

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte CAROL M. IULIANELLO et al.

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Appeal No. 2001-1087  
Application 08/660,616

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ON BRIEF

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Before HAIRSTON, BARRY and LEVY, Administrative Patent Judges.  
HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 2, 4 through 6, 8<sup>1</sup> through 10, 13 through 15 and 17 through 20.

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<sup>1</sup> Claim 8 improperly depends from canceled claim 7.

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The disclosed invention relates to a method for determining a cost for maintaining a software application, and to a method for determining a total cost for an enhancement to a software application portfolio.

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

1. A method for determining a cost for maintaining a software application, comprising the steps of:

receiving and storing functional metrics data of the software application in a computer readable storage medium wherein the functional metrics data includes software size in function points, number of users, and number of sites;

determining a composite index of the software application from the functional metrics data;

receiving and storing maintenance information for the software application in the computer readable storage medium;

determining a maintainability index of the software application from the maintenance information, the maintainability index providing an indication of the availability and quality of documentation for the software application;

receiving and storing an average cost per full-time equivalent in the computer readable storage medium;

determining a maintenance unit cost of the software application from the composite index, the maintainability index, and the average cost per full-time equivalent;

determining a total maintenance cost of the software application from the maintenance unit cost and the size in

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function points of the software application, the total maintenance cost providing an indication of the level of maintenance effort required to maintain the software application; and

performing maintenance on the software application in response to the total maintenance cost not exceeding a desired threshold.

The references relied on by the examiner are:

White et al. (White)                      5,446,895                      Aug. 29, 1995

Abdel-Hamid, "Adapting, Correcting, and Perfecting Software Estimates: A Maintenance Metaphor," IEEE Computer, Mar. 1993, pages 20 through 29.

Claims 1, 2, 4 through 6, 8 through 10, 13 through 15 and 17 through 20 stand rejected under the first paragraph of 35 U.S.C. § 112 for lack of written description.

Claims 1, 2, 9, 10, 13 and 15 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Abdel-Hamid.

Claims 4 through 6, 8 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Abdel-Hamid.

Claims 17 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Abdel-Hamid in view of White.

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Reference is made to the substitute brief (paper number 19), the reply brief (paper number 21) and the answer (paper number 20) for the respective positions of the appellants and the examiner.

#### OPINION

We have carefully considered the entire record before us, and we will sustain the lack of written description rejection, and reverse all of the prior art rejections of record.

Turning first to the lack of written description rejection, the examiner states (answer, page 4) that the originally filed disclosure lacks written description support for the steps of "performing maintenance on the software application in response to the total maintenance cost not exceeding a desired threshold" (claim 1), "performing enhancements on the software application in response to the total enhancement cost not exceeding a desired threshold" (claim 9), "developing a replacement software application in response to the total enhancement cost exceeding a desired threshold" (claim 19), and "developing a replacement software application in response to the total maintenance cost exceeding a desired threshold" (claim 20).

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Appellants argue (substitute brief, page 7) that they "acquiesce in the rejection of Claims 19 and 20." In view of appellants' acquiescence, the rejection of claims 19 and 20 under the first paragraph of 35 U.S.C. § 112 is sustained pro forma.

In response to the lack of written description rejection of claims 1 and 9, appellants argue (substitute brief, page 7) that:

The specification makes clear that a project may be approved and that certain actions occur after a project has been approved. (p. 15, l. 22). Work requests typically come from customers. (p. 17, l. 21-30). Those providing services in response to a request typically bid to provide the services. (p. 3, l. 28-p. 4, l. 6). One of ordinary skill reading the application would understand that Applicants disclose that enhancements and maintenance will not be performed if the bid on the project is not approved and that the focus of that decision is the total enhancement cost or total maintenance cost. Providing cost estimates is the focus of the invention. One of ordinary skill understands that such estimates are necessarily used to make decisions as to whether to approve or reject bids by service providers. Thus, the added elements to Claims 1 and 9 are either explicitly or inherently disclosed.

We agree with the appellants that action will be taken after the total maintenance and the total enhancement costs are

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determined. We do not, however, agree with the appellants that it is "explicitly or inherently disclosed" in the originally filed disclosure that the claimed actions will be taken after the noted total costs are determined. We agree with the examiner that the originally filed disclosure lacks support for such specific actions made in response to the total cost determinations. Appellants cannot rely on the knowledge of the skilled artisan to supply the written description support for the noted claimed subject matter because the mere fact "[t]hat a person skilled in the art might realize from reading the disclosure that such a step is *possible* is not a sufficient indication to that person that that step is part of appellants' invention." In re Barker, 559 F.2d 588, 593, 194 USPQ 470, 474 (CCPA 1977), cert. denied, 434 U.S. 1064 (1978). Accordingly, the lack of written description rejection of claims 1 and 9 is sustained. The lack of written description rejection of claims 2, 4 through 6, 8, 10, 13 through 15, 17 and 18 is likewise sustained because of the dependency of these claims from the base claims 1 and 9.

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Turning to the anticipation rejection of claims 1, 2, 9, 10, 13 and 15, appellants argue (substitute brief, pages 9 and 10) that the functional metrics data, the composite index and maintenance information set forth in the method steps in the claims on appeal are not disclosed by Abdel-Hamid. We agree. The Abdel-Hamid publication is concerned with software estimation, software cost and makes use of constructive cost modeling (Cocomo). The publication additionally discusses full-time equivalents or person-months (page 23, column 1). However, no other teachings relevant to the claims on appeal are found in the Abdel-Hamid publication. Thus, the anticipation rejection of claims 1, 2, 9, 10, 13 and 15 is reversed for lack of a prima facie case.

The obviousness rejection of claims 4 through 6, 8 and 14 based upon the teachings of the Abdel-Hamid publication is reversed for all of the reasons set forth supra in the anticipation rejection.

The obviousness rejection of claims 17 and 18 is reversed because the teachings of White fail to cure the noted shortcomings in the teachings of the Abdel-Hamid publication.

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DECISION

The decision of the examiner rejecting all of the claims on appeal under the first paragraph of 35 U.S.C. § 112 is affirmed, and the decision of the examiner rejecting claims 1, 2, 4 through 6, 8 through 10, 13 through 15, 17 and 18 based upon prior art is reversed. Accordingly, the decision of the examiner is affirmed.

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

AFFIRMED

KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
LANCE LEONARD BARRY	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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STUART S. LEVY	)	
Administrative Patent Judge	)	

KWH:psb

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