

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LEONARD E. PRUITT

Appeal No. 96-1988
Application No. 08/172,290¹

ON BRIEF

Before THOMAS, KRASS, and CARMICHAEL, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 3, 5 through 11 and 13 through 16, all of the claims remaining in the application.

¹ Application for patent filed December 23, 1993.

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The invention pertains to a method and apparatus for creating a flowchart through the use of a programmed computer wherein a structured program automatically results.

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We reverse.

Independent claim 1 requires that the program created by the flowchart be a "structured" program and that, in combining selected flow forms, "only downward flow of control is required within the flowchart, and no two lines connecting flow forms cross one another." Independent claims 5 and 14 contain similar language.

We find nothing in the disclosure of Marmelstein which teaches the claimed "downward flow" and prohibition of connecting flow lines crossing each other. The examiner's position is that "there are inherently predetermined connection rules applied to the input and output of each basic block of the structured program in which up-ward logical flow and crossing logical flows will not be allowed" [principal answer-page 3]. For his part, appellant disputes the "inherency" theory of the examiner and points out that the examiner "has not pointed out where in Marmelstein there is a suggestion that flow forms be placed in a flowchart such that control flow is only downward and no two lines connection flow forms cross each other" [principal brief-page 8]. Appellant also points out that, if anything, Marmelstein teaches away

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from the instant claimed invention in the Figure 8 showing of upward flowing lines and crossing lines in a flowchart.

We agree with appellant in that it is the initial burden of the examiner to specifically point out where each and every one of the claimed limitations is taught by the reference if a proper rejection under 35 U.S.C. 102(e) is to lie. The examiner has pointed to nothing within the disclosure of Marmelstein that persuades us that the reference contains a teaching of the claimed downward flow and the claimed prohibition of the crossing of two connecting flow forms.

Accordingly, we will not sustain the rejection of claims 1 through 3, 5 through 11 and 13 through 16 under 35 U.S.C. 102(e) over Marmelstein.

With regard to the rejection of the claims under 35 U.S.C. 103, the examiner admits [principal answer-page 5] that Marmelstein "does not teach preventing construction of visible crossing lines between icons." The examiner takes the position, however, that it would have been obvious to

realize such flowchart connection enforcement and the display of corresponding error messages because it would have helped programmers to avoid some common program syntax errors during the program flowchart construction without having to compile the program...[principal answer-page 5].

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Such reasoning sounds, to us, like hindsight. Just because a certain technique "would have helped programmers" does not mean that it would have been obvious to artisans, within the meaning of 35 U.S.C. 103, to have provided such a technique. There is no evidence of record, other than appellant's own disclosure, that would have suggested the prevention of the crossing of two lines connecting flow forms.

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Accordingly, we will not sustain the rejection of claims
1 through 3, 5 through 11 and 13 through 16 under 35 U.S.C.
103 over Marmelstein.

The examiner's decision is reversed.

REVERSED

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| JAMES D. THOMAS |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| ERROL A. KRASS |) | APPEALS |
| Administrative Patent Judge |) | AND |
| |) | INTERFERENCES |
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| JAMES T. CARMICHAEL |) | |
| Administrative Patent Judge |) | |

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