

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte RICHARD HENRY VAN GAASBECK,  
SHYAM PILLALAMARRI and SLAWOMIRO ILNICKI

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Appeal No. 2001-2369  
Application 08/728,422

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ON BRIEF

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Before JERRY SMITH, BARRY and LEVY, 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 1-6, which constitute all the claims in the application.

The disclosed invention pertains to an operating environment for use on a computer system that includes a network connecting the computer to other computers. User applications running on the computer generate operating system commands requiring access to the network and commands requiring operating system actions that do not access the network. The invention has an emulation library which forwards commands to a network server or a non-network server based on whether network services are required.

Representative claim 1 is reproduced as follows:

1. A method for operating a computer system to provide operating system services to a user application running on said computer system including a network connecting said computer system to at least one other computer system, said user application generating operating system commands requiring access to said network, commands requiring operating system actions that do not access said network, said method comprising providing an operating system including:

a network server for accessing said network;

a non-network server for executing operating system commands not requiring network services;

an emulation library, separate from said network server and said non-network server, for receiving said operating system commands generated by said user application, for decoding each of said received operating system commands to determine if that command requires network services, and forwarding a command based on that received command to said non-network server or said network server depending on whether or not that command requires network services.

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The examiner relies on the following references:

Yu	5,636,371	June 3, 1997 (filed June 7, 1995)
Loucks	5,764,984	June 9, 1998 (effectively filed Feb. 26, 1993)

Claims 1-6 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Yu in view of Loucks.

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

#### 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 appellants' arguments set forth in the brief 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

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in the art the obviousness of the invention as set forth in claims 1-6. 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 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 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.

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

The examiner has indicated how he finds the claimed invention to be obvious over the teachings of Yu and Loucks. Specifically, with respect to independent claim 1, the examiner finds that Yu teaches the claimed invention except that Yu does not explicitly disclose a non-network server or translation operations, although the examiner asserts that it would be inherent in a computer system to have one in order to perform certain basic functions. The examiner cites Loucks as teaching use of a dominant personality server and a sub-dominant

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personality server. The examiner finds that it would have been obvious to the artisan to have provided the network oriented system of Yu with the OS translation system of Loucks to provide a highly adaptable system [answer, pages 3-5].

Appellants argue that none of the components of Yu identified by the examiner teaches the claimed emulation library because each of these components handles both network and non-network commands. Appellants also argue that the Telnet Server as identified by the examiner cannot be the network since it does not receive all the commands requiring network services. Appellants argue that any inherent non-network server in Yu does not teach that the server is separate from the emulation library and performs the claimed functions. Appellants note that Loucks does not provide the missing teachings and, in fact, teaches away from using emulation libraries. Appellant also argues that Loucks separates commands by personality rather than by whether the commands require network services [brief, pages 4-9].

The examiner responds that the claimed emulation library also handles both network and non-network commands. The examiner also responds that the Telnet Server is a network server as long as it receives at least one network command. The examiner also asserts that any file server on the system could be the claimed

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non-network server. The examiner observes that although Loucks discourages the claimed invention, it would have been obvious to the artisan based on other well known advantages. The examiner responds that the personalities of Loucks includes commands requiring access to a network server and a non-network server [answer, pages 6-9].

We will not sustain the examiner's rejection of independent claim 1 or of claims 2-6 which depend therefrom because the examiner has failed to establish a prima facie case of obviousness. The examiner's rejection fails to account for several recitations in the claimed invention. First, independent claim 1 recites that there is a network server and a non-network server and that a command must be forwarded to one of these two servers based on each received command. Thus, the network server must receive every command requiring a network server and the non-network server must receive every command not requiring the network server. With respect to the network server, appellant argues that the Telnet server does not receive every command requiring a network server in Yu. The examiner has not responded to this argument. Since the examiner has not identified a non-network server in the rejection, it is impossible to determine if a single non-network server in the applied prior art receives

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every command not requiring a network server. The examiner's "finding" that a non-network server is inherent in Yu fails to account for the requirement that this server must receive every command not requiring a network server. Additionally, the claimed invention requires that the emulation library be separate from the network server and the non-network server. Since the examiner has not identified a specific non-network server in Yu, it is impossible to determine that the "inherent" non-network server is completely separate from what the examiner has identified as the emulation library of Yu. Even if the applied prior art teaches a non-network server and an emulation library, the rejection fails to establish that these components are separate as claimed.

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In summary, since the rejection fails to account for all the recitations of the claimed invention, we have not sustained the examiner's rejection of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-6 is reversed.

REVERSED

JERRY SMITH	)	
Administrative Patent Judge	)	
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	)	
LANCE LEONARD BARRY	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
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STUART S. LEVY	)	
Administrative Patent Judge	)	

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