

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte BRANISLAV KISACANIN

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Appeal No. 2004-1827  
Application No. 09/467,396

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ON BRIEF

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Before RUGGIERO, LEVY, and BLANKENSHIP, Administrative Patent Judges.

LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-20<sup>1</sup>, which are all of the claims pending in this application.

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<sup>1</sup> The rejection of claims 1, 5, 10, 14 and 19 under 35 U.S.C. § 112, first and second paragraphs, has been withdrawn by the examiner (answer, pages 3 and 4).



of the rejection, and to appellant's brief (Paper No. 13, filed December 11, 2003) and reply brief (Paper No. 15, filed May 7, 2004) for appellant's arguments thereagainst. Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the briefs have not been considered.

#### OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejection advanced by the examiner, 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, appellant's 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.

Upon consideration of the record before us, we reverse. We observe at the outset appellant's assertion (brief, page 4) that claims 1-20 stand or fall together. Accordingly, we select claim 1 as representative of the group.

Turning to claim 1, we note as background that 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 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. 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. 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, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

The examiner's position (final rejection, page 2) is that "Kohl teaches customers can create and customize their programs, compile them and create customer compatible executable software." To teach the limitation of pre-existing source code, the examiner asserts (final rejection, page 3) that "[s]ource code must exist (i.e., must pre-exist) before it can be compiled." The examiner further asserts (final rejection, page 12) that Kohl teaches customer specific messages "because it would have been obvious . . . to extend Kohl and disclose that source code may include customer specific messages provided by the customer in a customer specification."

Appellant's position (brief, page 12) is that Kohl is not directed to a system that provides "a customer compatible executable that is compiled from pre-existing source code that includes inserted customer specific message provided by the customer in a customer specification," but rather (id.) that "Kohl discloses a web application that is customizable by a user using, for example, a simple point and click interface."

Appellants assert (id.) that Kohl "does not teach or suggest electronically providing a customer compatible executable that is compiled from pre-existing source code that includes inserted customer specific message provided by a customer in a customer specification."

The examiner responds (answer, page 8) by acknowledging that Kohl "**does not** use the word 'source code' [, or] 'message'," but reiterates his position that it would have been obvious to one of ordinary skill in the art to extend Kohl to disclose that source code may includes "customer specific messages provided by a customer in a customer specification."

In reply, appellant asserts (reply brief, page 3) that the examiner has cited no prior art reference to support his assertion that the appellants system would have been obvious in view of Kohl, when combined with the knowledge generally available to one of ordinary skill in the art.

From our review of Kohl, we find that Kohl teaches a system "that allows end users to create applications on the Web" (col. 4, lines 54-55). The system contains an application development environment on the web, along with "an interpretive server and proprietary databases" (col. 4, lines 56-58). The "proprietary databases are used to store information pertaining to

applications, while the interpretative server interprets the information from the proprietary databases and generates applications" (col. 4 lines 58-62). The "[i]nterpretive server . . . interacts with ADBs to generate application logic on the fly according to the application definition data it gets from the ADBs" (col. 5, lines 49-53). In Kohl, "[u]ser interaction with the interpretative server occurs via HTML pages displayed by a Web browser" (col. 6, lines 4-6). These pages may contain "HTML, JavaScript, Java and/or any scripting or embedded language" (col. 6, lines 13-14). Kohl teaches that "Java programs that work on Web pages are called 'applets.' A Java applet is a program designed to be included in an HTML document and run inside a Web browser" (col. 6, lines 7-10). Kohl also teaches that "the same environment may be used to design, generate and store non-Web applications such as client-server applications" (col. 5, lines 3-5).

From the teachings of Kohl, we agree with the examiner that Kohl discloses a method for electronically providing customized software. This method of Kohl receives a customer specification through the web, and automatically creates customer compatible software that meets the customer specification, and electronically provides the customer compatible software to the

customer. We also agree with the examiner that Kohl discloses the software to be a customer compatible executable, because Kohl teaches that the HTML pages of application may contain Java applets, and because Kohl teaches that it can deliver a client-server application instead of a web application. We additionally agree with the examiner that Kohl teaches that these executables are compiled from pre-existing source code, because the source code for these executables must exist before they can be compiled. It is at this point, however, that we part company with the examiner. Although we agree that Kohl would inherently include pre-existing source code, we find no suggestion of modifying the source code to include customer specific messages from a customer specification. In addition, with respect to the examiner's arguments (final rejection, page 12) that selection of a display language would permit customers to insert messages, we note that the selection of one language or another is merely the selection of a source to be compiled and not the insertion of "customer specific messages" into the source code. Accordingly, we agree with appellant (brief, page 12) that "Kohl does not teach or suggest electronically providing a customer compatible executable that is compiled from pre-existing source code that includes inserted customer specific messages provided by a

customer in a customer specification." We find the examiner's assertion (answer, pages 9 and 10) of what would have been obvious to one of ordinary skill in the art to be unsupported by evidence in the record.

From all of the above, we find that the examiner has failed to establish a case of prima facie obviousness of claim 1. Accordingly, the rejection of claim 1 under 35 U.S.C. § 103(a) is reversed. As claims 2-9 are dependent on claim 1, the rejections of claims 2-9 are reversed. Because independent claims 10 and 19 also recite "pre-existing source code that includes inserted customer specific messages provided by the customer in the customer specification," the rejection of claims 10 and 19, and claims 11-18 and 20, dependent therefrom, is reversed.

#### NEW GROUND OF REJECTION

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b).

Claims 1-4, 6-13, and 15-20 are rejected under 35 U.S.C. § 112, second paragraph, as being misdescriptive, and therefore vague and indefinite. Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they

define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

Each of independent claims 1, 10, and 19 recite the limitation, "is a customer compatible executable that is compiled from pre-existing source code that includes inserted customer specific messages." This limitation is unclear because once a "customer specific message" is inserted, the source code is no longer pre-existing source code, but rather is a pre-existing source code that has been modified. Thus, we find the language of claims 1, 10 and 19 to be misdescriptive of the invention. We observe that the specification includes original claim 5, which recited "wherein the creating the customer compatible executable step further includes the steps of: selecting generic source code based on the specification file; modifying the generic source code based on the specification file; compiling the modified generic source code." The language of original claim 5 is consistent with appellant's disclosure. However, this language is not recited in appellant's independent claims 1, 10 or 19. As claims 5 and 14 include language that corrects the indefiniteness of the claims from which they depend, claims 5 and 14 have not been included in the rejection.

SUMMARY

This decision contains a New Ground of Rejection of claims 1-4, 6-13 and 15-20 under 35 U.S.C. § 112, second paragraph.

37 CFR § 41.50(b) provides, "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review." 37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings as to the rejected claims:

- (1) Reopen prosecution
- (2) Request a rehearing

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

CONCLUSION

The decision of the examiner to reject claims 1-20 under 35 U.S.C. § 103(a) is reversed. In addition, a New Ground of Rejection has been entered under 37 CFR § 41.50(b), rejecting claims 1-4, 6-13 and 15-20 under 35 U.S.C. § 112, second paragraph, as being indefinite.

REVERSED, 37 CFR § 41.50(B)

JOSEPH F. RUGGIERO	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
STUART S. LEVY	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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HOWARD B. BLANKENSHIP	)	
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