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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte STEFANO CELESTINI

Appeal 2010-007148
Application 11/463,918
Technology Center 2800

Before JOHN A. JEFFERY, DENISE M. POTHIER, and BARBARA A. BENOIT, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-10, 12, 13, and 15-17. Claims 11, 14, and 18-20 have been indicated as containing allowable subject matter. Br. 5.[1] We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

[1] Throughout this opinion, we refer to the Appeal Brief filed October 1, 2009 ("Br.") and the Examiner's Answer mailed January 26, 2010 ("Ans.").

STATEMENT OF THE CASE

Appellant's invention remotely monitors and controls machines in various environments via a self-contained machine monitoring device (MMD) that is connected to one or more client computing devices on a network. Since the MMD provides self-contained data storage, processing, configuration, and reporting services, it is not dependent on external computers for these functions. *See generally* Spec. ¶ 0019. Claim 1 is illustrative with a certain disputed limitation emphasized:

> 1. A system for monitoring a machine, said system comprising:
> a machine monitoring device connected to said machine, said machine monitoring device comprising:
> input means connected to said machine for receiving inputs from said machine;
> an engine connected to said input means for performing transformations on said inputs, wherein said transformations apply a mathematical operation or a logical operation on said inputs to generate outputs;
> a database system connected to said engine to store said outputs; and
> *report generating means connected to said database system for generating reports based on said outputs*; and
> a client computing device connected to said machine monitoring device by a communications network for receiving said reports to allow a user to monitor said machine from said client computing device.

THE REJECTIONS

1. The Examiner rejected claims 1-7, 10, 12, 13, 15, and 16 under 35 U.S.C. § 102(b) as anticipated by Adachi (US 2002/0161551 A1; Oct. 31, 2002). Ans. 3-6.

2. The Examiner rejected claim 8 under 35 U.S.C. § 103(a) as unpatentable over Adachi and RS-232 (Wikipedia.org, *RS-232* (printed Nov. 2007)).[2] Ans. 7.

3. The Examiner rejected claim 9 under 35 U.S.C. § 103(a) as unpatentable over Adachi and Lech (US 2002/0082736 A1; June 27, 2002). Ans. 8.

4. The Examiner rejected claim 17 under 35 U.S.C. § 103(a) as unpatentable over Adachi and Tozer (WO 02/082302 A1; Oct. 17, 2002). Ans. 8-9.

THE ANTICIPATION REJECTION

The Examiner finds that Adachi discloses every recited element of independent claim 1 including an "integrated machine monitoring device (MMD)" (controller 2) comprising (1) a "database system" (the controller's memory 2d) connected to an "engine" (CPU 2c) to store the engine's outputs, and (2) a "report generating means" (personal computers (PCs) 4, 5, 8) for generating reports based on the outputs. Ans. 4, 9-13.

Appellant argues that Adachi's (1) controller is not an integrated MMD; (2) memory 2d is not a database system; and (3) PCs are not equivalent to the recited report generating means. Br. 25-27. Appellant adds that Adachi does not (1) generate reports directly on an MMD, and (2)

[2] This reference was printed after the effective filing date of the present invention and is from Wikipedia—a non-peer-reviewed source. *See, e.g., Ex parte Three-Dimensional Media Group, Ltd.*, 2010 WL 3017280 at *17 (BPAI 2010) (non-precedential). Nevertheless, Appellant does not dispute the reference's qualification as prior art.

transmit the reports from the MMD to a client computing device as recited in claim 16. Br. 28-29.

ISSUES

Under § 102, has the Examiner erred by finding that Adachi discloses:

(1) an integrated MMD comprising (a) a database system connected to the MMD's engine to store the engine's outputs, and (b) report generating means connected to the database system for generating reports based on the outputs as recited in claim 1?

(2)(a) generating reports directly on the machine monitoring device, and (b) transmitting the reports from that device to a client computing device as recited in claim 16?

ANALYSIS

Claims 1-7, 10, 12, 13, and 15

We begin by noting that the integrated MMD in independent claim 1 comprises four elements: (1) an input means; (2) an engine; (3) a database system; and (4) report generating means. Like the input means (which is not at issue here), the report generating means is recited in means-plus-function format which we construe according to the corresponding structure in the Specification and its equivalents. *See* 35 U.S.C. § 112, ¶ 6; *see also In re Donaldson Co., Inc.*, 16 F.3d 1189, 1193 (Fed. Cir. 1994) (en banc).

