

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES M. CLAUSS,
KEVIN M. LINSOTT
AND DAVID J. FORD

Appeal No. 2006-0837
Application No. 10/081,446

ON BRIEF

Before BARRETT, RUGGIERO, and MACDONALD, **Administrative Patent Judges**.

MACDONALD, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 16-45. Claims 1-15 have been canceled. Claims 46-47 are allowed.

Invention

Appellants' invention relates to a method, apparatus, and article of manufacture for processing and representing error messages within a computer-aided design environment. An occurrence of a software event that results in an error or a warning is recognized.

An indication of the error/warning is stored in an error/warning storage structure. A result is

returned from a function call that indicates that the error/warning indication has been stored in the error/warning storage structure. Subsequent function call returns do not indicate that the error/warning indication has been stored in the error/warning storage structure. In one embodiment, a hierarchical graphical error/warning log is provided that provides varying levels of error/warning information in response to user input. Appellants' specification at page 4, lines 2-10.

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

16. In a computing apparatus executing a computer aided design (CAD) application, a method comprising:

receiving a user input to perform an operation on a CAD design;

detecting a failure during performance of the operation;

generating a failure indication upon detecting the failure; and

providing information to a user to facilitate the user in determining a location of a cause of the failure within the CAD design and information about how to recover from the failure.

References

The references relied on by the Examiner are as follows:

Ben-Natan et al. (Ben-Natan)	5,740,354	April 14, 1998
Mueller	6,115,544	September 5, 2000
Burrows et al. (Burrows)	6,397,117	May 28, 2002 (Filed May 28, 1998)

Rejections At Issue

Claims 16-23, 26-33, and 36-43 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Burrows and Ben-Natan.

Claims 24-25, 34-35, and 44-45 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Burrows, Ben-Natan, and Mueller.

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

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 affirm the Examiner's rejection of claims 16-45 under 35 U.S.C. § 103.

I. Whether the Rejection of Claims 16-23 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 have suggested to one of ordinary skill in the art the invention as set forth in claims 16-23. Accordingly, we affirm.

¹ Appellants filed an appeal brief on August 5, 2005. Appellants filed a reply brief on October 24, 2005. The Examiner mailed an Examiner's Answer on August 23, 2005.

Appeal No. 2006-0837
Application No. 10/081,446

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of 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, Appellants argue at page 4 of the brief that claim 16 is patentable because “Ben-Natan does not teach or suggest a CAD application nor a CAD design, as required by claim 16.” We disagree. The Examiner correctly points out at pages 7-8 of the answer that Ben-Natan was used “only to teach the limitation of ‘providing information to a user to facilitate the use in determining a location of a cause of the failure and

Appeal No. 2006-0837
Application No. 10/081,446

information about how to recover from the failure.” One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. **See In re Keller**, 642 F.2d 413, 426, 208 USPQ 871, 882 (CCPA 1981); **In re Merck & Co.**, 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986).

Appellants also argue that Ben-Natan’s error message “does not provide the user with information about how to recover from the failure.” We disagree. Again, the Examiner correctly points out at pages 8-9 of the answer that the error report “Could not open file expenses.xls – corrupted” teaches the limitations of the claim. We do not agree with Appellants’ dismissal of this teaching at page 2 of the reply brief. The answer to Appellants’ question (“how is the user to uncorrupt the file?”) would be, as every artisan knows, to replace the corrupted file with an archived file. Given that archiving is a standard business practice, we believe the prior art error report would readily show to an artisan how to recover from the failure.

Further, Appellants argue that there is no motivation to combine the references. We disagree. In addition to a specific suggestion to combine found in the references, we remind Appellants that the Examiner may find a motivation to combine prior art references in the nature of the problem to be solved. **Ruiz v. A.B. Chance Co.**, 357 F.3d 1270, 1276, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004). **See also Pro-Mold & Tool Co. v. Great Lake Plastic Inc.**, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630; **In re Huang**, 100 F.3d 135, 139 n.5; 40 USPQ2d 1685, 1688 n.5 (Fed. Cir. 1996).

The Burrows patent teaches within the context of a computer aided design (CAD) tool that an error can occur and messages must be generated about the error (column 1, line 14). The

Ben-Natan patent teaches an improved method for displaying error messages in a computer system (Summary of Invention). We find that the nature of the problem to be solved provides more than sufficient motivation to combine the prior art references.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103.

II. Whether the Rejection of Claims 26-33 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 have suggested to one of ordinary skill in the art the invention as set forth in claims 26-33. Accordingly, we affirm.

With respect to claims 26-33, Appellant merely references the arguments made with respect to claim 16. Therefore these claims stand or fall with claim 16, and we will sustain the Examiner's rejection under 35 U.S.C. § 103.

III. Whether the Rejection of Claims 36-43² 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 have suggested to one of ordinary skill in the art the invention as set forth in claims 36-43. Accordingly, we affirm.

² We note that Appellants reference claims 36-45 at pages 6 of the brief. However, we treat this as a typographical error as the next section at page 7 of the brief also includes claims 44-45 .

Appeal No. 2006-0837
Application No. 10/081,446

With respect to claims 36-43, Appellant merely references the arguments made with respect to claim 16. Therefore these claims stand or fall with claim 16, and we will sustain the Examiner's rejection under 35 U.S.C. § 103.

IV. Whether the Rejection of Claims 24-25, 34-35, and 44-45 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 have suggested to one of ordinary skill in the art the invention as set forth in claims 24-25, 34-35, and 44-45. Accordingly, we affirm.

With respect to dependent claims 24-25, 34-35, and 44-45, Appellants argue at page 7 of the brief, "Mueller fails to cure the deficiencies of Burrows and Ben-Natan." We find this unpersuasive as we have found no such deficiencies in the rejections based on Burrows and Ben-Natan (see above discussion).

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103.

Conclusion

In view of the foregoing discussion, we have sustained the rejection under 35 U.S.C. § 103 of claims 16-45.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

Appeal No. 2006-0837
Application No. 10/081,446

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