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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MATTHIEU CATALANO, YVES CROCHEMORE,  
DOMINIQUE LLORENS-CORTES, HENRI MARIE-AGNES,  
and DIDIER RODRIGUE

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Appeal 2014-009394<sup>1</sup>  
Application 10/887,928  
Technology Center 3600

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Before: MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and  
MICHAEL W. KIM, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants seek our review under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1, 3–24, 51, 63–65, and 67–89<sup>2</sup>. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE but enter a new ground of rejection.

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<sup>1</sup> Appellants identify SNECMA SERVICES as the real party in interest. Appeal Br. 2.

<sup>2</sup> Claim 89 depends from canceled claim 66. Claims 90–100 are withdrawn.

Appellants' invention is directed generally to managing machine servicing. (Spec. 5, ll. 6–8).

Claims 1 and 64 are illustrative:

1. A system for managing service of a machine, comprising:
  - at least one database for storing:
    - structural information about the machine;
    - servicing information relevant to the machine, including at least repair procedures and maintenance procedures which can be used for fixing or maintaining the machine;
    - at least one service reason information which includes a predefined reason for servicing the machine, the stored at least one reason for servicing the machine being linked to primary work information which includes at least one of the stored repair procedures and stored maintenance procedures; and
    - secondary work information corresponding to at least some of the stored repair and maintenance procedures, the secondary work information comprising work that has no direct relation to a given stored repair or maintenance procedure except that the secondary work must be performed to permit performance of the given stored repair or maintenance procedure;
  - a display unit configured to display an interface for selecting at least one of the stored reasons for servicing the machine;
  - a processor configured to automatically generate a workscope which identifies work to be performed on the machine in response to the at least one reason for servicing the machine, the workscope including the at least one of the repair and maintenance procedures of the primary work information which is automatically selected on the basis of the selected at least one reason for servicing the machine, and the at least some of the stored repair and maintenance procedures of the secondary work information corresponding to each of the at least one of the repair and maintenance procedures of the primary work

information, the at least some of the stored repair and maintenance procedures of the secondary work information being automatically selected on the basis of the selected at least one reason for servicing the machine; and

a transmission unit configured to transmit the generated workscope via a network to a computing device.

64. A method of managing machine servicing, comprising:  
identifying one or more reasons for servicing the machine;  
automatically identifying required primary work needed to address the identified one or more reasons for servicing by a computer including a database, the primary work including repair and/or maintenance procedures stored in the database that corresponds to the identified one or more reasons for servicing;

automatically identifying secondary work by the computer including the database, the secondary work including work stored in the database that has no direct relation to a given stored repair or maintenance procedure except that the secondary work must be performed to permit performance of each of the repair and/or maintenance procedures of the primary work; and

generating a workscope defining the work to be performed on the machine by the computer, the workscope including the identified primary work and the identified secondary work.

Appellants appeal the following rejections:

Claims 1, 3, 4, 15–20, 23, 24, 51, 63–65, 67, 68, 74–80, and 85–88 are rejected under 35 U.S.C. § 102(b) as anticipated by Sinex (US 6,442,459 B1, iss. Aug. 27, 2002).

Claims 5–8, 13, 14, 69, 83, and 84 are rejected under 35 U.S.C. § 103(a) as unpatentable over Sinex and Wetzler (US 2002/0143421 A1, pub. Oct. 3, 2002).

Claims 9 and 70 are rejected under 35 U.S.C. § 103(a) as unpatentable over Sinex, Wetzler, and Gonyea (US 2001/0032109 A1, pub. Oct. 18, 2001).

Claims 10, 21, 22, and 71–73 are rejected under 35 U.S.C. § 103(a) as unpatentable over Sinex, Wetzler, Gonyea, and Applicant-Admitted Prior Art.

Claims 11 and 81 are rejected under 35 U.S.C. § 103(a) as unpatentable over Sinex and Rosenfeld (US 6,901,377 B1, iss. May 31, 2005).

Claims 12 and 82 are rejected under 35 U.S.C. § 103(a) as unpatentable over Sinex, Rosenfeld, and Official Notice.

Claim 89<sup>3</sup> is rejected under 35 U.S.C. § 103(a) as unpatentable over Sinex and Thomas (US 2003/0154199 A1, pub. Aug. 14, 2003).

## ANALYSIS

Appellants argue Sinex fails to disclose generating a workscope including information about both primary and secondary work, where the secondary work “has no direct relation to a given stored repair or maintenance procedure except that the secondary work must be performed to permit performance of the given stored repair or maintenance procedure,” as claimed in each of independent claims 1, 51, and 64. (Appeal Br. 6–11; *see also* Reply Br. 1–4).

