

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

Appeal No. 2006-1785
Application No. 10/768,827

ON BRIEF

Before THOMAS, JERRY SMITH, and BLANKENSHIP, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-34.

The disclosed invention pertains to a system and method for testing computer applications.

Representative claim 26 is reproduced as follows:

26. A method of emulating a target computing system, comprising:

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- a. receiving a request;
- b. obtaining a response associated with said request from a data source, said data source containing a plurality of requests acceptable to said target computing system and a plurality of responses, each acceptable request being associated with a response that describes the expected behavior of said target computing system upon receiving said acceptable request; and
- c. responding as described by said response associated with said request.

The examiner relies on the following references:

Bodamer	6,163,858	Dec. 19, 2000
McLain et al. (McLain)	6,295,518	Sep. 25, 2001
Ryzi	US 2003/0236657	Dec. 25, 2003 (filed Mar. 12, 2001)

Flynn, Peter (Flynn), "The XML FAQ", <http://www.ucc.ie/xml>

The following rejections are on appeal before us:

1. Claims 15-25 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter [answer, page 3].

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2. Claims 1, 13, 14, 15, 24 and 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bodamer [answer, page 4].
3. Claim 26 stands rejected under 35 U.S.C. § 102(e) as being anticipated by McLain [answer, page 6].
4. Claims 1-8, 11, 13, 15-19, 23, 24, 27-29, 32 and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Ryzl in view of McLain [answer, page 7].
5. Claims 9, 10, 12, 20, 21, 22, 30, 31 and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Ryzl in view of McLain, and further in view of Flynn [answer, page 13].

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

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

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have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' 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. Only those arguments actually made by appellants have been considered in this decision

It is our view, after consideration of the record before us, that the evidence relied upon supports the examiner's finding of anticipation with respect to claims 1, 13, 14, 15 and 24-26. We also find that the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-13, 15-24 and 27-34. However, we will not sustain the examiner's finding of non-statutory subject matter with respect to claims 15-25. Accordingly, we affirm.

I. We consider first the examiner's rejection of claims 15-25 under 35 U.S.C. §101. Appellants argue that claims 15-25 are improperly rejected under 35 U.S.C. §101 [brief, pages 6-9]. In response, the examiner essentially argues that claim 15 is directed to a data structure per se and is therefore non statutory. See In re Warmerdam 33 F.3d 1354, 1362, 31 USPQ2d 1754, 1760 (Fed. Cir. 1994).

We note that claim 15 recites "an article of manufacture comprising a computer program product embodied in a machine readable medium"

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We further note that under the PTO's "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" [OG, 22 Nov. 2005], when functional descriptive material is recorded on a computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. See also In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (a claim to data structure stored on a computer readable medium that increases computer efficiency held statutory). Therefore, we do not agree with the examiner that instant claim 15 recites an unpatentable data structure, per se. Accordingly, we will reverse the examiner's rejection of claims 15-25 under 35 U.S.C. §101.

II. We consider next the examiner's rejection of claims 1, 13, 14, 15, 24 and 25 as being anticipated by Bodamer. Since Appellants' arguments with respect to this rejection have treated these claims as a single group which stand or fall together, we will consider independent claim 1 as the representative claim for this rejection. See 37 C.F.R. § 41.37(c)(1)(vii) (2004).

In rejecting claims under 35 U.S.C. §102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim

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invalidates that claim by anticipation. Perricone v. Medicis Pharmaceutical Corp., 432 F.3d 1368, 1375-6, 77 USPQ2d 1321, 1325-6 (Fed. Cir. 2005), citing Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc., 976 F.2d 1559, 1565, 24 USPQ2d 1321, 1326 (Fed. Cir. 1992). To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” 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.” In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (internal citations omitted). “Every element of the claimed invention must be literally present, arranged as in the claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (internal citations omitted).

(a) Appellants argue that Bodamer does not disclose “establishing communication between said application and an emulating system, said emulating system responding to a request from said application,” as recited in claim 1 [brief, pages 10 and 11].

The examiner disagrees [answer, page 15]. The examiner points to fig. 2 as showing the communication connection for the emulating system [id.].

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The examiner asserts that the emulating system shown in fig. 2 is the system connected to client application 206 that performs emulation, noting that database server 202 and agent 214 clearly show an emulating system [id.]. The examiner asserts that there is communication between the application and the emulation system [answer, page 16; see also fig. 2(a) and 2(b), in particular IPC 208].

