

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MICHAEL B. GENKIN and MICHAEL STARKEY

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Appeal 2006-1785  
Application 10/768,827  
Technology Center 2100

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Decided: December 11, 2007

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Before JAMES D. THOMAS, HOWARD B. BLANKENSHIP, and  
ST. JOHN COURTENAY III,<sup>1</sup> *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants have filed a Request for Rehearing under 37 C.F.R.  
§ 41.52(a)(1)(2006) for reconsideration of our Decision of August 30, 2006.

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<sup>1</sup> APJ Courtenay substitutes for original panel member APJ Smith, who retired from the USPTO.

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The Decision reversed the Examiner's 35 U.S.C. § 101 rejection of claims 15-25 and affirmed the Examiner's remaining rejections, as follows:

1. We affirmed the Examiner's rejection of claims 1, 13, 14, 15, 24, and 25 as being anticipated by Bodamer.
2. We affirmed the Examiner's rejection of claim 26 stands as being anticipated by McLain.
3. We affirmed the Examiner's rejection of claims 1-8, 11, 13, 15-19, 23, 24, 27-29, 32, and 34 as being unpatentable over the teachings of Ryzl in view of McLain.
4. We affirmed the Examiner's rejection of claims 9, 10, 12, 20, 21, 22, 30, 31, and 33 as being unpatentable over the teachings of Ryzl in view of McLain, and further in view of Flynn.

The above noted panel only recently received the Request for Rehearing, even though the Request was timely filed on Sept. 27, 2006. We have reconsidered our Decision of Aug. 30, 2006, in light of Appellants' comments in the Request for Rehearing, and we find no errors therein. We decline to change our prior Decision for the following reasons:

A. Appellants contend claims 1 and 15 are not anticipated by Bodamer.<sup>2</sup> Specifically, Appellants argue the following claim limitations are not disclosed by Bodamer:

A(1). Appellants contend the Examiner has never identified any element or passage in Bodamer as disclosing a target computing system (Request 3).

In response, we note that Bodamer expressly discloses: “Fig. 1 is a block diagram that illustrates a computer system 100 upon which an embodiment of the invention may be implemented.” (Col. 3, ll. 56-58). Bodamer further discloses: “The invention is related to the use of computer system 100 for software fault diagnosis.” (Col. 4, ll. 20-21). Bodamer also discloses alternative embodiments: “In alternative embodiments, hard-wired circuitry may be used in place of or in combination with software instructions to implement the invention.” (Col. 4, ll. 32-35). Therefore, we find Bodamer clearly discloses a target computing system.

A(2). Appellants contend there is no language in Bodamer that discloses the requests are acceptable to the target computing system (Request 4).

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<sup>2</sup> We respond here only regarding the limitations of claim 1 since we selected independent claim 1 as the representative claim in our Decision. Appellants did not separately argue claims 1, 13, 14, 15, 24, and 25 in the Appeal Brief (*See* Decision 6-7).

We disagree. As noted in our Decision (p. 11) Appellants have expressly defined the term “request” in the Specification as broadly encompassing “a communication received from a computer application by a computing system.” (Spec. 6, ll. 3-4). Appellants also broadly define the term “communication” as meaning “any transmission of information.” (Spec. 6, l. 7). Bodamer expressly discloses commands that are translated by client process 206 into “lower level requests” that are handled by database server 202 with communication effected by IPC mechanism 208 (Bodamer, col. 7, ll. 9-15). Bodamer further discloses that database server 202 responds to the requests by executing instructions for causing the requested operations to be performed (col. 7, ll. 19-21). In one embodiment, Bodamer discloses that a requested operation (i.e., request), e.g., a cursor call, “must be performed by an external routine, developed by a customer, client, division, or other third party.” (Bodamer, col. 7, ll. 25-27).<sup>3</sup> When database server 202 executes trusted external routine 210 and an agent 214 for an untrusted external routine 212, the external routine that fails (either 210 or 212) is identified as containing a programming error (col. 7, ll. 34-39). Thus, in the case where there is no error in base software module 202 (i.e., database server 202, Fig. 2(a)),<sup>4</sup> Bodamer discloses the error occurs in

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<sup>3</sup> See Bodamer’s discussion of external routines 210 and 212 at col. 6, ll. 5-31.

