

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 EITAN FARCHI, DANIEL GEIST, ALAN HARTMAN,
PAUL KRAM, KENNETH NAGIN, YAEL SHAHAM-GAFNI,
And SHMUEL UR

Appeal 2006-3277
Application 09/946,237¹
Technology Center 2100

Decided: February 9, 2007

Before KENNETH W. HAIRSTON, HOWARD B. BLANKENSHIP, and
JAY P. LUCAS, *Administrative Patent Judges*.

LUCAS, *Administrative Patent Judge*.

STATEMENT OF CASE

Applicants appeal from a final rejection of claims 1 to 25 under 35
U.S.C. § 134 (2002). The Board has jurisdiction under 35 U.S.C. § 6(b)
(2002).

¹ Application filed September 05, 2001. The real party in interest is
International Business Machines Corporation.

The Appellants have invented a method, system, and computer program device that tests software using an automatically generated suite of tests. The Examiner rejected claims 1 to 25 under 35 U.S.C. § 102 based on AGEDIS – Project Proposal Part B (“AGEDIS”). No claims have been allowed.

The claims are drawn to a method, a system, and a computer program product. Claims 1 and 23 are representative:

1. A method of generating a test suite for testing computer software, comprising the steps of:

running an existing test suite against said computer software and outputting a test trace;

inputting said test trace to a test coverage tool and outputting a test coverage result file;

inputting said test coverage result file to an automated test generator; and
generating a final test suite based on said test coverage result file.

23. A computer program product in a computer-readable medium for generating a test suite for testing computer software, comprising:

computer-readable means for running an existing test suite against said computer software and outputting a test trace;

computer-readable means for inputting said test trace to a test coverage tool and outputting a test coverage result file;

computer-readable means for inputting said test coverage result file to an automated test generator; and

computer-readable means generating a final test suite based on said test coverage result file.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

AGEDIS: “Automated Generation and Execution of Test Suites for Distributed Component Based Software”, Project Proposal – Part B, pp 1-38, printed May 23, 2000.

Neither the Appellants in the Brief nor the Examiner in her Answer has argued the sufficiency of the contents of the reference to anticipate the claims. The sole issue is whether the AGEDIS proposal qualifies as a reference against this application. Appellants contends that the reference cannot be considered prior art against these claims as the reference was not made public until subsequent to the application’s filing date, September 5, 2001. (Br. 7-9). The Examiner contends that the Appellants have not established with proper evidence that the reference was indeed held in confidence as Appellants contend. (Answer 4).

We reverse.

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 102. The issue turns on whether the AGEDIS document is a proper and sufficient prior art reference against these claims.

FINDINGS OF FACT

Appellants invented a system, method, and computer program for automatically testing software as claimed.

On review of the Declaration of Alan Hartman submitted under 37 C.F.R. § 1.132 on August 5, 2004 we find that the AGEDIS reference was submitted to the European Commission, Directorate General Information Society on January 14, 2000 as a project proposal in response to a Call for Proposals.

Appellants submitted as an exhibit a copy of that Call for Proposals with their Reply Brief submitted July 31, 2006. The Call for Proposals was issued in accordance with a Decision of the European Parliament and of the Council of December 22, 1998. We find that paragraph 6 of that document reads as follows:

“All proposals received by the European Commission will be treated in strict confidence.” as was asserted by Appellants.

We find no evidence in the file that the AGEDIS reference was treated other than in confidence until the AGEDIS system was disclosed to the public on December 11 and 12, 2003, as indicated in the Hartman declaration referenced above.

PRINCIPLES OF LAW

On appeal, Appellants bear the burden of showing that the Examiner has not established a legally sufficient basis for rejecting the claims under 35 U.S.C. § 102.

Assertions of fact, such as in an affidavit under 37 C.F.R. § 1.132, must be supported by whatever evidence can be presented in support of those assertions. *See In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984).

35 U.S.C. § 102(a) and (b) provide:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or * * *

ANALYSIS

To be a valid reference, the AGEDIS reference had to be made public before the filing date of the application. *See W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 720 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983).

Examiner was correct in requiring that the Call for Proposals be presented to the Office to establish evidence that the AGEDIS reference was not made public when it was submitted to the European Commission. On review of that evidence, we find that the standard practice was for the AGEDIS reference to be held in confidence and there was no evidence that the practice was not followed in this case. Therefore the AGEDIS reference does not qualify as prior art against the claims in this application.

Appeal 2006-3277
Application 09/946,237

CONCLUSION OF LAW

On the record before us, Appellants have sustained their burden of establishing that the Examiner's rejection is not supported by a legally sufficient basis for holding that the claimed subject was anticipated by AGEDIS within the meaning of 35 U.S.C. § 102.

DECISION

The Examiner's rejection of claims 1-25 is reversed.

REVERSED

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