“During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification.” In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Claim language is given its plain, ordinary, or accustomed meaning to one of ordinary skill in the relevant art, unless the applicant has imparted a novel meaning to the language. Teleflex, Inc. v. Ficosa N. Am. Corp., 299 F.3d 1313, 1325, 63 USPQ2d 1374, 1380 (Fed. Cir. 2002). In the instant case, we find that appellants’ claimed “emulating system” is properly construed broadly in light of the plain, ordinary, and accustomed meaning of the term “emulator” [claim 1]. We note that this broad construction finds support within the instant specification at page 7, lines 25 and 26: “Emulator 16 and interface 18 are not described in detail herein as a skilled person in the art would know how they could be implemented,” [emphasis added]. In particular, we find that the substitute routines that imitate the function of Bodamer’s external routines [col. 8, lines 40-42] clearly meet the plain

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meaning definition proffered by the examiner in the answer (i.e., “emulation is simply one computer, device or program imitating the function of another computer, device or program.”¹) [answer, page 16, emphasis added]. We further note that the examiner’s use of extrinsic evidence (i.e., a dictionary definition) has been properly considered in the context of the intrinsic evidence (i.e., the plain meaning of the term is consistent with and does not contradict the instant specification). See Phillips v. AWH Corp., 415 F.3d 1303, 1319, 75 USPQ2d 1321, 1331 (Fed. Cir. 2005) (en banc). Therefore, we agree with the examiner that Bodamer teaches an emulation system even though Bodamer does not use the literal term “emulator.” Accordingly, we conclude that the plain meaning of the recited term “emulating system,” (i.e., a program imitating the function of another computer, device or program) broadly reads upon Bodamer’s substitute routines [col. 8, lines 13-21].

(b) Appellants argue that Bodamer does not disclose “obtaining a response associated with said request from a data source, said data source containing a plurality of requests acceptable to said target computing system and a plurality of responses, each acceptable request being associated with a response that describes the expected behavior of said target computing system in response to said acceptable request,” as recited in claim 1 and

¹ See “Microsoft Computer Dictionary”, 3rd Edition, Microsoft Press, 1997, page 175.

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similarly in claim 15 [brief, page 13]. Appellants further argue that Bodamer does not disclose “responding as described by said response associated with said request,” as recited in claim 1 and similarly in claim 15 [brief, page 16].

The examiner disagrees [answer, page 18]. The examiner asserts that Bodamer teaches responses describing the expected behavior of the target computing system in response to the requests at col. 8, lines 13-21 [id.]. The examiner asserts that Bodamer further teaches the requests being acceptable to the target system at col. 7, lines 8-11 [id.]. The examiner asserts that fig. 2 of Bodamer clearly shows multiple data sources (Database Server 202 and Source for Client Routine(s) 220) [id.]. The examiner notes that Bodamer states that the source files are archived into a library and this library is accessed to generate the substitute routines based on a template at col. 6, lines 23-24 and 55-58, and col. 7 lines 63-67 [id.]. The examiner concludes that it is clear that the data source contains the substitute routines (i.e., responses) and is accessed based on the template, which necessarily includes the acceptable requests as outlined in Bodamer at col. 7, lines 8-11 [id.].

We begin by construing the recited terms “request” and “response” by according these terms the broadest reasonable interpretation consistent with the specification. We note that the Court of Appeals for the Federal Circuit has determined that “the specification is the ‘single best guide to the

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meaning of a disputed term' and that the specification 'acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication.' " Phillips v. AWH Corp., 415 F.3d at 1321, 75 USPQ2d at 1332 (internal citations omitted). In the instant case, we note that appellants have expressly defined the term "request" in the instant specification as broadly encompassing "a communication received from a computer application by a computing system" [page 6, lines 3 and 4]. We further 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" [page 6, lines 5 and 6]. We note that Bodamer explicitly discloses commands that are translated into "lower level requests" that are handled by database server 202 with communication effected by IPC mechanism 208 [col. 7, lines 9-15, emphasis added]. We further note that Bodamer discloses that database server 202 responds to the requests by executing instructions for causing the requested operations to be performed [col. 7, lines 19-21]. Significantly, we note that Bodamer explicitly discloses that "[t]he results of the database server 202 operation are communicated back to the client process 206 via IPC mechanism 208" [col. 7, lines 27-30, emphasis added]. We also note that database server 202 executes external routines [col. 7, lines 34 and 35] that in one embodiment are replaced by substitute routines that are generated based on

