

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* EITAN FARCHI, PAUL KRAM, YAEL SHAHAM-GAFNI,  
and SHMUEL UR

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Appeal 2008-0484  
Application 09/946,255  
Technology Center 2100

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Decided: June 20, 2008

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Before JAMES D. THOMAS, ALLEN R. MACDONALD, and THU A. DANG, *Administrative Patent Judges*.

MACDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF CASE

### *Introduction*

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 1-12. We have jurisdiction under 35 U.S.C. § 6(b).

According to Appellants, the invention is a method, system, and computer program product for the integration and combination of software test generators, and enables a plurality of independently developed test generators of different formats to work together and to be controlled as a single encompassing unit. (Spec. 5:16-19).

### *Exemplary Claim(s)*

Exemplary independent claim 1 under appeal reads as follows:

1. A method for integrating the use of a plurality of different-language test-generators to generate a test suite for testing computer software, comprising the steps of:

developing coverage criteria for said computer software;

determining a test sequence for satisfying said coverage criteria using said plurality of different-language test generators individually;

determining an intermediate representation of said test sequence; and

running said intermediate representation using said plurality of different-language test generators in an integrated manner to generate said test suite.

Appeal 2008-0484  
Application 09/946,255

*Prior Art*

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

Szermer	US 5,913,023	Jun. 15, 1999
Hollander	US 6,182,258 B1	Jan. 30, 2001
Willis	US 6,321,376 B1	Nov. 20, 2001

*Rejections*

The Examiner rejected claims 1-12 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Szermer, Hollander, and Willis.

*Examiner's Findings or Conclusions*

The Examiner found that “Sznermer (sic) teaches an invention substantially as claimed” (Ans. 7:4-5). The Examiner then found that “Sznermer (sic) does not explicitly disclose [a] plurality of different-language test generators” (Ans. 7:12-13). Additionally, the Examiner found that “Willis teaches ‘plurality of test generators (see Fig. 2, block 20 and associated text)’, and Hollander teaches plurality of different language test generators (abstract)” (Ans. 7:13-16).

The Examiner then concluded that it would have been obvious “to incorporate the teaching of Willis, and Hollander into the teaching of Sznermer (sic) to have a plurality of different language test generators” (Ans. 8:2-4).

Appeal 2008-0484  
Application 09/946,255

*Appellants' Contentions*

Appellants contend that the subject matter of claims 1-12 would not have been obvious over the combination of Szermer, Hollander, and Willis. More specifically, Appellants contend that the Examiner erred in rejecting claims 1-12 because Hollander does not teach “plurality of different-language test generators” as found by the Examiner (Ans. 7:12-16). Rather, “Hollander teaches a single test generator . . .” (App. Br. 7).

*Result*

We affirm.

ISSUE(S)

Have Appellants established that the Examiner erred in rejecting claims 1-12 as being unpatentable under 35 U.S.C. § 103(a) over Szermer, Hollander, and Willis?

PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary

indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’

*KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007).

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious without an explicit application of the teaching, suggestion, motivation test.

In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR* at 11 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12

(1966) (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.*

The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

*Id.* at 1740. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

Under this framework, once an Examiner demonstrates that the elements are known in the prior art and that one of ordinary skill could combine the elements as claimed by known methods and would recognize that the capabilities or functions of the combination are predictable, then the Examiner has made a *prima facie* case that the claimed subject matter is likely to be obvious. The burden then shifts to the Appellants to show that the Examiner erred in these findings or to provide other evidence to show that the claimed subject matter would have been nonobvious.

“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR.*, 127 S. Ct. at 1741 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

## ANALYSIS

Appellants argue that the subject matter of claims 1-12 would not have been obvious over the combination of Szermer, Hollander, and Willis because the Examiner has erred in that Hollander does not teach “plurality of different-language test generators” as found by the Examiner (Ans. 7:12-16). Rather, “Hollander teaches a single test generator . . .” (App. Br. 7:4-5).

We disagree. Although we agree that Hollander does not teach plural test generators as found by the Examiner. Appellants do not dispute the Examiner’s finding that “Willis teaches ‘plurality of test generators (see Fig. 2, block 20 and associated text)’” (Ans. 7:13-16). Additionally, Appellants do not dispute that portion of the Examiner’s finding that Hollander teaches a test generator directed to a plurality of different languages. The Examiner reiterates this in the Answer:

Hollander is used for showing a method and apparatus with means for test generation, which is adapted for integration with a plurality of different languages (see Abstract of Hollander and Final action, page 3). It is Willis that has called for such a plurality of test generators (see Final action, page 3).

Appeal 2008-0484  
Application 09/946,255

(Ans. 4). We conclude that the error due to Hollander's failure to provide a teaching is harmless because, as the Examiner correctly found, Willis provides the teaching which is missing from Hollander.

Therefore, for the reasons above, Appellants have not established that the Examiner erred with respect to this rejection of claims 1-12 under § 103(a).

#### CONCLUSION OF LAW

- (1) Appellants have failed to establish that the Examiner erred in rejecting claims 1-12 as being unpatentable under 35 U.S.C. § 103(a) over Szermer, Hollander, and Willis.
- (2) Claims 1-12 are not patentable.

#### DECISION

The Examiner's rejection of claims 1-12 is affirmed.

Appeal 2008-0484  
Application 09/946,255

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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