

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DANIEL J. CULBERT and ROBERT V. WELLAND

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Appeal No. 1998-0717  
Application 08/099,841

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ON BRIEF

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Before KRASS, JERRY SMITH and GROSS, 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 1-31, which constitute all the claims in the application. An amendment was filed concurrently with the reply brief on September 8, 1997 but was denied entry by the examiner.

The disclosed invention pertains to a method and apparatus for automatically distributing individual parts of a package to software entities that can use the individual parts. Each individual part has a part kind attribute characterizing a known inherent feature of the information in that part and a part type attribute defining the type of software entity that can use the information in that part.

Representative claim 1 is reproduced as follows:

1. A computer program product having a computer-readable medium embodying a package data structure for automatically routing computer information within a computer system, said computer information originating from an information source and being automatically dispatched to at least one of a plurality of software entities within said computer system by a package manager, the package of the computer program product comprising:

(a) one or more parts containing said computer information usable by at least one of said plurality of software entities, each part having an associated part kind attribute characterizing a known inherent feature of that portion of the computer information contained in said part and an associated part type attribute defining the type of software entity that can use that portion of the computer information contained in the part; and

(b) a package directory describing characteristics of said package and of said computer information, said characteristics including the part type attribute and the part kind attribute of each of the one or more parts, said package directory being used by said package manager to route said computer information contained in said one or more parts to at least one of said plurality of software entities.

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The examiner relies on the following references:

Skeen et al. (Skeen)	5,257,369	Oct. 26, 1993 (filed Oct. 22, 1990)
Bland et al. (Bland)	5,333,298	July 26, 1994 (filed Aug. 08, 1991)
Fisher et al. (Fisher)	5,367,686	Nov. 22, 1994 (effective filing date of Aug. 29, 1990)

Claims 1-31 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Skeen in view of Bland and further in view of Fisher.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs 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 briefs along with the examiner's

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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 1-31. 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

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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 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

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considered [see 37 CFR  
§ 1.192(a)].

With respect to each of the claims on appeal, we appreciate the effort of the examiner to indicate how he reads the various claims on the applied prior art [answer, pages 3-15]. With respect to independent claims 1, 12, 20 and 28, the examiner points out various teachings of Skeen, but the examiner

acknowledges that Skeen does not explicitly disclose routing a "part" containing a particular "part type" to a "part handler." The examiner states that Bland does provide this teaching and asserts the obviousness of applying this teaching to the Skeen system. The examiner observes that this combination does not meet the automatic recitations of the claimed invention and cites Fisher for the obviousness of this feature.

Appellants argue that each of the independent claims recite in some form the automatic routing of computer information to a software entity by a package manager based upon the part type attribute. Appellants argue that the

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applied prior art references do not teach or suggest this feature [brief, pages 4-9]. The examiner responds that appellants' definition of the terms "part kind attribute" and "part type attribute" are repugnant to the usual definitions of those terms. According to the examiner, a broad reading of the claim language is met by the collective teachings of the applied prior art [answer, pages 15-19]. Appellants respond that their definitions of the noted terms are not repugnant to the usual meaning of those terms, and appellants argue that the examiner has failed to interpret these terms consistent with the specification [reply brief].

After a careful consideration of the complete record, we agree with the position argued by appellants. Although appellants are guilty of arguing deficiencies in individual references for teachings for which they are not being relied on, the fundamental position argued by appellants is correct. In our view, appellants' description of "parts," "part kind attribute," "part type attribute," and "package" are certainly

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not repugnant to the usual meaning of these terms. They do not appear to have a "usual meaning." The appropriate question for consideration is whether the examiner's broad interpretation of these terms is reasonable and consistent with the use of these terms in the specification. A second question is whether there is any motivation to combine the teachings of Skeen, Bland and Fisher in the manner proposed by the examiner.

On the first question, we find that the various terms noted above have no usual meanings associated therewith and make sense in the claims only when interpreted in a manner consistent with their use in the disclosure. It is clear from the disclosure that the part kind attributes and the part type attributes must convey a specific type of information within a

computer system. The claims also reinforce this meaning. It appears that the examiner has interpreted these terms broad enough to read on almost any form of data. We agree with appellants that the collective teachings of the references do not suggest the automatic dispatching of package parts to

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software entities wherein each part has an associated part kind attribute and an associated part type attribute as set forth in the claimed invention.

Even if we could somehow agree with the examiner that his broad interpretation of the claim language is correct, we would not agree with his conclusion that the claimed invention is suggested by the applied prior art within the meaning of 35 U.S.C. § 103. We do not see the motivation for combining the applied references as proposed by the examiner. Instead, the rejection appears to be a selective picking and choosing from disparate prior art teachings to reconstruct appellants' invention in hindsight.

For all the reasons discussed above, we do not sustain the rejection of independent claims 1, 12, 20 and 28, or of any of the claims which depend therefrom, based on the prior art

applied by the examiner. Therefore, the decision of the examiner rejecting claims 1-31 is reversed.

REVERSED

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ERROL A. KRASS	)	
Administrative Patent Judge	)	
	)	
	)	
JERRY SMITH	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
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ANITA PELLMAN GROSS	)	
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JS/ki

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