

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MARTIN P. NALLY

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Appeal No. 2000-1284  
Application 08/576,730

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ON BRIEF

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Before JERRY SMITH, FLEMING and BARRY, 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 and 7-12, which constitute all the claims remaining in the application. In response to appellant's appeal brief, the examiner has indicated that claim 8 now contains allowable subject matter. Therefore, this appeal is directed to the rejection of claims 1-3, 7 and 9-12.

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The disclosed invention pertains to a technique for packaging an object oriented application having reduced footprints and which has been created in an object oriented development environment.

Representative claim 1 is reproduced as follows:

1. Computer readable code for determining a set of code from a development environment required to execute an object oriented application created with the development environment, comprising:

first subprocesses for identifying a known component required to execute the application;

second subprocesses for identifying methods and classes required by the known component for execution of the application;

third subprocesses for identifying other methods and classes required by the methods and classes identified in said second subprocesses and said third subprocesses for execution; and

fourth subprocesses for creating a list of methods and a list of classes from the known component and the methods and classes identified in said second and third subprocesses and ensuring that each of the methods and classes in the lists is listed only one time.

The examiner relies on the following reference:

|                  |           |                       |
|------------------|-----------|-----------------------|
| McInerney et al. | 5,758,160 | May 26, 1998          |
| (McInerney)      |           | (filed June 28, 1993) |

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Claims 1-3, 7 and 9-12 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers McInerney taken alone.

Rather than repeat the arguments of appellant 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 appellant's 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 have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-3, 7 and 9-11. We reach the opposite conclusion with respect to claim 12. Accordingly, we affirm-in-part.

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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. 1988), 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

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

The examiner's rejection is set forth on pages 3-7 of the answer. In this rejection the examiner sets forth how he interprets each of the claimed subprocesses of independent claim 1 and the means of independent claim 9. With respect to independent claims 1 and 9, which stand or fall together [brief, page 3], appellant argues that McInerney does not recite an algorithm for providing a program or application which includes

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its components only a single time. Appellant also argues that McInerney does not teach the first subprocess (means) because McInerney uses a compiler to maintain the project component, and the present invention has nothing to do with a compiler. Appellant argues that McInerney does not teach the second subprocess (means) because McInerney does not explain how his lists are created or that his lists are required by an identified known component for execution of the application. Appellant simply argues that the claimed third subprocess (means) is not taught or suggested by McInerney. Finally, appellant argues that McInerney does not teach or suggest the fourth subprocess (means) because McInerney is directed to minimizing compiling and the present invention has nothing to do with compiling or re-compiling [brief, pages 4-6].

The examiner responds that appellant's arguments regarding the compiler of McInerney are not relevant because claims 1 and 9 do not preclude the use of a compiler. The examiner indicates that the first subprocess (means) is met by the project component of McInerney. The examiner finds that the second subprocess (means) is met by the compile list of

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McInerney. The examiner finds that the third subprocess is met by the recursive procedure in McInerney for identifying additional components based on the compile list. Finally, the examiner finds that the fourth subprocess (means) is met by the interface compile list disclosed by McInerney. The examiner also explains that McInerney's teaching of avoiding the listing of unnecessary components suggests including a component only once in the created list. The examiner also notes that claim 9 is broader than claim 1 and does not include the listing of components only one time [answer, pages 7-12].

We generally agree with the position argued by the examiner for the reasons explained by the examiner in the answer. Appellant's arguments that he does not see how the relevant portions of McInerney suggest the claimed invention are not sufficient to overcome a prima facie case of obviousness. The examiner is correct that the functions performed in claims 1 and 9 do not preclude the presence of a compiler for implementing these functions. We also agree with the examiner that the subprocesses (means) of the claimed invention are met by the tree structure disclosed by McInerney with the project component at

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the base which respectively branches out to a compile list, a list generated by a recursive procedure for identifying additional components, and a final list of components to be included in the list. Although representative claim 9 does not recite the "listed only one time" feature, we agree with the examiner that McInerney does in fact suggest that the components on the list should be minimized, that is, not duplicated. Since we find that the examiner has established a prima facie case of obviousness and since we are not persuaded of error by appellant's arguments, we sustain the rejection of independent claims 1 and 9 and dependent claims 7, 10 and 11 which stand or fall with claim 1 or claim 9 [brief, page 3].

With respect to separately argued claim 2, we agree with the examiner that the project component of McInerney constitutes at least one known component as claimed. With respect to separately argued claim 3, we agree with the examiner that the project component of McInerney has an associated title which can be used to identify a desired known component. Therefore, we also sustain the examiner's rejection of claims 2 and 3.

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With respect to separately argued independent claim 12, appellant argues that the examiner has not identified how each of the steps recited therein is taught or suggested by McInerney. Specifically, appellant argues that the examiner has relied on the rejection with respect to claim 1, but claim 12 recites steps that were not considered in the rejection of claim 1 [brief, page 8].

Although the examiner has provided what he calls a mapping of the steps of claim 12 onto the disclosure of McInerney, we are unable to see how each of the steps of claim 12 is met by the portions of McInerney relied on by the examiner. The examiner has, therefore, failed to establish a prima facie case of the obviousness of claim 12. Accordingly, we do not sustain the examiner's rejection of claim 12.

In summary, the examiner's rejection of claims 1-3, 7 and 9-12 based on McInerney taken alone is sustained with respect to claims 1-3, 7 and 9-11, but is not sustained with respect to claim 12. Therefore, the decision of the examiner rejecting claims 1-3, 7 and 9-12 is affirmed-in-part.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

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| JERRY SMITH                 | ) |                 |
| Administrative Patent Judge | ) |                 |
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| MICHAEL R. FLEMING          | ) | BOARD OF PATENT |
| Administrative Patent Judge | ) | APPEALS AND     |
|                             | ) | INTERFERENCES   |
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| LANCE LEONARD BARRY         | ) |                 |
| Administrative Patent Judge | ) |                 |

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