

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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** TOSHIO HIROSAWA,  
TSUTOMO ITO, YOSHIHIRO ISHII and MINORU HIDAKA

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Appeal No. 2003-0646  
Application No. 09/250,154

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HEARD: July 15, 2003

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Before FLEMING, GROSS and LEVY, **Administrative Patent Judges.**

FLEMING, **Administrative Patent Judge.**

**DECISION ON APPEAL**

This is a decision on appeal from the final rejection of claims 4 through 7, all the claims present in the instant application. Claims 1 through 3 have been cancelled.

***INVENTION***

The invention relates to a method and a system for searching and collecting data from information providing World Wide Web servers through the Internet. See page 1 of Appellants' Specification. Figure 1 is a functional block diagram of a reserve request type of information search and distribution system of Appellants' invention. See page 5 of Appellants' Specification.

In Figure 1, the reserve request type of information search and distribution system is provided with a searching server 1 and a satellite communication server 2. Searching server 1 is connected to the internet 7 which is connected to the network access center 9. Satellite communication server 2 is connected to the network access center via satellite 12, 11 and 10 link. Searching server 1 and satellite communication server 2 are also connected to client terminals 6a through 6c via a land 5 and router 5a. See pages 6 and 7 of Appellants' Specification.

Independent claim 4 present in the application is reproduced as follows:

4. A reserved request type of searched information distribution server system comprising:

Appeal No. 2003-0646  
Application No. 09/250,154

first controlling means for receiving a first search request from one of a plurality of client terminals and issuing a data search request to a network access center connected to the Internet in order to search and collect desired data designated in said first search request from one of a plurality of Web servers connected to the Internet;

second controlling means for receiving searched data from said network access center via another network independent of the Internet and transferring received data with a data received time indicating a time the searched data was received to said first controlling means; and

a data file for storing said searched data in association with said data received time in response to said second controlling means,

wherein said first controlling means having means for receiving a second search request from one of said client terminals, checking if there is any requested data corresponding to said second search request in said data file, transmitting requested data retrieved from said data file to said client terminal which issued said second search request if said requested data is present in said data file, and issuing a data search request to one of said Web servers if said requested data is not present in said data file.

### **REFERENCES**

The references relied on by the Examiner are as follows:

Takase et al. (Takase)	5,822,535	Oct. 13, 1998
Chase et al. (Chase)	5,944,780	Aug. 31, 1999 (filed May 5, 1997)
Burns et al. (Burns)	5,991,306	Nov. 23, 1999 (filed Aug. 26, 1996)

Appeal No. 2003-0646  
Application No. 09/250,154

**REJECTIONS AT ISSUE**

Claims 4 through 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Burns and Chase. Claim 7 stands rejected under 35 U.S.C. 103 as being unpatentable over Burns and Chase as applied to claims 4 through 6 above, further in view of Takase.

Throughout the opinion, we make references to the Brief and the Answer for the respective details thereof.<sup>1</sup>

**OPINION**

With full consideration being given the subject matter on appeal, the Examiner's rejections and the arguments of Appellants and the Examiner, for the reasons stated **infra**, we reverse the Examiner's rejection of claims 4 through 7 under 35 U.S.C. 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

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<sup>1</sup> Appellants filed a Brief on July 30, 2002. Appellants filed a Reply Brief on December 24, 2002. The Examiner mailed out an office communication on January 8, 2003 stating that the Reply Brief has been entered.

Appeal No. 2003-0646  
Application No. 09/250,154

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 USPQ2d 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." **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the 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.

Appeal No. 2003-0646  
Application No. 09/250,154

Appellants argue that Appellants' claims clearly recite that the first control means is connected to the network access center via the Internet and the second control means is connected to the network access center via another network independent of the Internet. Appellants argue that if the ISP 56 taught by Burns includes all the functions of the first control means, second control means and network access center as alleged by the examiner, then the ISP 56 could not in any way correspond directly to the specific features recited in the claims which require that the first controlling means be separated from and connected to the network access center via the Internet and a second control means be separated and connected to the network access center via the network independent of the Internet. See page 7 of Appellants' Brief.

In response, the Examiner argues that Burns teaches the first control means shown as elements 70 and 74 in Figure 6 which issues a data research request to network center shown as element 56 in Figure 6 connected to the Internet shown as 54 in Figure 6 in order to search and collect desired data designated in the first search request from one of a plurality of web servers shown

Appeal No. 2003-0646  
Application No. 09/250,154

as element 52 in Figure 6. The Examiner further argues that Burns teaches a second control means shown as element 72 in Figure 6 for receiving search data from said network access center shown as element 56 in Figure 6 via another network shown as elements 202, 204, 206 and 208 shown in Figure 6 which are independent of the Internet shown as element 54 in Figure 6. See pages 3 and 4 of the Answer. The Examiner further argues that Appellants' independent claim 4 does not require the first controlling means to be connected to the access center via the Internet. The Examiner argues that the claim does not require a connection between the first control means and the Internet and that the claim only requires connection between the network access center and the Internet. See page 7 of the Answer.

