

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY L. KODOSKY, DARSHAN SHAH, and
STEVEN W ROGERS

Appeal 2007-3639
Application 10/123,848
Technology Center 2100

Decided: May 14, 2008

Before JOSEPH L. DIXON, LANCE LEONARD BARRY, and
HOWARD B. BLANKENSHIP, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-26 and 45-50. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

BACKGROUND

Appellants' invention relates to a method and article of manufacture for configuring graphical program nodes for remote execution. (Spec. 1). An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method for configuring a graphical program, wherein the method executes on a first computer system, the method comprising:

displaying a graphical program on a display of the first computer system, wherein the graphical program includes a plurality of interconnected nodes which visually indicate functionality of the graphical program;

displaying a first device icon on a display of the first computer system, wherein the first device icon corresponds to a first device;

graphically associating a first node of the graphical program with the first device icon in response to user input;

deploying the first node to execute on the first device in response to said graphically associating.

PRIOR ART

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Small	US 5,898,434	Apr. 27, 1999
Gretta	US 5,971,581	Oct. 26, 1999
Morcos	US 6,229,539 B1	May 8, 2001
Eryurek	US 2005/0007249 A1	Jan. 13, 2005

REJECTIONS

Claims 1-7, 9, 10, 12-15, 16, 19-26 and 45-50 stand rejected under 35 U.S.C. 102(b) as being anticipated by Gretta. Claim 8 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Gretta and Small. Claim 11 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Gretta. Claim 18 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Gretta and Eryurek.

We note that the Examiner's statement of the rejections in the Answer is different than that set forth in the Final Rejection. The Examiner includes those missing claims from the Section 103 rejection and lists them in the Section 102 rejection, but discusses those claims in the responsive arguments in the previous groupings of rejections set forth in the Final Rejection. Therefore, it is not readily clear what the Examiner's position is in the record. It appears that the Examiner has changed the statutory basis for some of the rejections in the Answer and has not clearly indicated to Appellants the change in the grounds of the rejection. Since Appellants did not file a Reply Brief, we should pro forma affirm the Examiner's rejection, but in fairness to Appellants we will consider the rejection of claims as set forth in the Final Rejection.

The changed rejections were as follows: Claims 10 and 11 were rejected under 35 U.S.C. 103(a) as being unpatentable over and Small. Claim 17 was rejected under 35 U.S.C. 103(a) as being unpatentable over Gretta and Eryurek, and further in view of Morcos. Claims 16 and 18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Gretta and Eryurek.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and Appellants regarding the above-noted rejection, we make reference to the Examiner's Answer (mailed Aug. 24, 2006) for the reasoning in support of the rejections, and to Appellants' Brief (filed Jun. 2, 2006) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to Appellants' Specification and claims, to the applied prior art references, and to the respective positions articulated by Appellants and the Examiner. As a consequence of our review, we make the determinations that follow.

35 U.S.C. § 102

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

With respect to independent claim 1, Appellants argue that Gretta nowhere teaches or suggests "graphically associating a first node of the

graphical program with a first device icon in response to user input; and deploying the first node to execute on the first device in response to said graphically associating." (App. Br. 5). Appellants argue that the text cited by the Examiner merely discloses dropping device icon's onto an edit window to configure trends and alarms in a field bus network; and automatically creating a schedule in response to a manually created fieldbus configuration. Appellants further distinguish that the function blocks of Gretta are already resident on their respective devices, and are not dynamically deployed to devices based on such graphical associating. (App. Br. 6). We agree with Appellants' interpretation of the instant claim language and the teachings of Gretta, and we do not find that the Examiner has set forth a sufficient initial showing of anticipation.

First, we note that at page 24, line 28, of the Specification, Appellants discuss the use of the invention with local area networks which we note includes fieldbus networks as disclosed in Gretta. Therefore, we find the teachings of Gretta to be appropriate. At page 25 of the Specification, Appellants discuss programmable devices and programs that are deployed or stored on the programmable devices. On page 26 of the Specification, Appellants discuss applications and that programs may be deployed to various devices in the system for distributed execution. On page 29 of the Specification, Appellants discuss the configuration diagram and the configuration design may be useful in deploying programs among a plurality of devices in the system. The configuration diagram may also be used in creating one or more programs and deploying created programs in the system. Additionally, from the discussion of Appellants' disclosed invention

at pages 89-92 of the Specification, we find that the claimed terminology of deploying is to indicate the transfer and storing of the functionality represented by the device icon with respect to another device or node in a network.

Here, we do not find that the teachings of Gretta can be reasonably interpreted to teach such a graphical associating and subsequent deploying of function to a separate and distinct device or node. We do not find that the Examiner's rejection in the Answer at pages 4-6 and 16-18 squarely addresses the merits of Appellants' argument with respect to the associating and the deploying function to a separate and distinct device or node. At page 17 of the Answer the Examiner notes that while the function blocks are already resident on their respective devices, the function blocks that are not selected in the fieldbus configuration will not be deployed to execute on the device. The Examiner then further asserts that contrary to Appellants' argument, Gretta teaches that when the fieldbus configuration is executed a function block icon comprised in the fieldbus configuration execute at a first rate specified in an editor window and therefore the selected function blocks in the configuration fieldbus are deployed to execute on the device.

We do not find the Examiner's positions and arguments to set forth a persuasive initial showing of anticipation, and we do not follow the Examiner's seemingly reversed analysis that non-selected function icons are not executed to show what Gretta teaches with respect to the claimed invention. Furthermore, we do not find the relevance of such an argument as to the positive recitation of graphically associating a first node of a graphical

program with a first device icon in response to user input and deploying the first node to execute on a first device in response to said graphically associating as recited in independent claim 1.

Since the Examiner has not clearly shown that Gretta teaches all of the limitations recited in independent claim 1, and we have not found all the teachings from our review of Gretta, we cannot sustain the rejection of independent claim 1 and its dependent claims. We find similar limitations in independent claim 45 which are not taught by Gretta, and we cannot sustain the rejection of independent claim 45 and its dependent claims. We find similar limitations in independent claim 25 with two selecting steps in place of the step of associating which are not taught by Gretta, and we cannot sustain the rejection of independent claim 25 and its dependent claims.

35 U.S.C. § 103

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 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). “[T]he Examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore,

‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim,

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for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1741 (2007)(quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

With respect to dependent claims 8, 10, 11, and 16-18, the Examiner has not identified how the teachings of Small, Eryurek, or Morcos remedy the noted deficiency of Gretta with respect to independent claim 1, and we do not find that the Examiner has set forth a proper initial showing of obviousness. Therefore, we cannot sustain the rejection of dependent claims 8, 10, 11, and 16-18.

CONCLUSION

To summarize, we have reversed the rejection of claims 1-26 and 45-50 under 35 U.S.C. §§ 102 and 103.

REVERSED

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