UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Ex parte CSB-SYSTEM INTERNATIONAL, INC.
Patent Owner and Appellant

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Appeal 2014-003666
Reexamination Control 90/012,210
Patent 5,631,953
Technology Center 3900

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Before MAHSHID D. SAADAT, MICHAEL J. STRAUSS, and
ROBERT J. WEINSCHENK, *Administrative Patent Judges.*

WEINSCHENK, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING

Appellant CSB-System International, Inc. ("Appellant") requests
rehearing of the Decision on Appeal mailed July 31, 2014 ("Decision"),
wherein we affirmed the Examiner's rejections of claims 1–8 of U.S. Patent
No. 5,631,953 ("the '953 patent") (*see* Decision 19–20). We refer herein to
Appellant's Appeal Brief filed August 5, 2013 ("App. Br."), the Examiner's
Answer mailed September 18, 2013 ("Ans."), Appellant's Reply Brief filed
November 18, 2013 ("Reply Br."), and Appellant's Request for Rehearing
filed September 30, 2014 ("Reh'g Req."). We reconsidered the Decision in
light of Appellant's arguments in the Request for Rehearing, but, for the
reasons discussed below, we do not modify the Decision.

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A request for rehearing is limited to matters overlooked or misapprehended by the panel in rendering the original decision. *See* 37 C.F.R. § 41.52. Appellant's arguments do not persuade us we overlooked or misapprehended matters in the Decision, but, for completeness, we address Appellant's arguments in the Request for Rehearing below.

CLAIM CONSTRUCTION

As explained in the Decision, Appellant acknowledges that the claims of the '953 patent are given their broadest reasonable interpretation consistent with the Specification (Decision 4–5; App. Br. 17).

Construction of "Personal Computer"

Appellant argued in the Appeal Brief the term "personal computer" in claim 1 should be construed to exclude a personal computer operating as a terminal (App. Br. 27–29). In the Decision, we considered Appellant's proposed construction and found it was not supported by the evidence of record (Decision 7–8). In the Request for Rehearing, Appellant urges the same proposed construction for the term "personal computer," and presents additional arguments that were not raised in the Appeal Brief (Reh'g Req. 2–13; App. Br. 27–29). Appellant's additional arguments in the Request for Rehearing are untimely and waived because Appellant does not show good cause as to why those arguments were not presented in the Appeal Brief. *Ex parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010) (informative). Further, even if Appellant's additional arguments were presented timely, they are not persuasive for the reasons below.

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Appellant argues we should adopt its proposed construction because the claims of the '953 patent use the term "personal computer," rather than a broader term such as "computing device" (Reh'g Req. 2–4). Appellant's argument is not persuasive. Appellant does not identify any language in the claims of the '953 patent indicating that the term "personal computer" excludes a personal computer operating as a terminal. The claims recite the term "personal computer" broadly without any limitation as to how the personal computer operates, other than to require that the personal computer send and receive data records (App. Br. 94). As explained in the Decision, the evidence of record, including the prior art of record, shows a personal computer operating as a terminal that can send and receive data records (Decision 8). Therefore, the evidence of record does not support Appellant's argument that the term "personal computer" excludes a personal computer operating as a terminal.

Appellant argues a person of ordinary skill in the art in 1993 would not have understood a terminal to be a personal computer (Reh'g Req. 4–11). Specifically, Appellant points to several excerpts from the prior art that use the word "terminal" to refer to a personal computer operating as a terminal (*id.* at 4, 6–7). The evidence cited by Appellant does not show, as Appellant suggests, that terminals and personal computers are "mutually exclusive" (*id.* at 4). Rather, the evidence of record indicates that certain prior art references may refer to a *subset* of personal computers, namely personal computers operating as terminals, using the word "terminal" (*id.* at 4, 6–7). Because, as discussed above, the claims of the '953 patent refer broadly to a "personal computer," we agree with the Examiner that the

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broadest reasonable interpretation of the term "personal computer" consistent with the Specification includes a personal computer operating as a terminal.

Appellant argues that we should adopt the construction of "personal computer" set forth in the claim construction opinion issued by the U.S. District Court for the Eastern District of Pennsylvania ("District Court") in the lawsuit styled *CSB-System International, Inc. v. SAP America, Inc.*, No. 2:10-cv-2156-RB (E.D. Pa.) ("Lawsuit") (Reh'g Req. 11). Appellant's argument is not persuasive. The District Court's claim construction is not binding in this reexamination proceeding. *In re Trans Texas Holdings Corp.*, 498 F.3d 1290, 1297–98 (Fed. Cir. 2007). Further, Appellant does not explain why the District Court's construction is the broadest reasonable interpretation. *See In re Swanson*, 540 F.3d 1368, 1377–78 (Fed. Cir. 2008) (explaining the difference between claim construction in district courts and reexamination proceedings). Also, as explained in the Decision, the District Court did not indicate whether its construction of "personal computer" excludes a personal computer operating as a terminal (Decision 7). In the Request for Rehearing, Appellant points out that the District Court's construction defines a personal computer as having independent computing power, and Appellant argues that a personal computer operating as a terminal does not have independent computing power (Reh'g Req. 11). However, Appellant does not provide any evidence to support that argument. *See id.; In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974).

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Appellant argues there is evidence from the Lawsuit demonstrating that the '953 patent relates to a client-server architecture (Reh'g Req. 11–13). Even assuming *arguendo* the '953 patent generally discusses a client-server architecture, Appellant does not explain why that means the term "personal computer" excludes a personal computer operating as a terminal (*id.*). As explained in the Decision, the Specification of the '953 patent does not indicate that the term "personal computer" excludes a personal computer operating as a terminal (Decision 7–8).

