before it is sent to the database. Appellant argues that indirect refers to a call which would have been processed locally in the user computer, but for the redirection provided through use of the simulator program. Appellant argues that the examiner's interpretation renders the term indirectly meaningless because there could never be an issued data base call which did not go through some other component before being sent to the data base in a data center computer [brief, pages 23-25]. The examiner responds that the interpretation proposed by the Board is reasonable and that Dr. Maryanski's declarations fail to provide any evidence to support the narrow definition proposed by appellant [answer, page 6].

Appellant's arguments with respect to the definition of indirectly issuing database calls are not persuasive. There is

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no reason why the artisan would interpret the broad phrase as requiring that the database would have been processed locally but for the redirection provided by the disclosed invention. We again find that the broadest reasonable interpretation requires nothing more than that the call must go through some other component before it is sent to the database.

With these definitions in mind, we can now consider the prior art rejections based on the four applied references cited above. Each of the prior art references is directed to a similar computer architecture for data base management. This architecture consists of a dedicated back-end computer for performing data base management functions for a plurality of users. The users make data requests, and those requests are processed and sent to the back-end computer for handling those data requests. Results of the data requests are then communicated back to the user whose application program made the data request.

We consider first the propriety of each of the rejections based on anticipation under 35 U.S.C. § 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 as well as disclosing structure

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which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Appellant does not specifically argue each of the rejections in detail, but appellant's position is generally that neither Canaday, Lowenthal, Passafiume nor Hsiao discloses the user computer as defined by appellant and the indirectly issuing limitation as defined by appellant.

As noted above, we continue to use the definition of these terms that we discussed in the previous decision. Using these definitions, we determined in the previous decision that claims 1-17 and 20-26 were anticipated by the applied prior art because the claimed user computers were met by the host computers of these references and the host computers of these references indirectly issued database requests to the database computer. Since claims 1-17 and 20-26 have not been amended, and since appellant's newly submitted arguments and evidence do not persuade us that the definitions we used in reaching the previous decision were in error, we sustain the anticipation rejections of

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claims 1-17 and 20-26 for reasons discussed in the previous decision.

Claims 27-32 recite that the user computer is a personal computer and/or that the distributed data processing system is a plurality of personal computers. Neither Canaday, Lowenthal nor Passafiume specifically discloses that the host computer is a personal computer. Therefore, the anticipation rejection based on these references is not sustained. Hsiao, however, describes a system in which a plurality of personal computers individually make database requests to a large shared database [see Figure 1]. Therefore, we sustain the anticipation rejection of claims 27-32 based on the disclosure of Hsiao.

Claims 33 and 34 recite that the user computer is a stand-alone computer having a microprocessor, a video display, a keyboard terminal and a hard disk drive. Canaday, Lowenthal and Passafiume do not specifically disclose that their host computers have video displays and keyboard terminals. Therefore, the anticipation rejection based on these references is not sustained. Since Hsiao discloses personal computers as discussed above, and since personal computers are known to have video displays and keyboard terminals, we sustain the anticipation rejection of claims 33 and 34 based on Hsiao.

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Claims 35-43 recite a specific definition for indirectly issuing database calls and/or a specific definition for a database simulator program. The first definition requires that an application requests data as if the data resides on the host computer and the request is redirected to the database computer. The second definition requires that the simulator program transparently replaces and imitates the database manager program and redirects the database requests from the host computer to the database computer. We find that each of the applied prior art references satisfies these definitions. Each of the applied references discloses that in a back-end system, the host computer receives database requests from the application programs and redirects these requests to the database computer at the back-end. This functions as a database simulator means which redirects requests as claimed. Therefore, we sustain the examiner's anticipation rejections of claims 35-43 based on each of the applied references.

We now consider the propriety of each of the alternative rejections of each of the claims on appeal based on obviousness under 35 U.S.C. § 103. Since anticipation is the epitome of obviousness, and since we have sustained the anticipation rejection of claims 1-17, 20-26 and 35-43 based on each of the

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applied references and the anticipation rejection of claims 27-34 based on Hsiao, we also sustain the alternative rejection of these claims under 35 U.S.C. § 103. We will nevertheless consider the alternative rejection of all the appealed claims under 35 U.S.C. § 103 separately on the merits.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore

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Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived by appellant [see 37 CFR § 1.192(a)].

Appellant argues that he has never received a rejection under 35 U.S.C. § 103 which made a proper Graham v. John Deere Co. analysis as required [brief, pages 28-33]. As noted above, the prior art rejections of the claims were always alternatively made under 35 U.S.C. §§ 102 and 103. Appellant is correct that the examiner's analysis was essentially a finding that the

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claimed invention was anticipated by the applied prior art. The only question as to whether the rejection was proper under 35 U.S.C. § 102 or should have been made under 35 U.S.C. § 103 was the question of whether the claimed user computer had to be interpreted as a personal computer. This question was decided adversely to appellant in the previous appeal and in this decision. Thus, the only possible argued difference between the claimed invention and the applied prior art for a Graham analysis is the interpretation of the user computer as requiring a personal computer.

