

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 42

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

**Ex parte** FRANKLIN C. BRESLAU, PAUL G. GREENSTEIN  
and JOHN T. RODELL

---

Appeal No. 2003-0994  
Application No. 08/579,544

---

ON BRIEF

---

Before JERRY SMITH, FLEMING, and MACDONALD, **Administrative Patent Judges**.

MACDONALD, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the final rejection of claims 16-22 and 38-63. Claims 1-15 and 23-37 have been canceled.

**Invention**

Appellants' invention relates to object-oriented computer systems. More specifically, to managing instances of objects by migrating an object between a merged status having a single instance and a split status having multiple instances. An object invoker invokes the object in the same way regardless of its

Appeal No. 2003-0994  
Application No. 08/579,544

merged or split status. An object request broker with a routing table decides which of the multiple instances of the object should be invoked. A heuristic is used to make the decision. Appellants' specification at page 1, lines 22-28; page 4, lines 16-18; and page 20, lines 12-21.

Claim 16 is representative of the claimed invention and is reproduced as follows:

16. In a computer system including an object and at least one invoker, wherein said object is invocable by said at least one invoker, a method of managing said object at run-time, said method comprising:

(a) providing multiple, functionally equivalent, instantiated instances of said object, each instance of said multiple instances of said object drawn from common class source code and being a candidate for invocation upon an invocation of said object;

(b) receiving, from an invoker that is unaware that there are multiple instances of said object, said invocation of said object, said invocation identifying said object and being indescriptive of said multiple instances of said object, wherein said invocation does not specify a particular one of said multiple instances of said object to be invoked; and

(c) invoking, transparent to said invoker, any one instance of said multiple instances of said object in response to said invocation of said object.

#### **References**

The references relied on by the Examiner are as follows:

Travis, Jr. et al. (Travis)	5,280,610	Jan. 18, 1994
Georgiadis et al. (Georgiadis)	5,283,897	Feb. 1, 1994



Appeal No. 2003-0994  
Application No. 08/579,544

Claim 63 stands rejected under 35 U.S.C. § 103 as being obvious over the combination of Travis and Huang and Corradi.

Throughout our opinion, we make references to the Appellants' briefs, and to the Examiner's Answer for the respective details thereof.<sup>1</sup>

#### **OPINION**

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated *infra*, we reverse the Examiner's rejection of claims 16-22 and 38-63 under 35 U.S.C. § 103.

#### **I. Whether the Rejection of Claims 16-19, 38-41, 45-55, and 59-63 Under 35 U.S.C. § 103 is proper?**

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 16-19, 38-41, 45-55, and 59-63. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a *prima facie* case of

---

<sup>1</sup>Appellants filed an appeal brief on January 23, 2002. Appellants filed a reply brief on August 28, 2002. The Examiner mailed out an Examiner's Answer on June 20, 2002.

Appeal No. 2003-0994  
Application No. 08/579,544

obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to independent claim 16, which is representative of claims 17-19, 38-41, 45-55, and 59-63,

Appeal No. 2003-0994  
Application No. 08/579,544

Appellants argue at page 14 of the brief, that the references fail to teach, "invoking, transparent to said invoker, any one instance of said multiple instances." (Emphasis added). We agree. The references fail to teach or suggest this limitation.

Our reviewing court states in *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) that "claims must be interpreted as broadly as their terms reasonably allow." Our reviewing court further states, "[t]he terms used in the claims bear a 'heavy presumption' that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art." *Texas Digital Sys. Inc v. Telegenix Inc.*, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1817 (Fed. Cir. 2002), *cert. denied*, 538 U.S. 1058 (2003).

Upon our review of Appellants' specification, we fail to find any definition of the term "transparent" that is different from the ordinary meaning. We find the ordinary meaning of the term "transparent" is best found in the dictionary. We note that the definition most suitable for "transparent" is "not visible, hidden."<sup>2</sup>

We appreciate the Examiner's position that "transparent" is met by Travis' method of invoking as discussed in the answer at

---

<sup>2</sup> *Dictionary.com. Copy provided to Appellant.*

page 4, lines 15-20. However we find that the claim language precludes reading on an invoker that "considers all instances." In such a situation, the invoking of a given instance is not hidden from the invoker as required by the claim limitation.

