

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 55

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AMERICAN ACADEMY OF SCIENCE
TECH CENTER

Appeal No. 98-1483
Application 90/003,463¹

ON BRIEF

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

JERRY SMITH, Administrative Patent Judge.

ON REQUEST FOR REHEARING

¹ Reexamination proceeding filed June 07, 1994. According to the appellant, this application is a reexamination of Application 06/921,219, filed October 20, 1986, now U.S. Patent 4,714,989; issued December 22, 1987; which is a continuation of Application 06/826,721, filed February 06, 1986 now abandoned; which is a continuation of Application 06/350,159, filed February 19, 1982, now abandoned.

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Appellant requests that we reconsider our decision of August 24, 1998 wherein we sustained the rejection of claims 1-17 and 20-26 as unpatentable under 35 U.S.C. § 102 or alternatively under 35 U.S.C. § 103 over a plurality of references applied individually under each noted section of the statute.

A brief review of the facts pertinent to this request for rehearing is in order. As noted in the opening paragraph above, the appeal originally was before us with rejections 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

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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 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.

In view of our decision which held that the scope of the claims was different from that agreed upon by appellant and the examiner, appellant requests that we amend our previous decision to indicate that we have asserted a new ground of rejection under 37 CFR § 1.196(b). In the alternative, appellant requests that we enter amendments filed concurrently with this request and instruct the examiner to issue a Certificate of Reexamination

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affirming patentability of the claims. For reasons which will become apparent infra, we will grant appellant the requested relief by designating our affirmance of the rejections under 35 U.S.C. § 102 as a new ground of rejection.

Appellant has argued that it should be allowed to further prosecute this reexamination before the examiner so that it can contest the definitions applied by the Board or insert the proposed definitions into the patent disclosure in order to support the narrower definitions. Appellant has also noted that our previous decision indicated that the examiner's rejection was inconsistent with his acceptance of the definitions proposed by appellant. According to appellant, this indication should have resulted in a ruling favorable to appellant.

After a careful review of the prosecution history of this reexamination proceeding, we agree with appellant that the simple affirmance of the examiner's Section 102 rejections based on definitions not considered by the examiner or appellant has produced a harsh and inequitable result on appellant. Appellant should not be penalized because the examiner improperly accepted definitions of claim terms which were unsupported by the disclosure. As we noted in the previous decision, the examiner's rejections under 35 U.S.C. § 102 were inconsistent with the

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definitions he and appellant had agreed to with respect to "user computer" and "distributed data processing system." Thus, we would have reversed the examiner's rejections under Section 102 if the definitions agreed upon had been used. We admit that our introduction of new definitions, while legally correct, has dramatically changed the issues under Section 102 as argued by appellant and the examiner. Therefore, we agree with appellant that the affirmance of the rejections under Section 102 should be designated a new ground of rejection.

We also note at this time that the merits of the rejections of the claims under 35 U.S.C. § 103 should have been considered on their own respective merits. Although anticipation is the epitome of obviousness, we would have affirmed the rejections of the claims under 35 U.S.C. § 103 even using the definitions proposed by appellant and accepted by the examiner. The difference between the definitions used by appellant and the examiner and the definitions used by us is that the agreed upon definitions require that the computers of the claims be personal computers (PCs) rather than larger or mainframe computers shared by several users.

The record before us, however, is complete with respect to the question of the obviousness of replacing the computers of

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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. 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.

In summary, we reaffirm our position on the scope of the claims which were on appeal before us, our decision to sustain the rejections of the claims under 35 U.S.C. § 102, and our decision to sustain the rejections of the claims under 35 U.S.C. § 103. However, we designate our affirmance of the rejections under 35 U.S.C. § 102 as constituting a new ground of rejection

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under 37 CFR § 1.196(b) based upon our nonacceptance of the definitions agreed to by the examiner and appellant.

We have granted appellant's request to the extent that we have designated our decision of August 24, 1998 as introducing a new ground of rejection under 37 CFR § 1.196(b). We have not considered appellant's proposed amendments submitted with the request for rehearing. Any further response by appellant should be made in accordance with the procedures outlined infra.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise

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one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record.
. . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejections, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for

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reconsideration thereof.

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

REQUEST GRANTED
PREVIOUS DECISION AFFIRMED
NEW REJECTION UNDER 37 CFR § 1.196(b)

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Errol A. Krass)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
Jerry Smith)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
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