

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER D. CLARK

Appeal No. 2001-1606
Application 08/582,661

ON BRIEF

Before THOMAS, 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, 3-21 and 23-25, which constitute all the claims remaining in the application.

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Representative claim 1 is reproduced as follows:

1. A method for sharing a resource between a plurality of threads of a multi-threaded program, the method comprising the steps of:

(A) causing a first thread of said plurality of threads to perform the steps of

(A1) acquiring a resource lock associated with said source;

(A2) holding said resource lock until detecting that another thread of said plurality of threads requires use of said resource;

(A3) in response to detecting that another thread of said plurality of threads requires use of said resource, performing the steps of

(a) finishing any use of said resource;

(b) releasing said resource lock; and

(c) requesting said resource lock.

The examiner relies on the following reference:

Richter, Jeffrey, Advanced Windows NT™:The Developer's Guide to the Win32 Application Programming Interface, Microsoft Press, 1993, pages 173-288.

Claims 1, 3-21 and 23-25 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Richter taken alone.

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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 appellant's arguments set forth in the briefs 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, 3-21 and 23-25. Accordingly, we reverse.

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

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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 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

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Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived by appellant [see 37 CFR § 1.192(a)].

The examiner's rejection is set forth on pages 3-9 of the examiner's answer. With respect to independent claims 1 and 15, appellant argues that Richter does not teach the step of causing a first thread to hold a lock resource until another thread requires use of the resource. According to appellant, in Richter all threads release the lock after accessing the resource. Appellant also argues that even though the examiner took "Official Notice" that causing a thread to perform a desired function was well-known in the art, this does not mean that causing a thread to perform a particular function as claimed was also well-known in the art. Appellant additionally argues that Richter does not teach the step of causing a thread to request a resource lock in response to detecting that another thread requires the resource. Finally, appellant argues that the examiner's position that his official notice is now admitted

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The examiner responds that appellant's argument relates to a matter that the examiner took "Official Notice" of, and that appellant failed to seasonably challenge this finding. According to the examiner, this "Official Notice" has now become admitted prior art. The examiner also asserts that Richter teaches this step [answer, pages 9-10].

Appellant responds that the examiner has still failed to address the argument that Richter does not teach the step of causing a thread to request the resource lock in response to detecting that another thread requires the use of the resource. Appellant also responds that the broad taking of "Official Notice" by the examiner does not establish admitted prior art as asserted by the examiner. Finally, appellant responds that the general assertion of "Official Notice" by the examiner does not constitute a proper finding of "Official Notice" in order to establish a prima facie case of obviousness [reply brief].

We do not sustain the examiner's rejection of independent claims 1 and 15 for essentially the reasons argued by appellant

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the resource and the step of causing the first thread to request the resource lock when detecting that another thread requires use of the resource. Although the examiner took "Official Notice" that the first step was, per se, well known, this notice does not establish that the first step in combination with the other steps of claims 1 and 15 would have been obvious within the meaning of 35 U.S.C. § 103. We also agree with appellant that they are not foreclosed from arguing the finding of "Official Notice" in this case while the case is still being prosecuted before the examiner.

We also agree with appellant that the second step noted above is not taught by Richter, and the examiner has never addressed this particular limitation of claims 1 and 15. We note that the key to this limitation is that the first thread always gets the resource lock back when another thread has finished with the resource. This enables the first thread to provide feedback to the user so that the user does not become concerned that the program is not operating properly. There is no suggestion of

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For all of these reasons, we do not sustain the examiner's rejection of independent claims 1 and 15, or of claims 3-10, 16-20 and 25 which depend therefrom.

With respect to independent claim 11, appellant argues that Richter does not teach the last two causing steps recited therein [brief, pages 12-13]. The examiner does not further respond to this argument in the answer.

We agree with appellant that the portion of Richter relied on by the examiner does not support the examiner's finding that Richter teaches these two causing steps of claim 11. Therefore, we do not sustain the examiner's rejection of independent claim 11 or of claims 12-14 which depend therefrom.

With respect to independent claim 21, appellant argues that Richter does not teach the step of causing the first thread to suspend after inspecting the value at the memory location if the value indicates that no other thread requires use of the resource. Appellant asserts that the sleep function of Richter noted by the examiner does not perform this step [brief, page

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We agree with appellant that the portion of Richter relied on by the examiner does not support the examiner's finding that Richter teaches the steps of claim 21. Therefore, we do not sustain the examiner's rejection of independent claim 21 or of claims 23 and 24 which depend therefrom.

In summary, we have not sustained the examiner's rejection with respect to any of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1, 3-21 and 23-25 is reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
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JERRY SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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)	
JOSEPH L. DIXON)	
Administrative Patent Judge)	

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Beyer, Weaver & Thomas, LLP
P.O. Box 778
Berkeley, CA 94704-0778