Appellant identifies elements 155 and 160 in connection with the recited report generating means. Br. 8 (citing Spec. ¶¶ 0042, 0048, 0050; Fig. 3). As shown in Appellant's Figure 3, reports Common Gateway Interface (CGI) module 155 is within the web server 165 of MMD 20 and

generates reports for an associated machine 15. Spec. ¶ 0048. To this end, the reports CGI module generates a web page with a menu of viewable reports for user selection. *Id.* After the user enters associated parameters, the module uses information received from database manager 175 to generate a web page containing the selected report that is transmitted to CD 35. *Id.*

The MMD's reporter module 160 also generates reports. Spec. ¶ 0050. But unlike the reports CGI module, the reporter module automatically periodically generates and writes backups of all MMD reports to a CD. *Id.* The report may be output in Microsoft Excel or comma separate values (CSV) format. *Id.*

In view of these dedicated reporting functions, we find the Examiner's mapping Adachi's PCs 4, 5, and 8 to the recited report generating means problematic. First, claim 1 requires that the MMD *comprises* the report generating means as noted above. The Examiner, however, maps the recited MMD to Adachi's controller 2 (Ans. 4, 10) which does not contain the PCs, but rather is directly coupled to PC 8 and indirectly coupled to PCs 4 and 5 via server 3 and either satellite 6 or PC 8—a coupling that the Examiner acknowledges. Ans. 12; *see also* Adachi ¶¶ 0102-06; Figs. 1-2. Although the term "comprising" recited in connection with the MMD does not preclude additional unrecited elements,[3] and the claim does not expressly recite that the report generating means is *part of* the MMD as the Examiner indicates (Ans. 13), the recited MMD nonetheless *must have* the four recited

[3] "'Comprising' is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim." *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501 (Fed. Cir. 1997) (citation omitted).

elements noted above, but could have additional elements and still fall within the scope of claim 1 due to the "comprising" language. But to say that the controller 2 (the "MMD" under the Examiner's mapping) *comprises the PCs* due to their coupling strains reasonable limits on this record. Rather, Adachi's controller 2 has six constituent elements 2a-2f as shown in Figure 2. Although the Examiner's position regarding coupled elements (Ans. 12-13) may have merit regarding a *system* comprising those elements, it is problematic when applied to the MMD which the Examiner maps solely to Adachi's controller. So even assuming, without deciding, that the memory 2d in Adachi's controller 2 constitutes a "database system" as the Examiner contends (Ans. 11-12), the controller still does not comprise the report generating means as claimed.

The Examiner's position is further undercut by the reporting capabilities of server 3's CPU 3c as Appellant indicates. Br. 27 (citing Adachi ¶ 0112). Although this report generating capability is arguably at least equivalent to the recited report generating means, it is performed by the server—not the controller (the "MMD") or the PCs. *See id.* In any event, PC 8 merely transfers operation information acquired from a machine to the server in lieu of the satellite link as Appellant indicates. Br. 26 (citing Adachi ¶ 0103). Although this operation information can have a "predetermined form" (Adachi ¶ 0105), to say that transferring this information via the computer constitutes a "report generating means" as the Examiner asserts strains reasonable limits, particularly in light of this means' corresponding structure in Appellant's Specification and Adachi's distinct server-based reporting functions noted above. We reach a similar conclusion regarding Adachi's PCs 4 and 5, for they do not generate reports

in the manner described in the Specification, but merely receive and display the reports that are generated by the server. *See* Adachi ¶ 0112.

We are therefore constrained by this record to find that the Examiner erred in rejecting (1) independent claim 1, and (2) dependent claims 2-7, 10, 12, 13, and 15 for similar reasons. To the extent that integrating various machine monitoring, database, and report generating functions distributed throughout Adachi's system in a single device would have been obvious is a question not before us, nor will we speculate in that regard here in the first instance on appeal. What we can say, however, is that the Examiner's anticipation rejection is untenable on this record.

Claim 16

Although a closer question, we likewise do not sustain the Examiner's rejection of independent claim 16 which recites, in pertinent part, (1) generating reports *directly on* an MMD, and (2) transmitting the reports *from the MMD* to a client computing device. Unlike claim 1, claim 16 not only lacks an "integrated" MMD, but also lacks a "report generating means." Rather, claim 16 recites the affirmative method step of generating reports *directly on* the MMD. But despite these distinctions, we still find the Examiner's position that Adachi's "outputt[ing]/report[ing] operation information . . . directly on/from the controller 2" (Ans. 14) is problematic when construing the recited report generation step in light of the Specification as noted previously. In short, Adachi's reports are generated at the server—not the controller (the "MMD"). Accordingly, we agree with Appellant (Br. 28) that Adachi does not generate reports *directly on* the MMD, let alone transmit those reports from the MMD as claimed.

We are therefore constrained by this record to find that the Examiner erred in rejecting independent claim 16.

THE OBVIOUSNESS REJECTIONS

Since the Examiner has not shown that the additional cited references cure Adachi's deficiencies noted above, we likewise reverse the Examiner's obviousness rejections of claims 8, 9, and 17 (Ans. 7-9) for similar reasons.

CONCLUSION

The Examiner erred in rejecting (1) claims 1-7, 10, 12, 13, 15, and 16 under § 102, and (2) claims 8, 9, and 17 under § 103.

ORDER

The Examiner's decision rejecting claims 1-10, 12, 13, and 15-17 is reversed.

REVERSED

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