The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

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BOARD OF PATENT APPEALS
AND INTERFERENCES

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRYAN NORMAN PIGGOTT

Appeal No. 2002-1639
Application No. 09/126,817

ON BRIEF

Before RUGGIERO, BARRY, and DIXON, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-17, which are all of the claims pending in the present application.

The claimed invention relates to a method and system for estimating the amount of effort required to develop computer software. An electronic version of a free text document is created, such as a statement of requirements document, and a

natural language engine is trained to recognize and search for phrases in the document which are representative of software functionality.

Claim 1 is illustrative of the invention and reads as follows:

> 1. A method of analyzing a textual document to determine the amount of effort required to develop software code to meet functionality requirements requested in the textual document, comprising:
>
> training a natural language engine to recognize and search for phrases in textual documents which are representative of software functionality;
>
> analyzing the textual document using the trained natural language engine to determine software functionality requirements requested in the textual document.

The Examiner relies on the following prior art:

Loatman et al. (Loatman) 4,914,590 Apr. 03, 1990

Function Point Analysis Training, pp. 1-240, some pages unnumbered (Stoneham, MA, Q/P Mgmt. Group, Oct. 1994) (Hereinafter referred to as FPAT).

Claims 1, 2, 8-13, and 15-17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Loatman.[1] Claims 3-7 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Loatman in view of the FPAT document.

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[1]Claims 8, 9, and 12 are not included in the heading of this rejection at page 3 of the Answer. The Examiner, however, has included them in the detailed discussion of this rejection (Answer, pages 4 and 5), and we will treat them as being part of this rejection.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Briefs[2] and Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, and the evidence of anticipation and obviousness relied upon by the Examiner as support for the rejections. 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 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 Loatman reference does not fully meet the invention as set forth in claims 1, 2, 8-13, and 15-17. With respect to the Examiner's obviousness rejection, we are also of the view that the evidence relied upon and the level of skill in the particular

[2]The Appeal Brief was filed July 30, 2001 (Paper No. 14). In response to the Examiner's Answer mailed October 2, 2001 (Paper No. 15), a Reply Brief was filed December 3, 2001 (Paper No. 16), which was acknowledged and entered by the Examiner as indicated in the communication dated February 12, 2002 (Paper No. 17).

art would not have suggested to one of ordinary skill in the art the invention as recited in claims 3-7 and 14. Accordingly, we reverse.

We consider first the rejection of claims 1, 2, 8-13, and 15-17 under 35 U.S.C. § 102(b) as being anticipated by Loatman. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.), cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

With respect to independent claims 1 and 15-17, the Examiner attempts to read the various limitations on the disclosure of Loatman. In particular, the Examiner directs attention to the portions of the disclosure of Loatman at column 28, line 4 and column 48, lines 38-42.

Appellant's arguments in response assert a failure of Loatman to disclose every limitation in independent claims 1 and 15-17 as is required to support a rejection based on

anticipation. At pages 9 and 10 of the Brief, Appellant's arguments focus on the contention that, in contrast to the language of each of the independent claims which requires an analysis of a textual document to determine software functionality requirements, Loatman merely provides a disclosure of using a natural language system for analyzing and understanding English language text.

After reviewing the Loatman reference in light of the arguments of record, we are in general agreement with Appellant's position as expressed in the Briefs. Our interpretation of the disclosure of Loatman coincides with that of Appellant, i.e., while Loatman discloses applying a natural language understanding system to English language text, as indicated in the passages in Loatman referenced by the Examiner which discuss syntactic analysis of clauses, we find no teaching of utilizing a natural language system to analyze textual document phrases for software functionality as claimed.

We make the further observation that the Examiner's remarks (Answer, pages 11 and 12) in answering Appellant's arguments appear to suggest that, while software functionality determination is not specifically mentioned in Loatman, the natural language understanding system of Loatman has general

applicability and is not limited to particular subjects which are expressible in natural language. Although not expressly stated, the Examiner's remarks suggest, since the existing rejection is one of anticipation, the inherency of using the Loatman natural language understanding system to analyze textual phrases related to any particular subject such as the claimed software functionality.

We agree with Appellant (Reply Brief, page 2), however, that any suggestion of inherency with regard to the use of Loatman for determining software functionality is simply not supported by any disclosure in the Loatman reference. To establish inherency, evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and would be recognized as such by persons of ordinary skill. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) citing Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient." Id. citing Continental, 948 F.2d at 1269, 20 USPQ2d at 1749.

In view of the above discussion, since all of the claim limitations are not present in the disclosure of Loatman, we do not sustain the Examiner's 35 U.S.C. § 102(b) rejection of independent claims 1 and 15-17, nor of claims 2 and 8-13 dependent on claim 1. We further note that, in our view, the Examiner has misinterpreted the disclosure of Loatman so that the issue of the obviousness to the skilled artisan of using a natural language system such as Loatman to analyze text to determine software functionality has not been addressed. To whatever extent the Examiner's remarks can be taken to suggest such obviousness, no teaching or suggestion to do so has been provided by the Examiner outside of Appellant's own disclosure.

Turning to a consideration of the Examiner's 35 U.S.C. § 103(a) rejection of dependent claims 3-7 and 14 based on the combination of Loatman with the FPAT reference, we do not sustain this rejection as well. The Examiner has applied the FPAT reference to address the function point analysis features of the rejected dependent claims. Our review of the disclosure of the FPAT document, however, reveals nothing that would overcome the innate deficiencies of Loatman discussed supra. Further, while the FPAT does discuss function point analysis in analyzing software requirement documents, there is no disclosure of using a

natural language understanding system to perform the analysis. As we alluded to previously, any suggestion to combine a software analysis system such as the function point analysis system described in the FPAT document with a natural language understanding system such as disclosed by Loatman could come only from Appellant's own disclosure and not from any teaching or suggestion in the references themselves.

In summary, we have not sustained either of the Examiner's 35 U.S.C. § 102(b) or 35 U.S.C. § 103(a) rejections of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-17 is reversed.

REVERSED

JOSEPH F. RUGGIERO Administrative Patent Judge	)
JOSEPH L. DIXON Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
LANCE LEONARD BARRY Administrative Patent Judge	)

JFR/hh

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