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the declarations for the external routines [col. 7, lines 61-63]. We note that the examiner corresponds the claimed responses with Bodamer's substitute routines that are generated for purposes of debugging [answer, page 18; see also Bodamer at col. 7, lines 58-67 and col. 8, lines 8-67]. We further note that Bodamer's exemplary software system 200 is implemented as a relational database system and base software module 202 (i.e., database server 202) is implemented as a relational database server [col. 5, lines 55-58]. Therefore, we find that the claimed "data source" broadly reads upon the database system disclosed by Bodamer [claim 1]. Accordingly, we will sustain the examiner's rejection of representative claim 1 for essentially the same reasons set forth by the examiner in the answer.

We note that claims 13, 14, 15, 24 and 25 fall with independent claim 1 since appellant has not separately argued the patentability of these claims. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987). See also 37 C.F.R. § 41.37(c)(1)(vii)(2004). Accordingly, we will also sustain the examiner's rejection of claims 13, 14, 15, 24 and 25 for the reasons set forth by the examiner in the rejection.

III. We consider next the examiner's rejection of claim 26 as being anticipated by McLain.

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Appellants argue that McLain does not teach the following recited limitations:

obtaining a response associated with said request from a data source, said data source containing a plurality of requests acceptable to said target computing system and a plurality of responses, each acceptable request being associated with a response that describes the expected behavior of said target computing system upon receiving said acceptable request [claim 26];

In particular, appellants argue that McLain's command response table (fig. 14) only includes responses and does not teach requests [brief, page 19]. Appellants further argue that the commands disclosed in the command response table are not requests [brief, page 20, ¶2, emphasis added]. The examiner disagrees and points to indexes to the command response table as corresponding to requests [answer, page 20; see also McLain col. 9, line 12 and col. 10, line 6]. Appellants note that very rarely would the index to a table be the same value as stored in the indexed entry in the table [reply brief, page 9]. We note that the examiner appears to contradict himself as he further explicitly corresponds McLain's commands as disclosed in the command response table as teaching the claimed requests [answer, page 21, lines 2 and 3].

Anticipation of a patent claim requires a finding that the claim at issue "reads on" a prior art reference. Atlas Powder Co. v. Ireco, Inc., 190 F 3d 1342, 1346, 51 USPQ2d 1943, 1945 (Fed. Cir. 1999) citing Titanium Metals Corp. v. Banner, 778 F.2d 775, 781, 227 USPQ 773, 778 (Fed. Cir. 1985)

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("In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art."). In the instant case, we do not agree with the examiner that McLain's indexes teach the instant recited "requests" because McLain's message pointer for accessing individual data entries is not contained within the command response table, as required by the language of claim 26 [see "message pointer" at col. 10, line 6]. We also do not agree with appellants that McLain's commands are not requests. We note again that appellants have expressly defined the term "request" in the instant specification as broadly encompassing "a communication received from a computer application by a computing system" [page 6, lines 3 and 4]. Therefore, we find that appellants' own definition for the claimed "requests" broadly reads upon the commands disclosed by McLain that are shown contained within the command response table [claim 26; see also McLain, command field 1414, fig. 14]. We also find that McLain clearly discloses requests (i.e., commands corresponding to function calls intended for the target system being emulated) and associated responses at col. 2, lines 49-54:

In order to adequately test a control system, a system, method and computer program product for simulating telecommunication network devices is needed. Simulation should include emulation of network device functionality in the context of receiving commands and data from a control system and formulating intelligent responses [emphasis added].

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Therefore, we find that McLain teaches every limitation of claim 26, arranged as claimed, as shown infra:

26. A method of emulating a target computing system, comprising:	See col. 3, lines 10 and 11: "emulating a telecommunications network."
receiving a request;	See col. 9, lines 64-67: "A command field 1414 identifies a particular command that can be received by TND emulator 126."
obtaining a response associated with said request from a data source, said data source containing a plurality of requests acceptable to said target computing system and a plurality of responses,	See col. 9, lines 64-67: "A response field 1416 provides an appropriate response for the command identified in field 1414." See also plural "command fields 1414" and "requests," col. 10, lines 11 and 21. The claimed "data source" is taught by the command response table shown in fig. 14, and described in columns 9 –11, particularly at col. 9, lines 43-67.
each acceptable request being associated with a response that describes the expected behavior of said target computing system upon receiving said acceptable request; and responding as described by said response associated with said request.	See col. 10, lines 6-14: "Command response manager 216 uses a message pointer to determine which entry will control response generation. The message pointer can be part of a command control vector. On initialization, the message pointer is positioned at the first entry in a command response table. When a command is received from network interface 212, a command column containing command fields 1414 is searched for a match. If the command is found in the command column, command response manager 216 takes action as indicated by an associated response field 1416."
responding as described by said response associated with said request.	See col. 10, lines 15-19: "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."

