

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 LARRY D. BARTO, YIWEI LI, STEVEN C. NETTLES
and VAN DYKE PARUNAK

Appeal No. 2006-1138
Application No. 10/231,849

ON BRIEF

Before THOMAS, RUGGIERO, and HOMERE, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 1 through 7, 24 through 30 and 47, the examiner having objected to claims 8 through 23 and 31 through 46.

Representative independent claim 1 is reproduced below:

1. A computer-implemented method for generating a cost function, comprising:

identifying a resource for processing a workpiece;
identifying a plurality of cost function parameters; and
accessing a library of parameterized cost function components based on the plurality of cost function parameters to generate a cost function for processing the workpiece using the resource at least one of the cost function parameters defining a shape of the cost function.

The following references are relied on by the examiner:

Harth et al. (Harth)	4,912,624	Mar. 27, 1990
Howie et al. (Howie)	5,093,794	Mar. 3, 1992
Clark et al. (Clark)	5,953,229	Sep. 14, 1999

Claims 1 through 7, 24 through 30 and 47 stand rejected under 35 U.S.C. § 103.

As evidence of obviousness as to claims 1, 4, 24, 27 and 47, the examiner relies on Howie in view of Harth, with the addition of Clark as to claims 2, 3, 5 through 7, 25, 26 and 28 through 30.

Rather than repeating the positions of the appellants and the examiner, reference is made to the revised principal brief on appeal filed on May 13, 2005 and the reply brief for appellants' positions, and to the answer for the examiner's positions.

OPINION

Generally for the reasons set forth by the examiner in the answer, we sustain the rejections of all claims on appeal under 35 U.S.C. § 103, as expanded upon here.

As to the first stated rejection, appellants present arguments generally only as to independent claim 1 and common features with respect to independent claims 24 and 47 as well. Moreover, appellants' positions in the principal brief on appeal do not argue

against the examiner's combinability of Harth with respect to Howie within 35 U.S.C.

§ 103 and also do not argue against the teachings the examiner relies on in Harth.

Moreover, as reflected in the arguments at pages 9 and 10 of the principal brief on appeal, appellants' arguments of patentability to the second stated rejection of various dependent claims additionally relying upon Clark are based upon arguments previously presented as to the subject matter in the first stated rejection as to claim 1.

As set forth in the preamble of representative independent claim 1 on appeal, the computer-implemented method is merely "for" generating a cost function and the body of this claim only recites accessing a library of certain components "to" generate a cost function. There is therefore no positive statement of the actual generation of a cost function in representative independent claim 1 on appeal. Instead, the claim relates to future acts that may never occur. Therefore, to the extent the arguments at page 9 of the principal brief on appeal and arguments that appear to be repeated in the reply brief that the claim is directed to the generation of a cost function, this view is misplaced. The actual claimed language is not consistent with the argument. Even if we agree with the position that Howie does not actually generate a cost function, but merely applies parameters to some unspecified, already generated cost function, the argument is misplaced because there is no positive statement of the generation of a cost function in representative independent claim 1 on appeal anyway.

To the extent argued and claimed, we agree with the examiner's views expressed in the answer, particularly the examiner's correlation of Howie's teachings at the bottom half of column 2 and the initial half of the discussion at column 6. We therefore agree with the examiner's views that the database of parameters used to formulate bids and cost indication of options directly relates to the claimed library of parameterized cost function components. The examiner has otherwise set forth a correlation of the features of representative independent claim 1 on appeal and what the examiner's views are. Corresponding features are taught in Howie. Appellants' arguments do not persuade us of any errors in these views of the examiner.

Appellants' remarks at page 8 of the principal brief on appeal are equally misplaced to the extent that the appellants argue the teachings at column 2, lines 36 through 50 in part are relied upon by the examiner as a basis for the rejection. The position there emphasizes that there is no disclosure of using multiple functions and makes the point that the noted excerpt appears to appellants to establish that an illustrated embodiment there uses only one function at a time which will militate against the use of a library. Because the reference suggests the ability to choose among many functions even though it may indicate that one maybe used at a time, there's no positive statement in representative independent claim 1 on appeal of a plurality of functions being used anyway.

The bulk of the arguments presented in the principal brief on appeal are repeated in the paragraph bridging pages 2 and 3 of the reply brief. The new argument at the top page 3 of the reply brief is that the examiner's view rests upon a hindsight reconstruction of Howie drawn from appellants' disclosure. From our point of view the examiner has merely construed the teachings of Howie against the expansive scope of the subject matter in representative independent claim 1 on appeal. The examiner merely correlates what he regards as the teachings of Howie to what is recited in the claims and no prohibited hindsight is seen to be taken by the examiner's views. The examiner has reasonably applied features of the prior art to extremely broad terms of the claims on appeal to the extent argued before us.

We note in passing that the record reflects that an entered amendment filed with the initial brief on appeal appeared to obviate in the examiner's views rejecting a prior rejection in the final Office action that included a rejection within 35 U.S.C. § 101. From our perspective, there still appears to be merit to this rejection even if representative independent claim 1 would be interpreted to positively recite the actual generation of a cost function. There is no application of a generated cost function to the automation manufacturing environment such as for semiconductor manufacturing in accordance with appellants' disclosed field of invention, for example. As such, the generated cost function would be a mathematical abstraction or be directed to encompass a mathematical algorithm prohibited within 35 U.S.C. § 101.

In view of the foregoing, the decision of the examiner rejection all claims on appeal under 35 U.S.C. § 103 is affirmed.

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

AFFIRMED

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JAMES D. THOMAS)	
Administrative Patent Judge)	
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JOSEPH F. RUGGIERO)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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