The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES C. KLEEWEIN,
EILEEN T. LIN and YUN WANG

Appeal No. 1997-0587
Application 08/314,644

ON BRIEF

Before JERRY SMITH, BARRY and LEVY, 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 final rejection of claims 1-20. Two amendments after appeal were filed by appellants, and both amendments were entered by the examiner. The second amendment cancelled claims 9 and 18. Accordingly, this appeal is directed to the rejection of claims 1-8, 10-17, 19 and 20,

which constitute all the claims remaining in this application.

The disclosed invention pertains to a method and apparatus for compensating for functional differences between heterogeneous database management systems.

Representative claim 1 is reproduced as follows:

1. A method of compensating for functional differences between heterogeneous database management systems, wherein data associated with a client is distributed among said heterogeneous database management systems, comprising the steps of:

(1) simulating support of multiple pending database actions on a single connection, said single connection being a logical link between a client and a database instance, wherein said database instance is instantiated in any of said heterogeneous database management systems which does not support multiple pending database actions on a single connection; and

(2) simulating support of cursors declared “with hold” in any of said heterogeneous database management systems which does not support cursors declared “with hold”.

The examiner relies on the following references:

Thompson et al. (Thompson)	4,881,166	Nov. 14, 1989
Adair et al. (Adair)	5,257,366	Oct. 26, 1993
Demers et al. (Demers)	5,278,978	Jan. 11, 1994

Claims 1-8, 10-17, 19 and 20 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the invention. Claims 1-8, 10-17, 19 and 20 also stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Adair in view of Demers with respect to claims 1-6 and 10-15, and Thompson is added with respect to claims 7, 8, 16, 17, 19 and 20.

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 obviousness relied upon by the examiner as support for the obviousness rejection. We 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.

It is our view, after consideration of the record before us, that the appealed claims are in compliance with the second paragraph of 35 U.S.C. § 112. We are also of the view

that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-8, 10-17, 19 and 20. Accordingly, we reverse.

We consider first the rejection of all the appealed claims under the second paragraph of 35 U.S.C. § 112. With respect to representative, independent claim 1, the rejection states:

> The body of the claim is not functionally tied to the invention as set forth in the preamble. It is unclear as to how the functional differences between heterogeneous database management systems are actually compensated for as set forth in the preamble. The body of the claim merely recites the step of **simulating** support of multiple pending actions, and cursors "with hold", which are mere **statements of desired results**. It is therefore unclear as to how said steps of simulating are actually performed to compensate for functional differences. Thus, the applicant failed to specifically detail a series of logical steps in the body of the claim that amount to the accomplishment of said simulating tasks and the compensation of functional differences therefor. [Final Rejection, page 3].

Appellants respond that each of the appealed claims satisfies the requirements of 35 U.S.C. § 112.

A claim must set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the disclosure as it would be by the artisan. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971); In re Johnson, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed in light of the specification. Seattle Box Co., v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984).

The first part of the rejection seems to contend that the two claimed simulating steps do not result in a method of compensating for functional differences between heterogeneous database management systems as indicated by the preamble. We do not agree. When the claims are properly interpreted in light of the disclosure, it is clear that the two claimed simulating steps, along with additional steps, do compensate for functional differences between heterogeneous database management systems.

The second part of the rejection asks how the steps of simulating are actually performed to compensate for functional

differences. The answer to this question can be found in appellants' disclosure. The examiner's question is related to the breadth of the claim rather than to its indefiniteness. Breadth of the claims is not equated with indefiniteness of the claims. In re Miller, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971).

We are of the view that the scope of the claims in this application would be understood by the artisan when interpreted in light of the accompanying disclosure. Therefore, we do not sustain this rejection of claims 1-8, 10-17, 19 and 20.

We now consider the rejection of the appealed claims under 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, 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), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine

prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). 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, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189

USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the briefs have not been considered [see 37 CFR § 1.192(a)].

With respect to independent claims 1, 10, 19 and 20, which stand or fall together as a single group [brief, page 4], we will consider the rejection with respect to claim 1. The examiner cites Adair as teaching the step of simulating support of multiple pending actions on a single connection. Demers is cited as teaching the step of simulating support of cursors "with hold." The examiner finds that it would have been obvious to the artisan to combine the teachings of the cited references [Final Rejection, pages 4-5].

Appellants argue that the examiner has failed to interpret the claimed invention consistently with the disclosure. Specifically, appellants argue that Adair does not teach a connection as recited in claim 1, and that Adair does not simulate support of multiple pending database actions on a single connection in a DBMS that does not support that function. Appellants also argue that Demers does not teach

simulating support of cursors declared “with hold” in a DBMS that does not support that function [brief, pages 12-15].

We agree with each of appellants’ arguments as set forth in the brief. Most importantly, neither Adair nor Demers teaches or suggests simulating a database function on a heterogeneous DBMS which does not support that function. The examiner’s attempt to provide a broad definition of simulating is of no help. The applied prior art simply does not perform simulating steps as recited in claim 1. Therefore, we do not sustain the examiner’s rejection of any of the independent claims which are on appeal before us.

Since the rejection is not sustained with respect to the independent claims, it is also not sustained with respect to the dependent claims. We note for the record, however, that we also agree with each of appellants’ arguments in consideration of the separate patentability of the dependent claims.

In summary, we have not sustained any of the examiner’s rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-8, 10-17, 19 and 20 is reversed.

REVERSED

	)	
JERRY SMITH	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
LANCE LEONARD BARRY	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
STUART S. LEVY	)	
Administrative Patent Judge	)	

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