The examiner made the following observations in the examiner's answer which was prepared for the previous appeal:

The Patent Holder argues (Brief p. 41, 42) that since PC were not available in 1974 Canaday et al could not have meant that such a computer is a PC. Similar arguments could be made for other prior art reference relied on. The examiner submits that a person skilled in the art reading Canaday et al in 1982 would recognize that a variety of user computers (front end machines) are taught by the reference. Such machines range from very limited (special-purpose) to general-purpose computers and would, as of 1982, include a common general purpose microprocessor computer such as a PC. Since a special-purpose machine is clearly not going to be running multiple application programs or serving many users it cannot be considered to be a large host computer as envisioned by the Patent Holder. Thus, this reference and

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others used by the examiner needs to be interpreted, not as of the time it was written or with the same exact meaning attributed by the original author but rather as a person skilled in the art as of 1982 would read and understand the document. Microprocessors, or PC's were common terms of art applied to general purpose computers in the 1982 time frame and would therefore come to mind by a person in the art in 1982 reading these documents. The references thus teach equivalent computers or suggest obvious variation of the network computers [answer mailed September 8, 1997, page 5].

Thus, the examiner essentially provided an analysis as to why the claimed invention would have been obvious to the artisan even if the user computers were considered to be personal computers.

In our decision in the first request for rehearing filed after the previous decision, we stated the following:

The record before us, however, is complete with respect to the question of the obviousness of replacing the computers of the prior art references with PCs as required by the proposed definitions. The examiner has explained why it would have been obvious as of the date of this invention (1982) to replace the computers of Canaday, Lowenthal, Maryanski, Passafiume and Hsiao with PCs [final rejection and answer]. Although appellant does not agree with this conclusion, we agree with the examiner that PCs were designed for the very purpose of replacing the large shared computers in use at the time that the applied references were published, and the artisan would have found it obvious to replace large computers with PCs wherever it was practical to do so.

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Thus, although we agree with appellant that the applied references do not anticipate PCs in the Section 102 sense, we agree with the examiner on this record that it would have been obvious to one having ordinary skill in the art to replace the computers of the applied prior art with PCs connected in a distributed network [Decision on first request for rehearing, pages 5-6].

Thus, in affirming the examiner's rejection of the appealed claims under 35 U.S.C. § 103, we clearly considered the obviousness of modifying the applied prior art references to replace the disclosed front end computers with personal computers. Since this was the only difference to be considered for a proper Graham analysis, we are not persuaded by appellant's argument that he was not given a proper rejection under 35 U.S.C. § 103.

As noted above, Hsiao specifically teaches personal computers connected as front end computers in a distributed processing network [Figure 1]. Canaday states that "a reduction in the size of the host configuration may be possible" [page 577, 2nd column]. This would have suggested PCs to the artisan. Lowenthal states that the "hosts in this case might be small general-purpose or business computers" [page 12, 2nd column]. Again, this would have suggested PCs to the artisan. Passafiume

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states that a "user running his or her program will access the data base via a conventional computer" [page 252, 1st column]. As noted by the examiner, a user running programs on a conventional computer in 1982 would have suggested a PC as the user computer.

In view of the above discussion, even if it were determined that none of the applied prior art references discloses PCs as the host computers in an anticipatory sense, we would still find that each of the applied references teaches the obviousness of using a PC as the host computer as of the filing date of the application which resulted in the patent.

Appellant argues that the claimed invention is non-obvious based on the Patent Owner's evidence of secondary considerations which demonstrate enormous commercial success, the failure of others and copying of the invention. Appellant argues that the examiner has ignored this evidence [brief, pages 33-35]. The examiner responds that this evidence failed to establish a commercial success of the claimed invention. Specifically, the examiner finds that the evidence relates to the commercial success of an alleged infringer's product and not to the claimed invention itself [answer, pages 9-10].

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On this particular point, we essentially agree with the examiner. The Billings Declaration, at best, might establish that Billings is of the view that the product marketed by Novell infringes the claimed invention. The Declaration also establishes that the Novell product has made Novell a lot of money. What the Declaration does not establish, however, is that the commercial success of the Novell product is commensurate in scope with the claimed invention. Declarant Billings notes that the product sold by Novell underwent several changes over the years. The Declaration does not preclude the possibility that the commercial success of the Novell product was due to features of the product which do not form part of the claimed invention. In other words, even if the product sold by Novell does infringe the claimed invention, that, by itself, does not suggest that the commercial success is commensurate in scope with the claimed invention. The success of the Novell product could be due to enhancements which do not form part of the claimed invention. The statements of the Billings Declaration have been considered, but these statements do not establish commercial success commensurate in scope with the claimed invention.

In conclusion, the examiner's rejection of claims 27-43 under the first paragraph of 35 U.S.C. § 112 is sustained with

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respect to claims 27-32 but is not sustained with respect to claims 33-43. The rejection of claims 1-17 and 20-43, under 35 U.S.C. § 102 based on Hsiao is sustained with respect to all the claims on appeal. The rejections of claims 1-17 and 20-43, under 35 U.S.C. § 102 based on Canaday, Lowenthal or Passafiume are sustained with respect to claims 1-17, 20-26 and 35-43, but are not sustained with respect to claims 27-34. The rejections of claims 1-17 and 20-43 under 35 U.S.C. § 103 based on Canaday, Lowenthal, Passafiume or Hsiao are sustained with respect to each of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-17 and 20-43 is affirmed.

We remind appellant that this decision is based only on arguments which were specifically made in the appeal brief submitted for this appeal. Any arguments which may have been made previously in the lengthy prosecution of this application, but which were not included in the appeal brief for this appeal, have not been considered and are deemed to now be waived by appellant.

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

AFFIRMED

ERROL A. KRASS)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JERRY SMITH)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
LEE E. BARRETT)	
Administrative Patent Judge)	

JS/ki

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