<sup>4</sup> See Bodamer’s discussion of software process 202 (database server 202) failing, i.e., “crashing” at col. 9, ll. 3-9.

either trusted external routine 210 or untrusted external routine 212 (*Id.*). Therefore, we find requests that are acceptable to Bodamer's target computing system are those requests that are associated with external routines that do not fail.

A(3). Appellants contend that Bodamer's requests are not included within a data source (database server 202) (Request 4).

We disagree. We note that the language of claim 1 in pertinent part recites "said data source containing a plurality of requests . . . ." We find a broad but reasonable construction of this claim language reads on database server 202 executing instructions for causing the requested operations to be performed (*See* Bodamer, col. 7, ll. 8-11, 19-21). In particular, Bodamer discloses a static linking embodiment where object code modules (plural) for external routines (210 and 212) are *incorporated into* the client application 206 *or base software 202* (i.e., database server 202) (*See* col. 6, l. 66 through col. 7, l. 3; *see also* col. 6, ll. 57-62). We note again that Appellants have expressly defined the term "request" in the Specification as broadly encompassing "a communication received from a computer application by a computing system." (Spec. 6, ll. 3-4). Because at least one embodiment of Bodamer incorporates code modules for external routines 210 and 212 *into base software 202* (i.e., database server 202), we find Bodamer discloses a

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data source containing a plurality of requests, as required by the language of representative claim 1 (*Id.*).

A(4). Appellants contend that Bodamer's requests are not associated with a response that describes the expected behavior of a target computing system (Request 4-5).

We disagree. We note that Appellants have expressly defined the term "response" in the Specification as broadly encompassing "a communication to a computer application from a computing system." (Spec. 6, ll. 5-6). We have found *supra* that requests acceptable to Bodamer's target computing system are those requests that are associated with external routines that do not fail (*See* Bodamer, col. 7, ll. 34-39). We find Bodamer's external routines that do not fail are responses that describe the expected behavior of a target computing system. We find the expected responses (i.e., the successful execution of external routines that do not fail) are associated with the requests that invoked the external routines, as discussed *supra*.

B. Appellants argue that the Examiner has not provided any motivation for modifying Ryzl with the teachings of McLain to include the missing limitations of *dependent* claims 2, 3, 4, 5, 16, 17, 28, and 29 (Request 5).

At the outset, we note that Appellants' Request does not challenge the combinability of Ryzl and McLain with respect to independent claims 1, 15,

and 27, from which claims 2, 3, 4, 5, 16, 17, 28, and 29 depend (either directly or indirectly). We further note that each dependent claim incorporates all the limitations of the claims from which it depends. *See* 35 U.S.C. § 112, fourth paragraph (“A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.”). Therefore, the implicit motivation the Examiner has provided to combine Ryzl with McLain (as applied to *independent* claims 1 and 15) applies equally to *dependent* claims 2, 3, 4, 5, 16, 17, 28, and 29 (*See* Ans. 8). Once the references have been determined to be properly combined for purposes of meeting the features of the independent claims, all that remains is to determine whether the references contain the further defined features of the dependent claims. We note that MPEP § 706.02(j) (directed to formulating a proper §103 rejection) is silent with respect to requiring the Examiner to provide a separate motivation statement for each dependent claim falling under the same rejection. It is illogical and cumbersome to require the Examiner to restate the same motivation for each dependent claim falling under the same rejection.