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Accordingly, because McLain teaches all that is claimed, we will sustain the examiner's rejection of independent claim 26 as being anticipated by McLain.

IV. We consider next 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 [answer, page 7].

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). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. 277 F.3d 1343, 61 USPQ2d at 1433-34. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience - or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these

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findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner 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 examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). See also In re Thrift, 298 F. 3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). 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 and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038,

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1039, 228 USPO 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPO 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPO 143, 147 (CCPA 1976).

Motivation to modify Ryzl with McLain

Appellant argues that the examiner has failed to set forth a proper motivation for combining Ryzl with McLain [brief, pages 22-30].

The examiner disagrees and asserts that one of ordinary skill in the art at the time of invention would have been motivated to combine the teachings because Ryzl teaches an emulator that executes an application without explicitly teaching how the emulator executes the application [answer, page 22]. The examiner asserts that there is 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 argues McLain meets the implicit deficiency of Ryzl by detailing the function of an emulator [answer, page 23].

We note that the Court of Appeals for the Federal Circuit has determined that the motivation to combine under § 103 must come from a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources, to select particular elements, and to combine them as combined by the inventor. Ruiz v. A.B.

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Chance Co., 234 F.3d 654, 665, 57 USPQ2d 1161, 1167 (Fed. Cir. 2000)

[emphasis added]. In the instant case, we find appellants' argument unpersuasive that the examiner has failed to provide a proper motivation for combining the teachings of McLain with the teachings of Ryzl. We note that the examiner's rejection is based on the finding that Ryzl teaches every element of the claimed invention except for the recited limitations of:

obtaining a response associated with said request from a data source, said data source containing a plurality of requests acceptable to said target computing system and a plurality of responses, each acceptable request being associated with a response that describes the expected behavior of said target computing system upon receiving said acceptable request [claim 1].

We note that we have found supra that these specific limitations are taught by McLain. We further note that the examiner has cited McLain for the purpose of showing that it was known to use a data source (i.e., see command response table, fig. 14) that contains a plurality of requests associated with responses that describe expected responses of a target system being emulated. We agree with the examiner that the artisan would have been motivated to modify Ryzl with the teachings of McLain because McLain provides specific implementation details of a structure (e.g., see command response table, fig. 14) and associated method of responding to application requests intended for the target devices being emulated [see McLain, fig. 14, Command Response Table, Command 1414 (i.e., corresponding to a request) and associated Response 1416; see also col. 10,

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lines 9-14; see also plural "command fields 1414" and "requests," col. 10, lines 11 and 21]. In particular, we note that McLain discloses at col. 4, lines 18-23:

One advantage of the present invention is that multiple levels of responses generated by a command response table permit designers to quickly provide a network emulator using simple, unintelligent responses while allowing more detailed responses to be programmed at a later time.

Upon consideration of all the evidence before us, we find appellants' arguments unpersuasive that the examiner has failed to show, inter alia, a source of the motivation, objective evidence, a reasonable expectation of success, and also that the proffered combination changes Ryzl's principle of operation [brief, pages 22-31]. We find that McLain provides specific implementation details to improve Ryzl's wireless device emulation system, as argued by the examiner [answer, pages 20-28]. We further agree with the examiner that the teaching, motivation, or suggestion to modify Ryzl with the teachings of McLain is implicit from the prior art as a whole. Accordingly, we conclude that the examiner has sufficiently explained why an artisan possessing knowledge of Ryzl and McLain at the time of the invention would have been motivated to look to McLain, to select particular elements, and to combine them with Ryzl.

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As per independent claims 1, 15, 27 and 34

Since Appellants' arguments with respect to this rejection have treated these claims as a single group which stand or fall together [brief, pages 31-33], we will select independent claim 15 as the representative claim for this rejection because it is the broadest independent claim associated with this rejection. See 37 C.F.R. § 41.37(c)(1)(vii)(2004).