The Examiner finds the recited language disclosed in Sinex (Final Act. 8–11; *see also Id.* at 6–16), and also finds the secondary work language contradicts itself as to being both related to, and having “no direct relation”

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<sup>3</sup> Claim 89 depends from claim 66, which is canceled.

to the primary work, and “asserts that the claimed invention does not positively recite any work being done” because it merely makes an identification of work. (Answer 8–9).

Appellants indicate the findings about the contradictory language appear to be an implied rejection under 35 U.S.C. § 112, second paragraph for indefiniteness, but no explicit rejection was made. (Reply Br. 4–5). Appellants also interpret the Examiner’s Response to Argument as an implied finding that the secondary work information should not receive patentable weight, but assert that the “except that” language in the claim sufficiently clarifies the “no direct relation” language. (*Id.*).

Independent claims 51 and 64 recite identifying information (of reasons for servicing a machine, primary work needed, and secondary work), and generating a “workscape.” The term “workscape” is not defined. But the Specification offers guidance describing by example, “the workscape can be generated based on stored data.” (Spec. 6, ll. 5–7). The report is generated by generating an output of linked information from a database. (Spec. 27, l. 23 to 29, l. 15). We, thus, construe the workscape to be a report containing information on the reason(s) for servicing the machine, and work required to service the machine.

Independent claim 1 recites a system with a database for storing information about secondary work, which has the same “no direct relation . . . except” language as claims 51 and 64. Claim 1 also recites “a processor configured to automatically generate a workscape” encompassing the same secondary work information.

The information in the database that is output on the report may, potentially, be categorized a mere printed matter, if the content of the

information does not functionally relate to the claimed method and configured system, which identify information and generate the report. *See In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004).

However, in order to determine if the “identified secondary work” has a functional relationship or not to the underlying method or configured system, we must first understand the language about “the secondary work including work stored in the database that has no direct relation to a given stored repair or maintenance procedure except that the secondary work must be performed to permit performance of each of the repair and/or maintenance procedures of the primary work.”

The trouble with this clause is that work that is performed on the same machine, or by the same entity, or using the same tools, or in the same physical location, would have a direct relation to the primary work because of any of these relationships of machine, entity, tools, or location. As a result, the primary and secondary work so related would fail to have “no direct relation.”

The “direct relation” is not defined by the Specification, which states, for example, “if the primary work relates to a component physically located deep within a machine, secondary work consisting of, for example, disassembling the overlying structure of the machine to permit access to the component may be necessary.” (Spec. 11, l. 23 to 12, l. 2). However, the primary and secondary work *are directly* related, by being performed on the same machine, but the claims recite, “the secondary work information comprising work that has *no direct* relation to a given stored repair or maintenance procedure.”

Where claims do not particularly point out and distinctly claim the invention as required by the second paragraph of 35 U.S.C. § 112, a prior art rejection of the claims must be reversed as impermissibly involving speculative assumptions as to the meaning of the claims. *In re Steele*, 305 F.2d 859, 862- 63 (CCPA 1962). If no reasonably definite meaning can be ascribed to certain terms in the claim, “the subject matter does not become obvious - the claim becomes indefinite.” *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

Therefore, we reverse *pro forma* the rejections under 35 U.S.C. § 102(b) of independent claims 1, 51, and 64. We also reverse *pro forma* the rejections of dependent claims 3, 4, 15–20, 23, 24, 63, 65, 67, 68, 74–80, and 85–88, rejected under 35 U.S.C. § 102(b), and claims 5–14, 21, 22, 69–73, and 81–84 rejected under 35 U.S.C. § 103(a).

Using our authority under 37 C.F.R. § 41.50(b), we reject independent claims 1, 51, and 64 under 35 U.S.C. § 112, second paragraph, as being indefinite, based on our inability to determine the precise meaning of “not directly related . . . except that the secondary work must be performed to permit performance of the given stored repair or maintenance procedure” in claims 1, 51, and 64. We also reject dependent claims 3–24, 63, 65, and 67–89 because they depend from the rejected independent claims, and therefore recite the same indefinite language. As a result, we are unable to precisely determine if the information on primary and secondary work represent mere printed matter, or bear a functional relationship to the underlying structure or method claimed.

DECISION

We reverse *pro forma* the rejections of claims 1, 3–24, 51, 63–65, and 67–89.

We enter a new ground of rejection of claims 1, 3–24, 51, 63–65, and 67–89 under 35 U.S.C. § 112, second paragraph, as indefinite.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b) (2008). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner . . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record . . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED; 37 C.F.R. § 41.50(b)