Regarding each of Appellants’ arguments directed to the “teaching, suggestion, or motivation” (TSM) test, the Supreme Court noted in *KSR Int’l Co. v. Teleflex, Inc.* that although the TSM test “captured a helpful insight,” an obviousness analysis “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art

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would employ.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741 (2007). We note that the analytical framework set forth in *KSR* does not distinguish between independent and dependent claims. Here, the Examiner, as finder of fact, has determined that “[o]ne of ordinary skill in the art at the time of invention would have been motivated to combine the teachings [of Ryzl and McLain] because Ryzl teaches an emulator that executes an application without explicitly teach[ing] how the emulator executes the application.” (*See* Ans. 8). The Examiner reasons “[t]here is, therefore, an implicitly stated need in Ryzl for a method of executing the application with the emulator, i.e. responding to requests of the application with the emulator.” (*Id.*). The Examiner concludes that “McLain meets the need of Ryzl by detailing the function of an emulator.” (*Id.*). We find the Examiner has articulated an adequate reasoning with a rational underpinning to support the legal conclusion of obviousness (*See* Ans. 8).

In the Request Appellants do not challenge the Examiner’s finding that the limitations of dependent claims 3, 4, 5, 17, and 29 are taught and/or suggested by the combination of Ryzl and McLain. Appellants do contend that the limitations of dependent claims 2, 16, and 28 are not taught or suggested by the combination of Ryzl and McLain, as discussed *infra*.

C. Appellants contend that Ryl and McLain, taken in combination, do not teach or suggest “wherein said responding comprises undertaking an

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action as described by said response associated with said request, collecting a result of said action, and reporting said result to said application” as recited in claim 2, and similarly in claims 16 and 28 (Request 8).

We disagree. As noted in our Decision (p. 22), we previously found that McLain teaches undertaking an action as part of the response, as claimed:

Actions can include a first level of response for unintelligently responding to certain inputs, a second level of response for intelligently responding to certain inputs using simple commands and a third level of response for providing detailed logical responses by invoking a script.  
(McLain, col. 10, ll. 15-19).

We further find that McLain teaches a reporting step 324 that collects the result of the actions and reports the statistical results of such actions to the user (via User Interface 214) (*See* Figs. 2-3), as follows:

Referring back to FIG. 3, if in step 320, if a user opts to terminate processing then, in step 322, system manager 127 terminates all communications sessions and processes that are currently executing under control of command response manager 216. System manager 127 also frees up memory used by buffers, queues, and command control vectors. In step 324, TND emulator 126 creates a report of statistics on the processing it has just performed.  
(McLain, col. 26, ll. 14-21).

Accordingly, we find the Examiner's proffered combination of Ryzl and McLain reasonably teaches and/or suggests all that is claimed (*See* dependent claims 2, 16, and 28). *See In re Hoeschele*, 406 F.2d 1403, 1406-07 (CCPA 1969) (“[I]t is proper to take into account not only specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom . . .”).

D. Appellants contend that Ryzl and McLain, taken in combination, do not teach or suggest “wherein said data source comprises at least one file” as recited in claim 7 and similarly in claim 18 (Request 9). In particular, Appellants contend the ADDataObject (190) taught by Ryzl (¶0068) is not a data source that includes a plurality of requests acceptable to a target computing system and a plurality of responses, as required by claim 1, upon which claim 7 depends (Request 10).

We disagree. We find Appellants are arguing the references separately. The Examiner's rejection is based upon the combination of Ryzl and McLain. Our reviewing court has determined that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Here, Ryzl must be read, not in isolation, but for what it fairly teaches or suggests in combination with the prior art as a whole. We note that Ryzl expressly teaches “an adContent file (188) that contains additional information that may be necessary to build the

application jar file (58)” (Ryzl, ¶0068). Therefore, we find Ryzl reasonably teaches and/or suggests a data source comprised of at least one file. Ryzl also teaches an emulator 61 and data source(s) connected to the emulator (*e.g.*, *see* Ryzl, Fig. 10). However, the Examiner has relied upon McLain as teaching a data source that includes a plurality of responses (*See* Answer 8; *see also* McLain, col. 3, ll. 52-53, *i.e.*, “The command response manager can employ one or more command response tables to generate responses.”). We find files are ubiquitous in computers systems in general, including the systems of Ryzl (as discussed above) and McLain.

*See also* McLain, as follows:

Database manager 220 manages a variety of databases that are employed by TND emulator 126. *Databases store files* for operation and can be maintained in one or more physical storage devices [emphasis added].  
(McLain, col. 7, ll. 38-41).

