The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 41

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWIN J. LAU, RANDALL G. MENNA,
PRASHANT NAVARE, TUNG NGUYEN
and JAMES SALOIS

Appeal No. 2002-0807
Application No. 08/672,588

Heard: MARCH 11, 2003

Before RUGGIERO, DIXON and BLANKENSHIP, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 2-7, 9-18, 22-24, and 26-32, which are all of the claims pending in the present application. Claims 1, 8, 19-21, and 25 have been canceled.

The claimed invention relates to a client-server environment in which application program instructions, in response to a partitioning program, are monitored and intercepted for partitioning into a plurality of sets of instructions. The media related portion of the partitioned instructions is executed by the client processor while the non-media related portion is executed by the server computer. According to Appellants (specification, page 2), the remote client-user interacts locally with the application which is running media-related instructions, thereby appearing to the client-user that the application is being executed completely by the remote client.

Representative claim 27 is reproduced as follows:

27. In a distributed computing system comprising a first processor connectable to a second processor, wherein an application executable by the first processor is provided, a method comprising the step of:

partitioning the application into a plurality of portions, including a media portion for execution by the second processor, such that when the second processor executes the media portion, the application is effectively executed by the second processor;

wherein the application comprises a plurality of instructions, at least one of such instructions being monitored for interception, executable by the first processor, at least one monitored instruction having a state which is communicated to the second processor, the execution of the application being partitioned effectively as the second processor executes a pre-defined generic program which comprises a plurality of

instructions to be executed as a result of the communicated state corresponding to the media portion of the application running on the first processor.

The Examiner relies on the following prior art:

Crawford et al. (Crawford)	5,261,095	Nov. 09, 1993
Fin et al. (Fin)	5,537,548	Jul. 16, 1996 (filed Jun 14, 1994)
Laursen et al. (Laursen)	WO 96/17306 (Published International Patent Application)	Jun. 06, 1996

Claims 2-7, 9-18, 22-24, and 26-32, all of the appealed claims, stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Crawford in view of Laursen and Fin.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs[1] and Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner, the arguments in support of the rejection, 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,

[1] The Appeal Brief was filed July 31, 2001 (Paper No. 32). In response to the Examiner's Answer dated January 2, 2002 (Paper No. 33), a Reply Brief was filed March 4, 2002 (Paper No. 34), which was acknowledged and entered by the Examiner as indicated in the communication dated March 22, 2002 (Paper No. 35).

Appellants' arguments set forth in the Briefs 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 2-7, 9-18, 22-24, and 26-32. Accordingly, we affirm.

Appellants' arguments in response to the Examiner's obviousness rejection of the appealed claims are organized according to a suggested grouping of claims indicated at pages 3 and 4 of the Brief. Consistent with this indication, Appellants have presented arguments directed to independent claim 27, which we will consider as the representative claim for all the claims on appeal with the exception of separately argued claim 12 and its dependent claims 13-15. Accordingly, claims 2-7, 9-11, 16-18, 22-24, 26, and 28-32 will stand or fall with claim 27, and claims 13-15 will stand or fall with claim 12. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

After reviewing the Examiner’s analysis (Answer, pages 4-6), it is our view that such analysis carefully points out the teachings of the Crawford, Laursen, and Fin references, reasonably indicates the perceived differences between this prior art and the claimed invention, and provides reasons as to how and why the prior art teachings would have been modified and/or combined to arrive at the claimed invention. In our opinion, the Examiner's analysis is sufficiently reasonable that we find that the Examiner has at least satisfied the burden of presenting a prima facie case of obviousness. The burden is, therefore, upon Appellants to come forward with evidence and/or arguments which persuasively rebut the Examiner’s prima facie case of obviousness. 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 [see 37 CFR § 1.192(a)].

With respect to representative claim 27, Appellants’ arguments in response to the obviousness rejection assert that the Examiner has failed to establish a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the applied prior art references. As summarized at page 7 of the Brief, Appellants contend that “[t]there is no

disclosure in any of the cited references of monitoring for interception the program designed to be run completely on the first processor, and no disclosure of the claimed pre-defined generic program running on the second processor....”