Therefore, the Examiner has failed to meet the initial burden of establishing a *prima facie* case of obviousness, and we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

We note that we found none of Appellants' other arguments on pages 4-13 of the brief to be persuasive. For example, the argument at page 5, lines 9-11, is not commensurate in scope with Appellants' claims. The field of endeavor referred to in these lines of "migrating an object between a merged status . . . and a split status . . ." is the field of endeavor of Appellants' related patent 6,421,736. The field of endeavor of the instant application is the broader "management of invoking of an instance." The claims of the instant application are silent as to status migration.

**II. Whether the Rejection of Claims 20, 42, and 56 Under 35 U.S.C. § 103 is proper?**

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

Appeal No. 2003-0994  
Application No. 08/579,544

in the art the obviousness of the invention as set forth in claims 20, 42, and 56. Accordingly, we reverse.

With respect to claim 20, we note that the Examiner has relied on the Georgiadis reference solely to teach, "operating as a function of communications performance" [answer, page 7]. The Georgiadis reference in combination with the Travis and Huang fails to cure the deficiencies of Travis and Huang noted above with respect to claim 16. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103(a) for the same reasons as set forth above.

**III. Whether the Rejection of Claims 21, 43, and 57 Under 35 U.S.C. § 103 is proper?**

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 21, 43, and 57. Accordingly, we reverse.

With respect to claim 21, we note that the Examiner has relied on the Silberschatz reference solely to teach, "resource allocation" [answer, page 7]. The Silberschatz reference in combination with the Travis and Huang fails to cure the deficiencies of Travis and Huang noted above with respect to claim 16. Therefore, we will not sustain the Examiner's

Appeal No. 2003-0994  
Application No. 08/579,544

rejection under 35 U.S.C. § 103(a) for the same reasons as set forth above.

**IV. Whether the Rejection of Claims 22, 44, and 58 Under 35 U.S.C. § 103 is proper?**

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 22, 44, and 58. Accordingly, we reverse.

With respect to claim 22, we note that the Examiner has relied on the Baradel reference solely to teach, "an object management system" [answer, page 8]. The Baradel reference in combination with the Travis and Huang fails to cure the deficiencies of Travis and Huang noted above with respect to claim 16. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103(a) for the same reasons as set forth above.

**V. Whether the Rejection of Claim 62 Under 35 U.S.C. § 103 is proper?**

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 claim 62. Accordingly, we reverse.

With respect to claim 62, we note that the Examiner has relied on the Berbers reference solely to teach, "object management including deleting" [answer, page 8]. The Berbers reference in combination with the Travis and Huang fails to cure the deficiencies of Travis and Huang noted above with respect to claim 16. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103(a) for the same reasons as set forth above.

**VI. Whether the Rejection of Claim 63 Under 35 U.S.C. § 103 is proper?**

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 claim 63. Accordingly, we reverse.

With respect to claim 63, we note that the Examiner has relied on the Corradi reference solely to teach, "instantiating split

Appeal No. 2003-0994  
Application No. 08/579,544

instances of an object" [answer, page 9]. The Corradi reference in combination with the Travis and Huang fails to cure the deficiencies of Travis and Huang noted above with respect to claim 16. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103(a) for the same reasons as set forth above.

***Conclusion***

In view of the foregoing discussion, we have not sustained the rejection under 35 U.S.C. § 103 of claims 16-22 and 38-63.

***REVERSED***

JERRY SMITH	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
MICHAEL R. FLEMING	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
ALLEN R. MACDONALD	)	
Administrative Patent Judge	)	

Appeal No. 2003-0994  
Application No. 08/579,544

ARM/lbg

Appeal No. 2003-0994  
Application No. 08/579,544

BLANCHE E. SCHILLER  
HESLIN & ROTHENBERG  
5 COLUMBIA CIRCLE  
ALBANY, NY 12203-5160