

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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY WILLIAM JOSTEN,
CHANDRASEKARAN MOHAN, and
INDERPAL SINGH NARANG

Appeal No. 2003-1036
Application No. 09/330,865

ON BRIEF

Before FLEMING, DIXON, and LEVY, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3-14, 16-27, 29-41, and 43-77.¹ Claims 2, 15, and 28 have been canceled and claims 7, 13, 20, 26, 33, 39, 45, 56, 63, 70, and 77 have been indicated in the answer to be objected to as containing allowable subject matter if rewritten in independent form.

We REVERSE.

¹ We note that the examiner has withdrawn the rejections under 35 U.S.C. §§ 101 and 112, first and second paragraphs, and withdrawn some of the rejections under 35 U.S.C. § 103.

Appellants' invention relates to assigning recoverable unique sequence numbers in a transaction processing system. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A computer-implemented system for assigning sequence numbers, comprising:

(a) a computer system; and

(b) sequence number assignment logic, performed by the computer system, for generating a recoverable, unique sequence number for assignment to an application when requested by the application, wherein subsequent ones of the sequence number can be assigned to applications concurrently without waiting for other applications which have been previously assigned the sequence number, and for periodically checkpointing the sequence number to a data storage device connected to the computer, wherein the checkpointed sequence number is used to initialize the sequence number assignment logic.

The prior art of record relied upon by the examiner in rejecting the appealed claims is as follows:

Myre, Jr. et al. (Myre)	5,043,866	Aug. 27, 1991
Mohan et al. (Mohan)	5,327,556	Jul. 05, 1994
Zbikowski et al. (Zbikowski)	5,590,318	Dec. 31, 1996

Claims 1, 3-6, 8-11, 14, 16-19, 21-24, 27, 29-32, 34-37, 40-41, 43, 44, 46, 47, and 50-55, 57-62, 64-69 and 71-76 stand rejected under 35 U.S.C. § 103 as being unpatentable over Myre in view of Zbikowski. Claims 12, 25, 38, 39, and 48, stand rejected under 35 U.S.C. § 103 as being unpatentable over Myre in view of Zbikowski further in view of Mohan.

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Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 15, mailed Dec. 11, 2002) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 14, filed Oct. 29, 2002) and reply brief (Paper No. 16, filed Feb. 19, 2003) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. **See In re Rijckaert**, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See In re Lintner**, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the

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references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See **In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. American Maize-Prods. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in art would lead that individual to combine the relevant teachings of the references.'" **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing **In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material

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fact." **Dembiczak**, 175 F.3d at 999, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) .

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations set forth in independent claim 1.

Appellants argue that the examiner admits that Myre does not teach the "sequence number assignment logic, performed by the computer system, for generating a recoverable, unique sequence number for assignment to an application when requested by the application, wherein subsequent ones of the sequence number can be assigned to applications concurrently without waiting for other applications which have been previously assigned the sequence number, and for periodically checkpointing the sequence number to a data storage device connected to the computer, wherein the checkpointed sequence number is used to initialize the sequence number assignment logic" and that Zbikowski does not remedy this deficiency in Myre. Appellant argues that Zbikowski merely describes the steps used in recovering a list of files stored in a change table as well as tracking files awaiting background processing. Appellants maintain that Zbikowski teaches nothing about concurrent assignment of sequence numbers. (Brief at pages 9-10.) We agree with appellants that Zbikowski and Myre teach the use of sequence numbers, but do not teach or fairly suggest the concurrent assignment of sequence numbers as recited in independent claim 1.

The examiner maintains that it would have been obvious to one of ordinary skill in the art at the time of the invention to include the concurrent checkpointing of Zbikowski into the checkpointing process of Myre. (Answer at pages 4-5.) From our review of the cited portions of Zbikowski, we find no teaching or suggestion of the logic to carry out concurrent assignment of sequence numbers as recited in independent claim 1. Therefore, we find that the examiner has not established a *prima facie* case of obviousness of the claimed invention, and we will not sustain the rejection of independent claim 1 and claims dependent therefrom.

Additionally, we find similar limitations in independent claims 14, 27, 40, 50, 57, 64, and 71 and find that the examiner has also not established a *prima facie* case of obviousness of the claimed invention. Therefore, we will not sustain the rejection of these claims and their dependent claims.

With respect to dependent claims 12, 25, 38, 39, and 48 the examiner has added the teachings of Mohan, but has not relied upon the teachings of Mohan to remedy to basic deficiency in the base combination. Therefore, we will not sustain the rejection of claims 12, 25, 38, 39, and 48.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 3-6, 8-12, 14, 16-19, 21-25, 27, 29-32, 34-41, 43, 44, 46- 48, and 50-55, 57-62, 64-69 and 71-76 under 35 U.S.C. § 103 is reversed.

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REVERSED

MICHAEL R. FLEMING)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH L. DIXON)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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STUART S. LEVY)	
Administrative Patent Judge)	

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