

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(2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte VOLKERT BROSDA and  
VOLKER OBERMEIT

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Appeal No. 95-2429  
Application 07/916,770<sup>1</sup>

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ON BRIEF

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Before THOMAS, HAIRSTON, and JERRY SMITH, 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, 3 and 7-22, which constitute all the claims remaining in the application. Amendments after final rejection were filed on September 2, 1994

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<sup>1</sup> Application for patent filed July 17, 1992.



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Claims 1, 3 and 7-22 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Simonetti taken alone.

Rather than repeat the arguments of appellants 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 rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1, 3 and 7-22. Accordingly, we reverse.

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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 Hospital Systems, Inc. v. Montefiore Hospital, 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).

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The only applied reference in this case is the patent to Simonetti. Simonetti discloses a database search system and method which combines features of relational database searching and hierarchical database searching. The example of a hierarchical database relationship disclosed in Simonetti is the relationship between states, counties and cities [column 4]. Simonetti has no discussion whatsoever of a database system for storing data structures related to dictionary entries.

With respect to independent claim 1, the examiner basically found that Simonetti teaches a hierarchical database searching system. According to the examiner, although Simonetti does not teach the claimed features of dictionary entries or definitions of words, such limitations do not affect the functionality of the claimed system, and therefore, do not structurally distinguish the claimed invention from the Simonetti system [final rejection, pages 9-10]. Appellants argue that Simonetti does not disclose or suggest data structures of a dictionary entry, and that the hierarchy and labels of a dictionary entry data structure must be considered in the determination of obviousness. According to appellants, the

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hierarchy and label sequences for data structures of a dictionary entry would not have been obvious over the teachings of Simonetti because the components of a dictionary entry are not hierarchical by nature [brief, page 4]. Appellants also argue that Simonetti does not teach that some of the data segments collectively form a word definition as recited in claim 1.

The examiner has responded that the hierarchy that exists between streets, cities and states in Simonetti is just as natural as the hierarchy between the letters in the English alphabet and the alphabetical arrangement of words in a dictionary. Additionally, the examiner argues that "the hierarchy recited in the claims in question lacks adequate structure to distinguish over the prior art" [answer, page 4]. The examiner also asserts that the collection of data segments to form a word definition has not been given patentable weight because the phrase is simply a functional recitation without supporting structure.

We must first consider the examiner's implicit position that the recitation of specific data structures and labels cannot be used to structurally distinguish one database search system

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from another. We do not agree with this position as broadly applied by the examiner. The examiner's position is essentially the same position adopted by the examiner in In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). There, the court determined that a memory as a structure could be distinguished by the nature of the data structures which are stored therein. The court noted that the data structures in Lowry imposed a physical organization on the data, 32 F.3d 1583, 32 USPQ2d 1034. We are of the view that the data structures recited in the appealed claims impose a similar physical constraint on the memory which distinguishes the claimed memory from a memory which does not have these specific data structures.

We also note that independent claim 1, for example, also recites a "means for searching said data structures." We fail to see how such a means could be suggested by the prior art unless the particular data structures themselves were suggested by the prior art. Thus, we conclude that the specific recitations of the data structures must be considered in determining whether the appealed claims are unpatentable over the prior art.

Having made this determination, we observe that the examiner has argued that hierarchical data structures of a

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dictionary entry would have been obvious in view of the database system of Simonetti. As noted above, appellants argue that the artisan would not have appreciated that dictionary entries would lend themselves to hierarchical data structures of the type claimed. We agree. The claimed hierarchical data structures have nothing to do with the "commonly known lexical order" pointed to by the examiner. The hierarchy in the claimed invention is established between the items which make up the entry for a given dictionary entry (see Figures 2-5 which show the relationship for a single dictionary entry). We agree with appellants that such dictionary definitions are not normally considered to be hierarchical in nature in the manner recited in the claims. Therefore, the database of Simonetti would not have suggested the hierarchical data structure of a dictionary entry as recited in the claims.

Since both independent claims 1 and 22 recite the specific features of data structures which are not taught or suggested by the data structures of Simonetti, we do not sustain

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the rejection of the claims under 35 U.S.C. § 103. Therefore,  
the decision of the examiner rejecting claims 1, 3 and 7-22 is  
reversed.

REVERSED

JAMES D. THOMAS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
KENNETH W. HAIRSTON	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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JERRY SMITH	)	
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