After careful review of the applied prior art references in light of the arguments of record, however, we are in agreement with the Examiner’s position as stated in the Answer. In our view, Appellants’ arguments unpersuasively focus on the individual deficiencies of the cited references. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. Each reference must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole. In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981); In re Merck & Co., Inc., 800 F.2d 1091, 1096, 231 USPQ 375, 380 (Fed. Cir. 1986). In this regard, as pointed out by the Examiner (Answer, page 17), it is the Fin reference, not Crawford, that is relied on as teaching the claimed “interception” feature. Further, although Appellants assert (Brief, page 7) the lack of any teaching in the prior art of an interception feature applied to a program “designed to run completely on the first processor”, there is no such requirement in the language of claim 27.

We also find to be unpersuasive Appellants' arguments that none of the applied prior art references disclose a "pre-defined generic program" running on the second processor. In reviewing the language of claim 27, we note that it is a basic tenet of patent law that claims are to be given their broadest reasonable interpretation consistent with the description in the specification. With this in mind, we have reviewed Appellants' specification for guidance as to the proper interpretation of the claim language, and we find little enlightenment as to how to properly interpret the "pre-defined generic program" language of claim 27. Further adding to this difficulty is the fact that Appellants' arguments in the Briefs do not refer to any specific portion of their specification in support of their arguments which attempt to distinguish the claim language from the applied prior art. Accordingly, in interpreting the language of claim 27, we will give the terminology "pre-defined generic program" its ordinary and accepted meaning and, in doing so, find ourselves in agreement with the Examiner's analysis articulated at page 4 of the Answer.

As asserted by the Examiner, the operating system software of the second processor, which controls the execution of the subprogram code (Crawford, Appendix C), would meet the ordinary

and accepted meaning of the language “pre-defined generic program.” Further, contrary to Appellants’ contention (Reply Brief, page 7), Crawford describes the second processor executing a plurality of instructions “...as a result of the communicated state corresponding to the media portion of the application running on the first processor” as claimed. (Crawford, column 6, line 61 through column 7, line 3; Appendix C).

Further, we find to be unpersuasive Appellants’ arguments (Reply Brief, pages 4-6) which attack the Examiner’s establishment of proper motivation for the proposed combination of references. Appellants initially contend (id., at 5) that there is “... little evident benefit to Crawford in using the network management scheme put forth by Laursen.” Appellants further assert (id., at 6) that the implementation of the application instruction interception of Fin in the system of Crawford would be extremely difficult. In a related argument, Appellants contend that, since the redirected code in Crawford is not executed directly, there would be no benefit to add the redirection scheme of Fin.

It is apparent to us, however, from the line of reasoning expressed in the Answer that the Examiner is not suggesting the bodily incorporation of Laursen’s network management system and

Fin's application instruction interception scheme into the system of Crawford. Rather, it is the disclosed techniques in Laursen of providing an illusion of effective execution of a program at a client processor and the provision of an API instruction interception routine in Fin that are being relied upon as a suggestion for the proposed combination. "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference....Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). See also In re Sneed, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir. 1983) and In re Nievelt, 482 F.2d 965, 967, 179 USPQ 224, 226 (CCPA 1973).

For the above reasons, since it is our opinion that the Examiner's prima facie case of obviousness has not been overcome by any convincing arguments from Appellants, the Examiner's 35 U.S.C. § 103(a) rejection of representative independent claim 27, as well as claims 2-7, 9-11, 16-18, 22-24, 26, and 28-32 which fall with claim 27, is sustained.

Turning to a consideration of the Examiner's 35 U.S.C. § 103(a) rejection of separately argued dependent claim 12, the

representative claim for Appellants' suggested grouping including claim 12 and its dependent claims 13-15, we sustain the obviousness rejection of this claim as well. We agree with the Examiner (Answer, page 19) that the limitations of claim 12, which extend the features in previously discussed claim 27 to "another processor coupled to the server processor," are met by the disclosure of Laursen's distributed client-server computing environment. Although Appellants reiterate their arguments that the applied prior art does not suggest the claimed pre-defined generic program nor the illusion of the apparent execution of a server program at the client processor, we find such arguments unpersuasive for all of the reason discussed supra.

In summary, we have sustained the Examiner's 35 U.S.C. § 103(a) rejection of all of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 2-7, 9-18, 22-24, and 26-32 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

JOSEPH F. RUGGIERO Administrative Patent Judge	)
JOSEPH L. DIXON Administrative Patent Judge	)BOARD OF PATENT) APPEALS AND)INTERFERENCES
HOWARD B. BLANKENSHIP Administrative Patent Judge	)

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