Appellants essentially restate the arguments previous made supra with respect to McLain, alleging, inter alia, that McLain does not teach a data source containing a plurality of requests acceptable to a target computing system and a plurality of associated expected responses [brief, pages 31-32].

We note that we have found, supra, that McLain does teach all the limitations that appellants allege are not taught by the combination of Ryzl and McLain [See discussion of claim 26, supra]. Therefore, we will sustain the examiner's rejection of representative claim 15. We further note that independent claims 1, 27 and 34 fall with independent claim 15 since appellant has not separately argued the patentability of these claims with respect to this rejection. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987). See also 37 C.F.R. § 41.37(c)(1)(vii)(2004). Accordingly, we will sustain the examiner's rejection of independent claims 1, 15, 27 and 34 as being unpatentable over Ryzl in view of McLain.

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As per dependent claims 2, 16 and 28

Appellants argue that Ryzl and McLain, taken alone or in combination, do not teach nor suggest “wherein said responding comprises undertaking an 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 [brief, page 34].

We disagree. We note that McLain explicitly discloses undertaking an action as part of the response, as claimed. See col. 10, lines 15-19:

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.

Accordingly, we will sustain the examiner’s rejection of claims 2, 16 and 28 as being unpatentable over Ryzl in view of McLain.

As per dependent claims 4, 17 and 29

Appellants argue that Ryzl, McLain and Flynn, taken alone or in combination, do not teach nor suggest “wherein said obtaining comprises searching said data source for a matching request and, upon finding said matching request, retrieving the response associated with said matching request” as recited in claim 4 and similarly in claims 17 and 29 [brief, page 35].

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We disagree. We note that McLain explicitly discloses searching a data source (i.e., command response table), matching, and retrieving a response associated with the request, as claimed. See col. 10, lines 6-14:

Command response manager 216 uses a message pointer to determine which entry will control response generation. The message pointer can be part of a command control vector. On initialization, the message pointer is positioned at the first entry in a command response table. When a command is received from network interface 212, a command column containing command fields 1414 is searched for a match. If the command is found in the command column, command response manager 216 takes action as indicated by an associated response field 1416 [emphasis added].

Accordingly, we will sustain the examiner's rejection of claims 4, 17 and 29 as being unpatentable over Ryzl in view of McLain.

As per dependent claim 5

Appellants argue that Ryzl and McLain, taken alone or in combination, do not teach nor suggest "'wherein said emulating system comprises an emulator adapted to receive said request from said application, obtain said response associated with said request from said data source, and respond to said application as described by said response associated with said request,'" as recited in claim 5 [brief, page 38].

We disagree. We note that Ryzl explicitly discloses an emulator at page 3, ¶0020. McLain explicitly discloses emulating a telecommunications network by simultaneously emulating multiple independent devices in the telecommunications network at col. 3, lines 9-13. McLain further teaches

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obtaining a response associated with the request from a data source, and responding to an application as described by the response associated with the request, as discussed supra with respect to the rejection of claim 26 as being anticipated by McLain.

Accordingly, we will sustain the examiner's rejection of claim 5 as being unpatentable over Ryzl in view of McLain.

As per dependent claims 7 and 18

Appellants argue that Ryzl and McLain, taken alone or in combination, do not teach nor suggest "wherein said data source comprises at least one file" as recited in claim 7 and similarly in claim 18 [brief, page 40].

The examiner points to the "adContent file" taught by Ryzl at ¶0068, line 7 [answer, pages 10 and 29]. We will sustain the examiner for essentially the same reasons argued by the examiner in the answer, and also because we find that McLain's command response table (fig. 14) is inherently stored as at least one file, as claimed.

As per dependent claims 3, 6, 11, 13, 19, 23, 24 and 32

Because appellants do not separately argue dependent claims 3, 6, 11, 13, 19, 23, 24 and 32 with respect to this rejection, these claims fall with representative claim 1. See In re Nielson, supra at 1572. Accordingly,

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we will sustain the examiner's rejection of these claims as being unpatentable over Ryzl in view of McLain.

V. We consider next 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 [answer, page 13].

Motivation to modify Ryzl and McLain with Flynn

Appellant argues that the examiner has failed to set forth a proper motivation for combining Ryzl with McLain and Flynn [brief, pages 42-45].

