

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VENU BANDA, FRANK R. CAMPAGNONI, MICHAEL H.
CONNER, GEORGE P. COPELAND, MARC G. SMITH and ERIN E.
SHEPLER

Appeal No. 1997-1208
Application 08/077,219

ON BRIEF

Before JERRY SMITH, RUGGIERO, and GROSS, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-20. An amendment after final rejection filed September 20, 1996, which canceled claims 3, 8, 13, and 18,

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was entered by the Examiner. Accordingly, claims 1, 2, 4-7, 9-12, 14-17, 19, and 20 remain before us on appeal.

The claimed invention relates to a method and apparatus for enabling communication between a process or task in a first address space and a process or task in a second address space. Upon determination that a target object in the second address space is required by the first process, a proxy object, which emulates the target object, is created in the first address space. Thereafter, communication between the first process and the target object is through the proxy object rather than directly between the first process and the target object. Appellants assert at page 18 of the specification that system resources are used more efficiently since the target object need not be executing or available when communication is required.

Claim 1 is illustrative of the invention and reads as follows:

1. A method for a first process in a first address space to communicate with an object in a second address space comprising the computer implemented steps of:

a) determining, during run time of the first process, that a requested communication link needed by the first

process is needed with a target object located in the second address space;

b) generating a proxy object in the first address space corresponding to the target object, said generated proxy object emulating said target object in the first address space; and

c) establishing the communication link between the first process and the target object through the proxy object.

The following references are cited in the Examiner's

Answer:¹

East et al. (East)	5,187,790	Feb. 16, 1993
Serlet et al. (Serlet) 1996	5,481,721	Jan. 02, 1991)
	(Effectively filed Jul. 17,	
Stein et al. (Stein) 1996	5,497,463	Mar. 05, 1992)
		(Filed Sep. 25, 1992)

The rejections of the appealed claims are set forth by the Examiner as follows:²

¹The Serlet and Stein references were cited by the Examiner for the first time in the prosecution at page 10 of the Answer. As indicated in the Supplemental Examiner's Answer, these references were cited "for the good of the prosecution history", but are not relied upon and form no basis for the rejections in this application.

²As indicated at page 3 of the Answer, the Examiner has withdrawn the non-statutory subject matter rejection under 35 U.S.C. § 101.

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1. Claims 1, 2, 4-7, 9-12, 14-17, 19, and 20 stand finally rejected under 35 U.S.C. § 112, first paragraph, as being based on an inadequate disclosure.

2. Claims 1, 2, 4-7, 9-12, 14-17, 19, and 20 stand finally rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the invention.

3. Claims 1, 2, 4-7, 9-12, 14-17, 19, and 20 stand finally rejected under 35 U.S.C. § 103 as unpatentable over East.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs³ and Answer for the respective details thereof.

OPINION

³ The original Appeal Brief was filed May 20, 1996 to which the Examiner responded with an Examiner's Answer dated July 15, 1996 and a Supplemental Examiner's Answer dated October 2, 1996. A corrected original Appeal Brief was filed September 13, 1999. In response to the correction and remailing of the original Examiner's Answer on September 17, 1999, a Reply Brief was filed November 22, 1999, which was acknowledged and entered by the Examiner without further comment on December 3, 1999.

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We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, the arguments in support of the rejections and the evidence of obviousness relied upon by the Examiner as support for the art rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejections and arguments in rebuttal set forth in the Examiner's Answers.

It is our view, after consideration of the record before us, that the disclosure in this application describes the claimed invention in a manner which complies with the requirements of 35 U.S.C. § 112. We are also of the view that the claims particularly point out the invention in a manner which complies with 35 U.S.C. § 112, second paragraph. In addition, it is our opinion 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

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as set forth in claims 1, 2, 4-7, 9-12, 14-17, 19, and 20.

Accordingly, we reverse.

The rejection of claims 1, 2, 4-7, 9-12, 14-17, 19, and 20 under the first paragraph of 35 U.S.C. § 112.

In order to comply with the enablement provision of 35 U.S.C. § 112, first paragraph, the disclosure must adequately describe the claimed invention so that the artisan could practice it without undue experimentation. In re Scarbrough, 500 F.2d 560, 566, 182 USPQ 298, 305 (CCPA 1974); In re Brandstadter, 484 F.2d 1395, 1404, 179 USPQ 286, 293 (CCPA 1973); and In re Gay, 309 F.2d 769, 774, 135 USPQ 311, 316 (CCPA 1962). If the Examiner has a reasonable basis for questioning the sufficiency of the disclosure, the burden shifts to Appellant to come forward with evidence to rebut this challenge. In re Doyle, 482 F.2d 1385, 1392, 179 USPQ 227, 232 (CCPA 1973), cert. denied, 416 U.S. 935 (1974); In re Brown, 477 F.2d 946, 950, 177 USPQ 691, 694

(CCPA 1973); and In re Ghiron, 442 F.2d 985, 992, 169 USPQ 723, 728 (CCPA 1971). However, the burden is initially upon the Examiner to establish a reasonable basis for questioning

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the adequacy of the disclosure. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982); In re Angstadt, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976); and In re Armbruster, 512 F.2d 676, 677, 185 USPQ 152, 153 (CCPA 1975).

The Examiner has questioned the sufficiency of Appellants' disclosure in describing the claimed operations of determining that a communication link is needed, generating a proxy object, and emulating a target object. The Examiner concludes (Answer, pages 5-7) that, since the details of these operations are not provided, it would require undue experimentation by the skilled artisan to implement each of these operations.