FIG. 12 contains Tables 1-5, illustrating sample data tables for configuration database 226 and *log database files 228* [emphasis added];  
(McLain, col. 5, ll. 7-9).

FIG. 13 illustrates a view of a main window of TND emulator 112. User interface 214 controls user displays and user interaction. User interface 214 handles displays for *script databases and log files*, controls a screen-saver feature and controls real-time display [emphasis added].  
(McLain, col. 7, ll. 32-36).

For at least the aforementioned reasons, we find unavailing Appellants' contention that the claimed "data source" that "comprises at least one file" is an unobvious advancement over the prior art. To the contrary, we find the preponderance of the evidence supports the Examiner's finding that the combination of Ryzl and McLain teaches and/or suggests all that is claimed.

E. Appellants contend that the Examiner has not provided an appropriate motivation for modifying Ryzl with Flynn to include the missing limitations of claims 9, 20, and 30 (Request 11). We note that each of claims 9, 20, and 30 recite in pertinent part "verifying the validity of said at least one file."

Specifically, Appellants contend that Ryzl has absolutely no interest in providing applications with advance notice of what names and structures can be used in a particular document type (Request 12). Appellants note that the purpose of Ryzl is unrelated to using a Document Type Definition (DTD). Appellants conclude that "[t]he Examiner's source of motivation is only motivation for Flynn to use a Document Type Definition." (*Id.*).

The Examiner states in the rejection that one of ordinary skill in the art at the time of invention would have been motivated to modify the teachings of Ryzl and McLain with the teachings of Flynn because verifying an XML file would have provided applications with advance notice of what names and structures could have been used in a particular document type

and would have allowed for the certainty that documents of a particular type would have been constructed and named in a consistent manner (*See* Ans. 13).

As previously set forth in our Decision (pp. 25-26), we note again that the Examiner's proffered motivation is taken directly from the Flynn reference at page 14, ¶C.11. Thus, we find the Examiner has provided a proper teaching or suggestion found within the prior art that would have reasonably motivated one of ordinary skill in the art to combine the references as suggested by the Examiner.

Moreover, in view of the Supreme Court's recent opinion in *KSR Int'l Co. v. Teleflex Inc.*, our analysis here does not turn solely upon whether the Examiner has provide an adequate teaching, suggestion, or motivation to combine the references. Instead, we view the question before us to be whether sufficient difference exists between the prior art and Appellants' claims to render the claims nonobvious. In *KSR*, the Supreme Court reaffirmed that "[w]hen a patent 'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an arrangement, the combination is obvious." *KSR*, 127 S. Ct. at 1740 (quoting *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282 (1976)). Furthermore, "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Leapfrog Enter., Inc. v. Fisher-*

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*Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting *KSR*, 127 S. Ct. at 1739).

Here, we note that Extensible Markup Language (XML) is a familiar element in the art, as is verifying the validity of XML files using Document Type Definitions and validating parsers, as taught by Flynn (*See* Flynn, section D.2, labeled: “Valid XML”). Appellants have not shown that the claimed combination of familiar elements produces a new function. Moreover, Appellants have not provided any factual evidence of secondary considerations, such as unexpected or unpredictable results, commercial success, or long felt but unmet need. After carefully considering the evidence before us, we conclude that Ryzl, McLain, and Flynn have complementary features that would have reasonably led an artisan having ordinary skill and common sense to combine their teachings in the manner suggested by the Examiner.

## CONCLUSION

We have considered the arguments raised by Appellants in the Request for Rehearing, but none of these arguments is persuasive that our original Decision was in error. This Decision on Appellants’ Request for Rehearing is deemed to incorporate our earlier Decision (mailed August 30, 2006) by reference. *See* 37 C.F.R. § 41.52(a)(1).

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DECISION

We have granted Appellants' request to the extent that we have reconsidered our Decision of Aug. 30, 2006, but we deny the request with respect to making any changes therein.

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)(2006).

DENIED

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