In response, the examiner disagrees [answer, page 29]. The Examiner asserts that the cited section of Flynn clearly details the benefits of using a Document Type Definition (DTD) when using XML (Extended Markup Language) [answer, pages 29 and 30]. The examiner points to MPEP §2144 that states: "the expectation of some advantage is the strongest rationale for combining references" [answer, page 30]. The examiner asserts that the benefits of using a DTD clearly provide the expectation of some advantage [id.]. The examiner concludes that the proffered motivation meets the definition of that which has been determined to be the "strongest rationale for combining references" [id.].

We note that 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

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the teachings of Ryzl and McLain with the teachings of Flynn because verifying an XML file provides applications with advance notice of what names and structures can be used in a particular document type and allows for the certainty that documents of a particular type will be constructed and named in a consistent manner [answer, page 13]. In particular, we note that this motivation is taken directly from the Flynn reference at page 14, ¶C.11. Accordingly, we find that the examiner has provided a proper teaching or suggestion found within the prior art that would reasonably motivate one of ordinary skill in the art to combine the references in the manner suggested by the examiner.

As per dependent claims 9 and 12

Appellants argue that dependent claims 9 and 12 are patentable over Ryzl in view of McLain, and further in view of Flynn, for at least the same reasons that claim 1 is patentable over Ryzl in view of McLain [brief, page 45]. Accordingly, we will sustain the examiner's rejection of these claims for the same reasons we sustained the examiner's rejection of claim 1 as being unpatentable over Ryzl in view of McLain, as discussed supra.

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As per dependent claims 20 and 22

Appellants argue that dependent claims 20 and 22 are patentable over Ryzl in view of McLain, and further in view of Flynn, for at least the same reasons that claim 15 is patentable over Ryzl in view of McLain [brief, page 45]. Accordingly, we will sustain the examiner's rejection of these claims for the same reasons we sustained the examiner's rejection of claim 15 as being unpatentable over Ryzl in view of McLain, as discussed supra.

As per dependent claims 30 and 33

Appellants argue that dependent claims 30 and 33 are patentable over Ryzl in view of McLain, and further in view of Flynn, for at least the same reasons that claim 27 is patentable over Ryzl in view of McLain [brief, page 45]. Accordingly, we will sustain the examiner's rejection of these claims for the same reasons we sustained the examiner's rejection of claim 27 as being unpatentable over Ryzl in view of McLain, as discussed supra.

As per dependent claims 10, 21 and 31

Appellants argue that dependent claims 10, 21 and 31 are patentable over Ryzl in view of McLain, and further in view of Flynn, because these references do not teach or suggest "wherein said verifying comprises verifying that the format of said at least one file conforms to a standard

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format stored in a definition source” as recited in claim 10 and similarly in claims 21 and 31 [brief, page 46].

The examiner disagrees [answer, page 31]. The examiner points to Flynn [page 23, ¶D.2] that describes XML rules for well-formed documents and rules for validity [answer, page 31]. The examiner asserts that a valid XML file is verified to determine whether it conforms to the format of the Document Type Definition (DTD) and is well-formed [id.]. The examiner notes that a valid XML file is a well-formed file that conforms with an associated DTD [id.]. The examiner concludes that the language of claims 10, 21 and 31 reads upon the cited Flynn reference [id.].

We note that the instant claimed “definition source” clearly reads upon an XML Document Type Definition, as disclosed by Flynn on pages 23 and 24. With respect to the claimed format verification, we note that Flynn explicitly discloses “[t]he test for validity is that a validating parser finds no errors in the file: it must conform absolutely to the definitions and declarations in the DTD” [see last sentence on page 24, emphasis added]. Accordingly, we will sustain the examiner’s rejection of claims 10, 21 and 31 as being unpatentable over Ryzl in view of McLain, and further in view of Flynn, for essentially the same reasons argued by the examiner in the answer.

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In summary, we have sustained the examiner's rejections of claims 1-34 in view of the prior art of record, but we have not sustained the examiner's rejection of claims 15-25 under 35 U.S.C. § 101. Therefore, the decision of the examiner rejecting claims 1-34 is affirmed.

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).

AFFIRMED

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James D. Thomas)	
Administrative Patent Judge)	
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Jerry Smith)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
)	
Howard B. Blankenship)	
Administrative Patent Judge)	

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