After careful review of the arguments of record, however, we are in agreement with Appellants' position as stated in the Briefs. As pointed out by Appellants (Brief, page 4), the specification at pages 11 and 12 provides a description of the determination of the requirement for a communication link. We further agree with Appellants that Appendix A to the specification, beginning at the bottom of page 16, describes in

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detail the generation of a proxy object which results in the emulation of a target object. In our view, the present disclosure is of sufficient detail so as to enable one of ordinary skill to implement an operative embodiment of the claimed invention.

In view of the above, we find that the Examiner has not established a reasonable basis for challenging the sufficiency of the instant disclosure. While some experimentation by artisans may be necessary in order to practice the invention, we find that such experimentation would not be undue. Accordingly, we will not sustain the rejection of claims 1, 2, 4-7, 9-12, 14-17, 19, and 20 under the first paragraph of 35 U.S.C. § 112.

The rejection of claims 1, 2, 4-7, 9-12, 14-17, 19, and 20 as being indefinite under the second paragraph of 35 U.S.C. § 112.

The general rule is that a claim must set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the disclosure as it would be by the artisan. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). Acceptability

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of the claim language depends on whether one of ordinary skill
in the art

would understand what is claimed in light of the
specification.

Seattle Box Co. v. Industrial Crating & Packing, Inc., 731
F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984).

After reviewing the arguments of record, we are in
agreement with Appellants (Brief, page 7) that no ambiguity or
lack of clarity exists in the claim language. Our review of
the language of the appealed claims reveals no uncertain or
unstated cooperative relationships among the claimed elements
as asserted by the Examiner. We further agree with Appellants
that, contrary to the Examiner's contention, no ambiguity
exists in the usage of the term "emulation", nor in the
indication that the claimed communication link is being
requested by the first process.

It is our view that the skilled artisan, having
considered the specification in its entirety, would have no

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difficulty ascertaining the scope of the invention recited in claims 1, 2, 4-7, 9-12, 14-17, 19, and 20. Therefore, the rejection of claims 1, 2, 4-7, 9-12, 14-17, 19, and 20 under the second paragraph of 35 U.S.C. § 112 is not sustained.

The rejection of claims 1, 2, 4-7, 9-12, 14-17, 19, and 20 under 35 U.S.C. § 103 as being unpatentable over East.

In rejecting claims under 35 U.S.C. § 103, it is incumbent on 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

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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 Hospital Systems, Inc. v. Montefiore Hospital, 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).

With respect to independent claims 1, 6, 11, and 16, the Examiner, as the basis for the obviousness rejection, proposes to modify the client-server system disclosure of East. In the Examiner's analysis (Answer, page 9), East differs from the claimed invention in that, instead of a local creation of a

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proxy or copy of a remote object, a thread is created in a server process which impersonates a client thread. The Examiner asserts, however, that this difference is only one of "degree" and draws the conclusion (Answer, page 4 which makes reference to pages 13 and 14 of the Office action dated January 31, 1995, paper no. 6) that:

One of ordinary skill in the DP [data processing] art would know how to implement [the] East et al impersonation feature as applicants' claimed proxy object because they only differ in degree.

After reviewing the East reference in light of the arguments and evidence of record, it is our view that the Examiner has not established a prima facie case of obviousness. We do not find the Examiner's attempt to draw parallels between the thread

impersonation feature of East and the claimed proxy-object feature to be convincing. As pointed out by Appellants (Brief, page 8), East discloses at column 31, lines 58-60:

Further, the only characteristics that are impersonated in the preferred embodiment are the identifiers held by the client.

In our opinion, this impersonation feature described by East

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falls well short of the proxy object emulation of a target object specified in the claims on appeal.

Further, notwithstanding the "degree" of difference between East and the claimed invention, we find the Examiner's conclusion that the skilled artisan could implement East's thread form impersonation in proxy-object form to thereby arrive at the claimed invention to be totally without support on the record. We are not inclined to dispense with proof by evidence when the proposition at issue is not supported by a teaching in a prior art reference, common knowledge or capable of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a prima facie case. In re Knapp-Monarch Co., 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961); In re Cofer, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966).

Since, for all of the reasons discussed supra, it is our opinion that the Examiner has not established a prima facie case of obviousness, we do not sustain the 35 U.S.C. § 103

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rejection of independent claims 1, 6, 11, and 16, nor of claims 2, 4, 5, 7, 9, 10, 12, 14, 15, 17, 19, and 20 dependent thereon.

As a final commentary, we take note of the Examiner's citation of the U.S. patents to Stein and Serlet. The Examiner's motivation for the citation of these references for the first time in the Answer is not completely clear from the record. In any case, these references form no basis for any rejection in this case and we decline to review their merits with respect to the issue of patentability of the claims on appeal. If the Examiner was of the opinion that these references had sufficient bearing on the issues on appeal, the Examiner was under a duty to properly formulate a rejection incorporating these references. The Examiner should be aware of the implications of discussing the relevance of prior art not relied upon to reject a claim. In accordance with the principles articulated in In re Portola Packaging Inc., 110 F.3d 786, 42 USPQ2d 1295, 1299 (Fed. Cir. 1997), the PTO will not order or conduct a reexamination in any application in which the relevance of prior art not relied upon

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to reject a claim was discussed on the record with respect to the patentability of any claim. [See Manual of Patenting Examining Procedure (MPEP) § 2242].

In conclusion, we have not sustained any of the Examiner's rejections of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1, 2, 4-7, 9-12, 14-17, 19, and 20 is reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
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