As pointed out by our reviewing court, we must first determine the scope of claims 12 and 18. "[T]he name of the game is the claim." *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Claims will be given their broadest reasonable interpretation consistent with the specification, and limitations appearing in the specification are not to be read into the claims. *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5

Appeal No. 2003-0646  
Application No. 09/250,154

(Fed. Cir.), **cert. denied**, 474 U.S. 828 (1985). Our reviewing court also states in **In re Zletz**, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) that "claims must be interpreted as broadly as their terms reasonably allow."

Appellants argue that the scope of Appellants' claims do require that the first control means is connected to the network access center through the Internet. Appellants argue that the claim clearly recites that the first control issues a data search request to a network access center connected to the Internet. The only manner as recited in the claims for the network access center to receive search requests issued from the first controlling means is via the Internet and the only manner recited in the claims for the network access center to supply search data to the second controlling means is via another network independent of the Internet. See page 2 of Appellants' Reply Brief. Appellants further recite that this is fully supported by Appellants' Specification and Drawing which clearly show a first controlling means (searching server 1) for receiving a search request from the client terminal 6 and issuing a data search

Appeal No. 2003-0646  
Application No. 09/250,154

request to a network access center 9 via the Internet 7. See page 1 of the Reply Brief.

We note that Appellants' claim 4 recites "first controlling means for receiving a first search request from one of a plurality of client terminals and issuing a data search request to a network access center connected to the Internet in order to search and collect desired data designated in said first search request from one of a plurality of Web servers connected to the Internet." See Appellants' claim 4.

Our reviewing court has stated in *In re Donaldson Co., Inc.*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994) that the "plain and unambiguous meaning of paragraph six is that one construing means-plus-function language in a claim must look to the specification and interpret that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure."

We find that "first controlling means" corresponds to the structure searching server 1 shown in Figure 1 of Appellants' disclosure. The function provided by this structure is to one,

Appeal No. 2003-0646  
Application No. 09/250,154

receive a first search request from one of a plurality of client terminals and to two, issue a data search request to a network access center. We further note that the network access center function is to search and collect desired data designated in the first search request provided by their first controlling means from one of a plurality of web servers connected to the network.

We further note that the claim language clearly recites that the network access center is connected to the Internet and that the web servers are connected to the Internet. The claim language further recites "issuing a data search request to a network access center connected to the Internet in order [network access center] to search and collect desired data designated in said first search request from one of a plurality of Web servers connected to the Internet." [network access center] is provided for emphasis. From the construction of the claim language, the first control means is connected to the network access center through the Internet and the network access center is connected to the Web servers through the Internet. If we accepted the Examiner's interpretation, then the only connection recited would be the connection between the network access center and the Web

Appeal No. 2003-0646  
Application No. 09/250,154

servers. To accept this interpretation, then the two recitations of "connected to the Internet" would be redundant. Furthermore, the interpretation that the first controlling means is connected to the network access through the internet and that the network access center is connected to the Web servers through the Internet is entirely consistent with the specification.

Turning to Burns, we fail to find that Burns teaches a first controlling means for issuing a data search request to a network access center connected to the Internet which causes the network access center to search and collect the desired data designated in the first search request from a plurality of Web servers connected to the Internet. Burns discloses an Internet service provider (ISP 56) which acts as an intermediate between a subscriber personal computer 58 and 60 and network 54. Burns fails to teach a first controlling means being separated from and connected to the network access center via the Internet and the second control means being separated from and connected to the network access center via another network independent of the Internet. Therefore, we fail to find that the examiner has provided a *prima facie* case.

Appeal No. 2003-0646  
Application No. 09/250,154

Claim 7 stands rejected under 35 U.S.C. § 103 as being unpatentable over Burns and Chase and in further view of Takase. We note that the Examiner relies on Burns for the above limitations. Furthermore, we note that Takase does not provide the missing pieces. Therefore, we will not sustain this rejection for the same reasons as above.

In view of the foregoing, we have not sustained the Examiner's rejection of claims 4 through 7 under 35 U.S.C. § 103.

**REVERSED**

MICHAEL R. FLEMING	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
ANITA PELLMAN GROSS	)	APPEALS
Administrative Patent Judge	)	AND
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STUART S. LEVY	)	
Administrative Patent Judge	)	

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Appeal No. 2003-0646  
Application No. 09/250,154

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