

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JACK D. JOHNSON

Appeal No. 2002-0901
Application 09/126,996

ON BRIEF

Before KRASS, JERRY SMITH, and DIXON, 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 rejection of claims 1-29, which constitute all the claims in the application.

The invention pertains to a method and apparatus for addressing the problem associated with computers which may not properly transition with respect to certain date changes such as

Appeal No. 2002-0901
Application 09/126,996

from the year 1999 to the year 2000. The invention solves the problem by monitoring the current date and time and correcting the date just before the transition occurs.

Representative claim 1 is reproduced as follows:

1. A computer system comprising:

at least one central processing unit (CPU);

a system memory coupled to the CPU;

a non-volatile memory coupled to the CPU, the non-volatile memory storing a current date and time;

a real time clock coupled to the non-volatile memory to provide the current date and time to the non-volatile memory;

a memory for storing computer software, the computer software including a plurality of instructions capable of performing the operations of:

monitoring the current date and time at periodic intervals;

determining whether the current date is equal to a predetermined date;

if the current date is equal to the predetermined date, determining whether the current time is a predetermined amount of time before the end of that predetermined date;

if the current date is equal to the predetermined date and the current time is a predetermined amount of time before the end of the predetermined date, setting the date to the day after the predetermined date and setting the time to 00:00:00.

The examiner relies on the following references:

Anderson et al. (Erasoft) GB 2 312 060 Oct. 15, 1997

Appeal No. 2002-0901
Application 09/126,996

The RightTime Clock Company, Inc., (Y2KPCPro.Com v2.32b), May 23, 1998 and printed from <http://www.righttime.com/pub/year2000.tx>.

Claims 9, 10, 19 and 25 stand rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the invention¹. Claims 1-29 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Erasoft in view of The RightTime Clock Company.

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

OPINION

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

¹ This rejection was made in the final rejection, but it is not repeated in the examiner's answer. Since the response to arguments section of the answer, however, indicates that the rejection has been maintained, we will consider this rejection.

Appeal No. 2002-0901
Application 09/126,996

It is our view, after consideration of the record before us, that claims 9, 10, 19 and 25 particularly point out the invention in a manner which complies with 35 U.S.C. § 112. We are also of the view that the collective 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 1-29. Accordingly, we reverse.

We consider first the rejection of claims 9, 10, 19 and 25 under the second paragraph of 35 U.S.C. § 112. The examiner's rejection states that the term "about" in these claims is indefinite without a scale of reference [final rejection, page 3]. Appellant argues that the phrase "less than about five seconds" in claim 9 is a clear, but flexible definition that comports with the standards set forth in Ex Parte Eastwood, 163 USPQ 316 (Bd. Of Pat. App. & Int., 1968) and MPEP § 2173.02 [brief, pages 3-5]. The examiner responds by repeating the position that the term "about" is not specific enough [answer, page 3].

The general rule is that a claim must set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the disclosure as it would be by the artisan. In re Moore, 439 F.2d 1232, 1235,

Appeal No. 2002-0901
Application 09/126,996

169 USPQ 236, 238 (CCPA 1971). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed in light of the specification. Seattle Box Co., v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984). We agree with appellant that the term "about" as used in the claimed invention is reasonably precise and the artisan having considered the specification of this application would have no difficulty ascertaining the scope of the invention recited in the claims on appeal. Therefore, the rejection of claims 9, 10, 19 and 25 under the second paragraph of 35 U.S.C. § 112 is not sustained.

We now consider the rejection of claims 1-29 under 35 U.S.C. § 103(a) as unpatentable over the teachings of Erasoft and The RightTime Clock Company. 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

Appeal No. 2002-0901
Application 09/126,996

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 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

Appeal No. 2002-0901
Application 09/126,996

in the brief have not been considered and are deemed to be waived [see 37 CFR § 1.192(a)].

With respect to independent claim 1, the examiner cites Erasoft as teaching a computer system which monitors the current date and time at periodic intervals. The examiner cites the document from the RightTime Clock Company as teaching that an erroneous DOS date in a computer can be corrected. The examiner finds that it would have been obvious to the artisan to periodically monitor the date and time in Erasoft and to set the desired date and time before the roll over to the year 2000 in order to avoid unpredictable events from an erroneous year reading [final rejection, page 4].

Appellant argues that the corrective action in Erasoft is not taken until after transition to the year 2000 has already occurred. Appellant also argues that the document from The RightTime Clock Company also takes corrective action after the date rollover. Appellant argues there is no basis within the applied prior art for the examiner's alleged motivation for combining the prior art teachings to set the correct date before the transition has occurred as claimed [brief, pages 5-7]. The examiner simply repeats the basis for the rejection in response to appellant's brief. Appellant responds that the examiner's

Appeal No. 2002-0901
Application 09/126,996

position is nothing but a conclusory opinion which is not supported by any of the evidence of record in this case [reply brief].

We will not sustain the examiner's rejection of claim 1 for essentially the reasons argued by appellant in the briefs. The only evidence on this record which suggests setting the correct time and date before a predetermined date occurs comes from appellant's own disclosure. The examiner's mere opinion that it would have been obvious to the artisan to modify the prior art so as to arrive at the claimed invention lacks any support from the applied prior art. As argued by appellant, neither the examiner nor the Board of Patent appeals and Interferences can simply substitute their opinion for evidence lacking in the record.

Each of independent claims 13, 20 and 27 contains limitations similar to the limitations considered above with respect to claim 1. Therefore, we also do not sustain the examiner's rejection of any of the independent claims on appeal

Appeal No. 2002-0901
Application 09/126,996

or of any of the claims which depend therefrom. Accordingly, the decision of the examiner rejecting claims 1-29 is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
)	
)	
)	
JERRY SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
JOSEPH L. DIXON)	
Administrative Patent Judge)	

JS/dal

Appeal No. 2002-0901
Application 09/126,996

HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS CO 80527-2400