

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AMANDA ELIZABETH CHESSELL,
MARTIN MULHOLLAND, and KATHRYN SARAH WARR

Appeal No. 2002-2322
Application 09/094,314

ON BRIEF

Before JERRY SMITH, RUGGIERO, 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 1-21, which constitute all the claims in the application.

The disclosed invention pertains to the field of transaction processing. More particularly, the invention seeks to avoid the creation of a transaction coordinator until such

transaction coordinator is absolutely necessary during the processing of the transaction. The invention identifies two events which require the transaction coordinator, and the coordinator is created only when one of these events has occurred.

Representative claim 1 is reproduced as follows:

1. A server processing apparatus for use in a client/server computing system which carries out transactions, said apparatus comprising:

means for receiving a command instructing the server processing apparatus to carry out a step of a transaction;

means for beginning the transaction; and

means for determining whether a predetermined triggering event has occurred during the carrying out of the transaction, and only if the triggering event has occurred, creating a means for coordinating the transaction with respect to a plurality of elements that are involved in carrying out the transaction.

The examiner relies on the following references:

Hapner et al. (Hapner)	5,940,827	Aug. 17, 1999 (filed Nov. 10, 1997)
Sadiq et al. (Sadiq)	6,029,177	Feb. 22, 2000 (filed Jan. 30, 1998)

Claims 1-21 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Hapner taken alone with respect to claims 1-13 and Hapner in view of Sadiq with respect to claims 14-21.

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Rather than repeat the arguments of appellants 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 rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejections 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 1-21. 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

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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.), 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,

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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 considered and are deemed to be waived [see 37 CFR § 1.192(a)].

We consider first the rejection of claims 1-13 based on the teachings of Hapner taken alone. The examiner has indicated how he finds the invention of these claims to be unpatentable over the teachings of Hapner [answer, pages 7-10]. Appellants have indicated that independent claims 1, 7 and 13 stand or fall together as a single group [brief, page 3]. With respect to representative claim 1, appellants argue that Hapner fails to teach the creation of a means for coordinating the transaction only if the predetermined triggering event has occurred as claimed. Appellants argue that the various passages of Hapner relied on by the examiner all fail to provide a teaching of this limitation. They assert that no triggering event is taught in Hapner nor a means for responding to a triggering event [brief, pages 3-5]. The examiner responds that he interprets creating a means as simply calling an agent, object, subprogram, macro or program at the desired time and place. Thus, the examiner finds

that calling a program and reading any necessary variables into the program "creates" a new program. The examiner also finds that checking the semaphore bit in Hapner reads on determining whether a predetermined triggering event has occurred [answer, pages 10-13].

We will not sustain the examiner's rejection of claim 1. Claim 1 recites a means for creating a means for coordinating the transaction with respect to a plurality of elements that are involved in carrying out the transaction only if the triggering event has occurred. Thus, the claim requires that the means for coordinating the transaction does not exist, and it only gets created when the predetermined triggering events occur. We do not agree with the examiner's fundamental assertion that the memory management coordination in Hapner constitutes the creation of a means for coordinating the transaction because it creates a new program. The memory management coordinator of Hapner does not become a new creation with each new request for access to the memory. The memory management coordinator of Hapner is always present. We agree with appellants that a coordinating means is not created in Hapner only in response to predetermined triggering events. We find that the examiner's attempt to read

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the claimed means for creating on the operation of Hapner to be unreasonable.

Since we have not sustained the examiner's rejection of independent claim 1, we also do not sustain the rejection with respect to independent claims 7 and 13 which contain recitations similar to those of claim 1. We also do not sustain the rejection with respect to claims 2-6 and 8-12 which depend from claims 1 and 7.

We now consider the rejection of claims 14-21 based on the teachings of Hapner and Sadiq. These claims all depend from claims 1, 7 or 13. Since Sadiq does not overcome the basic deficiencies of Hapner discussed above, we also do not sustain the rejection of any of claims 14-21.

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In summary, we have not sustained either of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-21 is reversed.

REVERSED

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JERRY SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	APPEALS AND
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LANCE LEONARD BARRY)	
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JS:dym

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