Construction of "LAN Server"

Appellant argued in the Appeal Brief the term "LAN server" in claim 1 should be construed to mean a computer providing shared services to other components on the Local Area Network ("LAN") and responding to requests from clients (App. Br. 30). In the Decision, we concluded the term "LAN server" did not require express construction (Decision 8–9). In the Request for Rehearing, Appellant argues the term "LAN server" should be construed to include additional requirements not identified previously in the Appeal Brief, specifically, to require that the LAN server "responds to client requests from personal computers integrated with telephone extensions" (Reh'g Req. 13–14; App. Br. 29–33). Appellant's new proposed construction for the term "LAN server" in the Request for Rehearing is untimely and waived because Appellant does not show good cause as to why it was not presented in the Appeal Brief. *Borden*, 93 USPQ2d at 1474. Further, even if Appellant's new proposed construction was presented timely and we were to adopt it, Appellant does not demonstrate any resultant error in the Decision with respect to the prior art rejections for the reasons below.

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PRIOR ART REJECTIONS

Anticipation of Claim 1 by Heinzelmann

Appellant argues we erred because Heinzelmann does not teach a
LAN server that responds to client requests from personal computers
integrated with the telephone extensions (Reh'g Req. 14–15). Appellant's
argument is untimely and waived: (i) because Appellant does not show good
cause as to why this argument was not presented in the Appeal Brief, and (ii)
because, as discussed above, Appellant's argument regarding the
construction of the term "LAN server" is also untimely and waived. *Borden*,
93 USPQ2d at 1474. Moreover, Appellant's argument is not persuasive
because we find Heinzelmann *does* teach a LAN server that responds to
personal computers integrated with telephones. For example, Heinzelmann
discloses:

> **FIG. 1** is a block diagram of a well-known *STAR-LAN PC-*
> *based network 10* and a well-known PBX network **20** which are
> *connected by* a phone management server device 21 to provide
> *phone management functionality to network 10* in accordance
> with the present invention.

(Heinzelmann 3:8–13) (emphasis added). Thus, Heinzelmann teaches a
LAN server in network 10 for responding to personal computers 11_1 to 11_3
that are integrated with telephones 23_1 to 23_4 via the phone management
server device 21 (*id.* at Fig. 1, 3:8–13). In the Request for Rehearing,
Appellant does not address that specific teaching in Heinzelmann.

Appellant also argues we erred because the EDP system recited in
claim 1 requires a shared database, but Heinzelmann only teaches a LAN
server, not a shared database (Reh'g Req. 15–16). Appellant's argument is

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not persuasive. As explained in the Decision, Heinzelmann teaches an
AT&T STARLAN PC Local Area Network (PC-LAN) allowing personal
computers to access *shared* directories and files (Decision 12). However, in
the Request for Rehearing, Appellant does not address the specific teaching
of *shared* directories and files in Heinzelmann.

Anticipation of Claims 1–6 by Gursahaney

Appellant argues we erred because the personal computers in
Gursahaney operate as terminals (Reh'g Req. 16–18). Appellant's argument
is not persuasive. As discussed above, the term "personal computer" in
claim 1 encompasses personal computers operating as terminals.

Appellant also argues we erred because the host computer in
Gursahaney, which was cited by the Examiner as teaching the claimed
"LAN server," does not respond to client requests (Reh'g Req. 18–19).
Specifically, Appellant argues, in Gursahaney, "a terminal connected to a
host computer is a 'dumb' terminal and does not do any requesting" (*id.*).
Appellant's argument is not persuasive. As explained in the Decision,
Gursahaney teaches the workstations (or clients) on the LAN automatically
access host applications running on the host computer via the LAN in order
to obtain caller-specific information from the host computer (Decision 13
(citing Gursahaney 4:45–48)). Thus, Gursahaney teaches the workstations
request caller-specific information from the host computer, which responds
to those client requests. In the Request for Rehearing, Appellant does not
address that specific teaching in Gursahaney.

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Obviousness of Claims 1–8 over IBM and Gursahaney

Appellant argues we erred because the personal computers in the Administrator's Guide operate as terminals (Reh'g Req. 19–20). Appellant's argument is not persuasive. As discussed above, the term "personal computer" in claim 1 encompasses personal computers operating as terminals.

Appellant also argues we erred because we improperly relied on the User's Guide, rather than the Administrator's Guide cited by the Examiner, as teaching the claimed "LAN server" (Reh'g Req. 20–21). Appellant's argument is not persuasive. In the Decision, we cited to Figure 1 of the Administrator's Guide as teaching the LAN server (Decision 19). Appellant also repeats the argument from its Appeal Brief that the Administrator's Guide does not teach a LAN server because a host application may reside on the LAN server disclosed in the Administrator's Guide (Reh'g Req. 21; App. Br. 90–91). As explained in the Decision, claim 1 recites "a LAN connected to a LAN server" and does not limit the types of applications that can reside on the LAN server (Decision 19). As such, Appellant's argument is not persuasive.

DECISION

We grant the Request for Rehearing to the extent that we reconsidered the Decision in light of Appellant's arguments in the Request for Rehearing, but we deny the Request for Rehearing in that we do not modify the Decision.

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Requests for extensions of time in this *ex parte* reexamination proceeding are governed by 37 C.F.R. § 1.550(c). *See* 37 C.F.R. § 41.50(f).

DENIED

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